

## TABLE OF CONTENTS.

	<b>PAGES</b>
<b>STATEMENT OF THE CASE</b> .....	1
As to the Final Decree appealed from .....	1
Contentions of the parties in the lower court .....	2
The single issue on this appeal .....	3
The Cameron patent adjudicated valid .....	4
Its granted term .....	4
As to Secs. 4884 and 4887, Rev. Stat. .....	5
Stipulations of record .....	6
As to Act of March 3, 1897 .....	7
Article 4 <i>bis</i> of the Treaty of Brussels .....	9
Immediate effect thereof on Sept. 14, 1902 .....	11
Courts of Appeals cases on Art. 4 <i>bis</i> .....	13
As to Act of March 3, 1903 .....	13
Did not abrogate Art. 4 <i>bis</i> .....	14
Could not devest term already vested under Art. 4 <i>bis</i> .....	15
Law extending patent term is <i>not</i> invalid for retroactivity .....	15; 45
Defendant-Appellee shows no special equities .....	17
<b>ASSIGNMENT OF ERRORS</b> .....	18
<b>BRIEF OF ARGUMENT</b> .....	20
Art. 4 <i>bis</i> of the Treaty of Brussels was self-executing and secured to the Cameron Patent the full remainder of the "Seventeen years" term named (as provided in the still effective Sec. 4884 of 1874) in the grant on the sealed face of said patent .....	20
<i>Shoe Machine Co.</i> case, of Aug. 2, 1907 .....	20
<i>Hennebique</i> case, of Aug. 19, 1909 .....	23
1889 Opinion of Atty. Gen. on 1883 treaty .....	26
Lower court cases on Art. 4 <i>bis</i> .....	27

<i>Art. 4 bis in terms of self-executing law and not of a contract to legislate</i> .....	30
Precedents as to such treaty terms.....	31
Grants directly secured by treaties.....	34
Within treaty-making power .....	16; 36
Limitation of prior statutes removed.....	38
Remainder of 17-years term confirmed.	39
<i>Conference Proceedings at Brussels</i> .....	41
Prospectus of the proposed treaty.....	42
1897 Conference Proceedings .....	44
Law extending patent term is <i>not</i> invalid for retroactivity .....	15; 45
Discussion in 1897 Conference meetings...	46
Insistence on Art. 4 <i>bis</i> .....	49
1900 report of commission on patent laws..	51
1900 Conference Proceedings at Brussels.	52
Treaty as finally made.....	54
1902 Convention of Turin .....	54
Legal aspect of the Conference Proceedings.	55
<b>The Act of Congress of March 3, 1903, 32 Stat. L. 1225, six months subsequent to the going into effect of the Treaty, did not affect Article 4 <i>bis</i>.</b> .....	60
Silent as to Art. 4 <i>bis</i> .....	60
Mere title of the Act considered.....	61
Limited scope of the Act.....	63
Shoe Mach. Co. case reviewed.....	66
<b>Neither the Act of March 3, 1903, nor any other subsequent legislation, could divest the patent rights that had already vested under Article 4 <i>bis</i> of the Treaty when the latter went into effect on September 14, 1902</b> .....	71
Conclusive precedents in point .....	71
<b>In Conclusion</b> .....	74

	PAGES
<b>APPENDIX (Copies of Treaty documents) .....</b>	<b>77</b>
<b>Treaty of Brussels as Proclaimed.....</b>	<b>78</b>
Article 4 bis .....	82
Provisions as to time of going into effect..	85; 86; 88
<b>Record of Deposit of Ratifications.....</b>	<b>87</b>
Agreement as to date of going into effect..	88

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### INDEX OF CASES CITED.

	PAGES.
<i>Cameron Septic Tank Company v. Village of Saratoga Springs</i> , 159 Fed. Rep. 453-464; 209 U. S. 548.....	4, 17
<i>Chew Heong v. United States</i> , 112 U. S. 536, 539-540, 542, 543 .....	31
<i>Chirac v. Chirac</i> , 2 Wheat. 259, 270-271, 277-278.....	32, 72
<i>Commercial Acetylene Co. v. Acme Co.</i> , 188 Fed. Rep. 89, 90-92; 192 Fed. Rep. 321, 326-329.....	29, 30, 73
<i>Commercial Acetylene Co. v. Searchlight Gas Co.</i> , 197 Fed. Rep. 908, 918-919.....	29
<i>Dallemande v. Moisan</i> , 197 U. S. 169, 175.....	62
<i>Foster et al. v. Neilson</i> , 2 Peters 253, 314, 315.....	12, 32, 34
<i>French Republic v. Saratoga Vichy Co.</i> , 191 U. S. 427, 439 .....	33
<i>Geofroy v. Riggs</i> , 133 U. S. 258, 267.....	37
<i>Hennebique case (Hennebique Construction Co. v. Myers)</i> , 172 Fed. Rep. 869, 873-874, 879-891.....	3, 13, 23, 24, 26, 27, 28, 30, 41, 51, 55, 66
<i>Hijo v. United States</i> , 194 U. S. 315, 324.....	12
<i>Jones v. Meehan</i> , 175 U. S. 1, 19-20, 32.....	16, 34, 72
<i>Keyes v. Mining Co.</i> , 158 U. S. 150, 153-4.....	3
<i>Leeds &amp; Catlin Co. v. Victor Co.</i> , 213 U. S. 301.....	6, 11, 30
<i>Little v. Watson</i> , 32 Me. 214, 223.....	57
<i>Malignani et al. v. Hill-Wright Electric Co.</i> , 177 Fed. Rep. 430, 434-5.....	27, 28

<i>Malignani et al. v. Jasper Marsh Electric Lamp Co.</i> , 180 Fed. Rep. 442, 444-445.....	28
<i>McClurg v. Kingsland</i> , 1 Howard 202, 206.....	15, 45, 72
<i>McDonald v. Miller</i> , 84 Fed. Rep. 344-345.....	3
<i>New York Indians v. United States</i> , 170 U. S. 1, 22-23.....	58
<i>Orr v. Hodgson</i> , 4 Wheaton 453, 463-464.....	16, 32
<i>Pohl v. Anchor Brewing Co.</i> , 134 U. S. 381, 386-387.....	11, 23, 39
<i>Refrigerator Co. v. Hammond</i> , 129 U. S. 151, 167.....	6, 11
<i>Rhode Island v. Massachusetts</i> , 12 Peters 657, 747.....	16
<i>Rogers v. United States</i> , 152 Fed. Rep. 346, 350.....	63
<i>Shoe Machine Co.</i> case (see <i>United Shoe Machine Co.</i> v. <i>Duplesis Shoe Machine Co.</i> ).....	
<i>Society, &amp;c. v. New Haven</i> , 8 Wheaton 464, 489, 490, 493.....	16, 17, 71
<i>The Bark Eudora</i> , 190 U. S. 169, 172-3.....	63
<i>The Isabella</i> , 6 Wheat. 1, 71-72.....	60
<i>Union Typewriter Co. v. Smith &amp; Bros.</i> , 173 Fed. Rep. 288.....	27
<i>United Shoe Machine Co. v. Duplesis Shoe Machine Co.</i> , 155 Fed. Rep. 842, 844, 845, 846, 848 (the <i>Shoe Ma-</i> <i>chine Co.</i> case).....	
3, 13, 20, 22, 23, 27, 28, 29, 30, 36, 39, 41, 55, 60, 61, 62, 63, 66	
<i>United States v. Oregon, etc., Railroad</i> , 164 U. S. 526, 541.....	14, 61
Walker on Patents (4th Ed.), pp. 138-139.....	15
Wigmore on Evidence, V. 4, Sec. 2425.....	60
<hr/>	
SEC. 4884, REVISED STATUTES (1874), QUOTED IN FULL.....	5, 40
“ 4887, “ “ (1874), “ “ “ ...	5
ACT OF MAR. 3, 1897, SEC. 3, AMENDING SEC. 4887, QUOTED	8
“ “ “ “ 8, LIMITTING SEC. 3, QUOTED....	9
“ “ “ 3, 1903, SUMMARIZED.....	63-65
TREATY OF BRUSSELS, IN FULL.....	78-86
ARTICLE 4 bis, QUOTED IN FULL.....	9-10

IN THE

# Supreme Court of the United States,

OCTOBER TERM, 1912.

No. 82.

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(No. 326, OCTOBER TERM, 1911.)

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CAMERON SEPTIC TANK COMPANY,

*Appellant,*

vs.

CITY OF KNOXVILLE, IN THE COUNTY OF MARION  
AND STATE OF IOWA,

*Appellee.*

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APPEAL FROM THE CIRCUIT COURT OF THE UNITED  
STATES FOR THE SOUTHERN DISTRICT OF IOWA.

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## BRIEF FOR APPELLANT.

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### STATEMENT OF THE CASE.

MAY IT PLEASE THE COURT:

This is an appeal, under Sec. 5 of the jurisdictional Act of March 3, 1891, 26 Stat. L., 826, from a Final Decree, of the United States Circuit Court for the Western District of Iowa, on a Bill of Complaint for infringement of Letters Patent No. 634423, the decree dismissing the bill on a Plea that, as the decree itself recites (Rec. 23), drew in question the construction and effect of the Treaty of

Brussels of December 14, 1900 (32 Stat. L. 1936-1943), and particularly that Article of said Treaty which relates to the independence of foreign and domestic patents to the same inventor for the same invention (Art. 4 *bis*, 32 Stat. L. 1940).

The sustained Plea (Rec. 18-19) was to the effect that the Complainant, Appellant here, had a plain and adequate remedy, if any, at law, because before any equitable or injunctive relief was had or actually sought under the Bill, the patent sued upon expired by limitation of its term through the expiration of a prior British patent to the same inventors for the same invention.

The Complainant-Appellant's contention was, and is, that the aforesaid Treaty of Brussels relieved the United States patent of any such limitation and confirmed to said patent the full "*Seventeen Years*" term actually expressed in the granting clause on the sealed face of the patent (Rec. 8); so that the patent still continues in force.

The Defendant, Appellee here, contended that the Treaty did not have such effect.

To expedite final determinaton of this plain issue of law, all disputed or disputable questions of fact were stipulated as to the case at bar. The court, after the submitting of briefs and oral arguments on both sides, found the Plea good in law (Rec. 20-21), and thereafter also found it true in fact and entered the before-mentioned Final Decree (Rec. 23), from which this appeal was duly petitioned (Rec. 24) and allowed (Rec. 26).

If the Appellant's contention as to the Treaty be sustained, the Plea falls, and the Bill should not have been dismissed, for the patent continues in

force to the end of the term stated on its sealed face, October 3, 1916, four years hence.

But if the patent sued upon expired with the British patent, as the Plea alleged, then the Complainant-Appellant does not dispute that it was within the proper discretion of the court (under *McDonald v. Miller*, 84 Fed. Rep. 344-345, and *Keyes v. Mining Co.*, 158 U. S. 150, 153-4) to dismiss the Bill, as there would have been a plain and adequate remedy at law.

The single issue before this Honorable Court is the construction and effect of the aforesaid Art. 4 *bis* of the Treaty of Brussels. Hence the jurisdiction of this court to entertain this appeal under that provision of Sec. 5 of 26 Stat. L. 826 which reads:

“That appeals \* \* \* may be taken from the \* \* \* circuit courts direct to the Supreme Court in the following cases:

In any case in which the constitutionality of any law of the United States, or the validity or construction of any treaty made under its authority, is drawn in question.”

And that the Treaty of Brussels is here so drawn in question is, as before stated, duly set forth in the final decree (Rec. 23) and the petition (Rec. 24) on which this appeal was allowed.

The Appellant's position as to the Treaty is in agreement with the majority view of the Court of Appeals of the Third Circuit in a recent parallel case (the *Hennebique* case, 172 Fed. Rep. 869), though at variance with an earlier opinion of the Court of Appeals of the Second Circuit in another case (the *Shoe Machine Co.* case, 155 Fed. Rep. 842), as will hereinafter be fully stated. These were the only authoritative precedents that the lower court,

*Statement of the Case.*

his Honor, Judge Smith McPherson, had to guide him in the case at bar, and he apparently followed the earlier one, though he did not hand down any opinion whatever to indicate his reasons for his decision.

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The patent sued upon, No. 634423, to Cameron *et al.*, for "Process of and Apparatus for Treating Sewage," has been sustained as to the validity of its Process claims, by the Court of Appeals of the Second Circuit, in the well-known case of *Cameron Septic Tank Company v. Village of Saratoga Springs*, 159 Fed. Rep. 453-464, in which case the Court of Appeals also denied a rehearing, 159 Fed. Rep. 464, and this Supreme Court denied certiorari, 209 U. S. 543, on April 20, 1908. That case, however, related only to the validity and infringement of this Cameron patent, as the present issue—duration of term—had not then been raised.

The grant on the sealed face of the Cameron patent, dated October 3, 1899, is for "SEVENTEEN YEARS," to October 3, 1916, and reads as follows (Rec. 8, 22):—

"Now therefore these Letters Patent are to grant unto the said Donald Cameron, Frederick J. Commin, and Arthur J. Martin, their heirs or assigns, for the term of SEVENTEEN years from the third day of October one thousand eight hundred and ninety-nine, the exclusive right to make, use and vend the said invention throughout the United States and the Territories thereof."

This "Seventeen" years term granted was of course that fixed by Section 4884 of the Revised Statutes, then and still in force, which reads as follows:

"Sec. 4884. *Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.*"

But at the date when the Cameron patent was applied for—March 15, 1887 (Rec. 3)—there was also in force the since repealed Section 4887 of the Revised Statutes, of 1874, which was as follows:

1897

"Sec. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. *But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.*"

And conformably with the Patent Office practice under this Section 4887 just quoted, the specification of the Cameron patent contained a list of the several prior foreign patents to the same inventors (Rec. 9). But nowhere in either the specification or sealed grant of the U. S. patent is there any statement whatever of any limitation or shortening of the "Seventeen years" term expressly named in the granting clause of the patent; and so any lim-

itation or shortening of such seventeen year term could be determined only upon ascertainment of two things, neither of which is stated in the patent itself, namely:—

First. The actual normal term of the shortest-termed of the several foreign patents listed in the specification. As to this we stipulated, for the purposes of defendant's plea in the case at bar, that the first-named British patent in the list, British patent No. 21,142 of November 8, 1895, expired, by the running of its normal term, on November 8, 1909 (Rec. 20).

Second. Whether any—and if any, which—of the many claims in the Cameron patent, may actually be for the same invention as the particular British patent (No. 21142 of Nov. 8, 1895) selected by the defendant from the list that also names another and different British patent (No. 23042 of Oct. 17, 1896) and some fifteen other foreign patents (Rec. 9). For, under the authority of the decision of this Supreme Court in *Leeds & Catlin Co. v. Victor Co.*, 213 U. S. 301, only some, if any, of the many claims of the patent sued upon might have such identity with the claims of the particular British patent as to expire with it. So as to this we also stipulated, for the purposes of defendant's plea in the case at bar, that the allegation of identity made in the Plea might be taken as true (Rec. 21).

These stipulations as to the term and subject-matter of the particular British patent cited in the Plea, would be the evidence on which the Cameron patent could be adjudged to have expired, if the limitation in the old repealed Sec. 4887 of 1874 still applies to it, under the rule stated by this Supreme Court, while said Section was still in force, in *Re-*

*frigerator Co. v. Hammond*, 129 U. S. 151, 167, as follows:

“Under § 4887 [of 1874], although, in the case provided for by it, the United States patent may on its face run for seventeen years from its date, it is to be so limited *by the courts, as a matter to be adjudicated on evidence in pais*, as to expire at the same time with the foreign patent, not running in any case more than seventeen years; but, subject to the latter limitation, it is to be in force as long as the foreign patent is in force.” (Italics ours.)

But since the date, March 15, 1897, at which the application for the Cameron patent was filed in the Patent Office, there have been certain radical changes in the law, by statute and treaty, relating to the former dependence between domestic and foreign patents under the old Sec. 4887 of 1874.

On January 1, 1898, while the application for the Cameron patent was still pending in the Patent Office, there went into effect the Act of March 3, 1897, entitled “An Act Revising and amending the statutes relating to patents,” 29 Stat. L. 692, which, in its “Section 3,” amended the aforesaid Section 4887 of 1874 in several respects and entirely struck out, among other things, the above-quoted clause that had made the term of domestic patents dependent on the term of foreign patents, the clause reading, in said Sec. 4887 of 1874:—

“But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.”

The said Sec. 3 of the new Act, so amending the old Sec. 4887, read as follows (29 Stat. L. 692):—

"Sec. 3. That section forty-eight hundred and eighty-seven of the Revised Statutes be, and the same hereby is, amended by inserting on line one, after the words 'no person,' the words 'otherwise entitled thereto,' and on line three, after the words 'caused to be patented,' the words 'by the inventor or his legal representatives or assigns,' and by erasing therein all that portion of the section which follows the words 'in a foreign country,' on lines three and four, and substituting in lieu thereof the following: 'unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country' so that the section so amended will read as follows:

'Sec. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country.' "

But this new Section 4887 thus set forth in Sec. 3 of the amendatory Act of 1897, did not in any manner affect the Cameron patent, the application for which was still pending when, on Jan. 1, 1898, said new Sec. 4887 went into force,—for a further section, Section 8, of the same amendatory Act of March 3, 1897, provided that the above quoted Section 3 of the Act, the section amending the old Sec. 4887 of 1874, should "*not apply*" to *any application filed prior to January 1st, 1898, nor to any patent granted on such an application*, the said limiting section of the amendatory Act (29 Stat. L. 692) reading as follows:

*“Sec. 8. That this Act shall take effect January first, eighteen hundred and ninety-eight, and Sections one, two, three, and four, amending Sections forty-eight hundred and eighty-six, forty-nine hundred and twenty, forty-eight hundred and eighty seven, and forty-eight hundred and ninety-four of the Revised Statutes, shall not apply to any patent granted prior to said date, nor to any application filed prior to said date, nor to any patent granted on such an application.” (Italics ours.)*

So the thereafter granted Cameron patent, when it was issued on October 3, 1899, took no benefit from the amendatory Act of 1897, but was still, when so issued, subject to the old Section 4887 of 1874, as before indicated, though on its face granted, as we have shown, for “Seventeen years” from Oct. 3, 1899.

But a little less than three years later, on September 14, 1902, the before-mentioned Treaty of Brussels was duly proclaimed by the President of the United States, and thereby became, as the Constitution provides, a “supreme law of the land,” in respect to all provisions of such Treaty that were in self-executing form and language. One of the provisions of said Treaty was that patents existing at the time the Treaty went into effect (September 14, 1902) *“shall be independent”* of foreign patents obtained for the same invention,—this provision being expressed in an *“Article 4 bis,”* which reads as follows (32 Stat. L. 1940):—

*“Art. 4 bis. Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.*

*This provision shall apply to patents existing at the time of its going into effect.*

The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion.” (Italics ours.)

And the Proclamation of the President further sets forth that (32 Stat. L. 1943) “it is agreed between the ratifying Governments” that the Treaty “shall go into effect between them on September 14, 1902,”

and therefore it is so proclaimed,

“to the end that the same and every article and clause thereof may be observed and fulfilled with good faith by the United States and the citizens thereof.” (32 Stat. L. 1943.)

The Cameron patent was on September 14, 1902, the day the Treaty went into effect, a “patent existing,” and therefore “applied for” and issued, as specified in said “Article 4 bis” above quoted. The patentees who applied for the Cameron patent, and to whom it issued, were such “persons” as are defined in the first clause of said Article, for they were, as the patent itself declares (Rec. 9),

“subjects of the Queen of Great Britain, and residents of, Exeter, in the county of Devon, England,”

and both Great Britain and the United States were “States adherents” to the Treaty, and both the subjects of Great Britain and the citizens of the United States were “persons admitted to the benefit of article 2,” which was an article of the prior Convention of 1883, relating to all citizens and subjects of the contracting states (Treaties and Conventions, 1889, p. 1168) and reading:

“Art. II. The subjects or citizens of each

of the contracting states shall enjoy, in all the other States of the Union, \* \* \*"  
and to which the United States adhered in 1887.

Also, the British patent cited by defendant's Plea against the Cameron United States patent, is, under the Record in the case at bar, a patent "obtained for the same invention in" one of "the other States adherents," namely, in Great Britain.

Thus the Treaty declares that such a United States patent as the Cameron patent "*shall be independent*" of such a British patent, and that this provision "*shall apply*" at the time the Treaty goes into effect, September 14, 1902.

Up to that day, the "Seventeen years" term expressed in the grant on the sealed face of the Cameron patent was limited by the normal term of the shortest-termed foreign patent to the same inventors, to the extent that the claims of said Cameron patent might be for the same invention as such foreign patent,—and such normal term and identity of the foreign patent were "matter to be adjudicated on evidence in *paix*" (*Refrigerator Co. v. Hammond*, 129 U. S. 151, 167, and *Leeds & Catlin Co. v. Victor Co.*, 213 U. S. 301, *supra*.) No other dependence, however, could have existed between the Cameron U. S. patent and the British patent, for it had long been established, by the decisions of this Supreme Court, that the seventeen years term of a United States patent could not be limited or shortened by any void foreign patent or by any mere lapsing of the foreign patent, through non-payment of annuities or non-working, short of the normal term for which such foreign patent was issued (*Pohl v. Anchor Brewing Co.*, 134 U. S. 381).

The language of Article 4 *bis* of the Treaty—"shall be independent," and "This provision shall apply to patents existing"—is the language of self-executing law and not of a mere contract to legislate. It exactly corresponds to the language "shall be valid," which Chief Justice Marshall, in considering a treaty relating to grants of lands, declared would be self-executing and "would have repealed those Acts of Congress which were repugnant to it" (*Foster et al. v. Neilson*, 2 Peters 253, 314).

The Art. 4 *bis* of the Treaty simply confirmed to the Cameron patent the "Seventeen years" already expressly stated (in accordance with the still effective Sec. 4884 of 1874) in the grant on the sealed face of that patent. No single word was required to be changed in the patent, and so nothing further was required to be done by any executive department of the government. A mere disability under which the courts might have adjudged the patent to labor, was removed, and no further legislative act was needed. The Treaty had simply operated in respect to such patents as the Cameron patent, to repeal so much of the old Section 4887 of 1874 as still limited each of their terms by a foreign term, thus simply giving them the independence of foreign patents that all other United States patents had enjoyed since the revision of Sec. 4887 in 1897.

A self-executing clause in a Treaty, plainly securing a private right, is as much the law of the land as an Act of Congress, and repeals any prior Act of Congress repugnant to it, under the rule repeatedly expressed by the Supreme Court, as, for instance, in *Hijo v. United States*, 194 U. S. 315, 324:—

"It is well settled that in case of a conflict between an act of Congress and a treaty—each being equally the supreme law of the land—the one last in date must prevail in the courts. *The Cherokee Tobacco*, 11 Wall. 616, 621; *Whitney v. Robertson*, 124 U. S. 190, 194; *United States v. Lee Yen Tai*, 185 U. S. 213, 221."

Both of the only Circuit Courts of Appeals that have discussed Art. 4 *bis* of the Treaty—in the *Shoe Mach. Co.* case and *Hennebique* before mentioned, and later more fully referred to—have agreed that said Art. 4 *bis* was *self-executing* and did, on September 14, 1902, relieve then existing domestic patents from the limitation of term previously imposed upon them by foreign patents. The going into effect of the Treaty on September 14, 1902, simply wiped out the limitation of term imposed by the limiting clause of the old Section 4887 of 1874 and confirmed to these domestic patents the "Seventeen years" term expressed in the grant on the face of each of them and determined by the same Section 4884 (Revised Stat.) that has never been repealed and that gives a seventeen years term to all domestic patents.

The divergence in these two Courts of Appeals is merely, that the earlier one held that a subsequent statute, the Act of March 3, 1903, *six months subsequent to the going into effect of the Treaty*, had abrogated Art. 4 *bis* of the Treaty and put the existing domestic patents back where they were before the Treaty went into effect,—and this merely because this subsequent Act of March 3, 1903, had been entitled an Act "to effectuate the provisions of" the Treaty but had been entirely silent on Art. 4 *bis* thereof, although said Art. 4 *bis* was *self-executing* and all that ever could be done under it as

a matter of administrative law had already been accomplished when it simply confirmed to existing patents the term already written on the face of each of them. The errors in this view of the effect of the Act of March 3, 1903, are obvious:

On the one hand, the mere title of the Act of March 3, 1903—"An Act to effectuate the provisions of the additional act [the Treaty of Brussels] of the international convention for the protection of industrial property" (32 Stat. L. 1225)—could not import into the body of the Act an abrogation of the already self-effective Art. 4 *bis* of the Treaty, when the said body of the Act is absolutely and entirely silent as to said Art. 4 *bis* and is merely directed to making conformable with the Treaty certain statutes that relate to other provisions and prescribe matters of administrative law such as the Patent Office would have to administer in acting upon future patent-applications and would find in confusion with the practice prescribed by former statutes that the Treaty superceded. There is nothing ambiguous in the body of the Act of March 3, 1903, and the mere title cannot import into it a thing upon which it is entirely silent. As the Supreme Court said in *United States v. Oregon, etc., Railroad*, 164 U. S. 526, 541:—

*"The title is no part of an act and cannot enlarge or confer powers, or control the words of the act unless they are doubtful or ambiguous."* (Italics ours.)

And the Act contained no words whatever in any manner referring to Art. 4 *bis* of the Treaty, and so cannot be held to have even attempted to abrogate that Article.

On the other hand, even if the Act of March 3,

1903, had attempted to abrogate Art. 4 *bis* of the Treaty, there was no possibility whatever of devesting any existing patents of the "Seventeen years" term that had been confirmed to them and vested in their patentees *six months previously*, when the self-executing Art. 4 *bis* went into effect on September 14, 1902. The right to the full "Seventeen years" term had been vested in the patentees throughout six months, from Sept. 14, 1902, to March 3, 1903, and,

*"Patent rights, once vested, are therefore incapable of being devested by act of Congress,"* as the rule has been stated in Walker on Patents (4th Ed., pp. 138-139), referring to the fuller statement of the Supreme Court in *McClurg v. Kingsland*, 1 Howard 202, 206:—

*"Whether these exceptions are well taken or not must depend on the law as it stood at the emanation of the patent, together with such changes as have since been made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.*

*"\* \* \* \* \* This repeal [a repeal alleged to abridge certain theretofore existing patent rights], however, can have no effect to impair the right of property then existing in a patentee, or his assignee, according to the well-established principles of this court in 8 Wheat. 493; \* \* \*"* (Italics ours.)

Thus the law-making power may retrospectively extend or remove limitations from the term of an existing patent, for that does not devest any prop-

erty right that has become vested, but after the Treaty, in the plain words of self-executing law, had confirmed to and already vested in the patentees the title to the rest of the "Seventeen years" named (in accordance with the still effective Sec. 4884 of 1874) in the grant on the sealed face of the existing patents, no subsequent Act of Congress could devest that title,—as is stated by this court in the decision "8 Wheat. 493" cited at the end of the matter just above quoted, (*Society, &c, v. New Haven*, 8 Wheaton 464, 493) :—

"But there is a still more decisive answer to this objection, which is, that *the termination of a treaty cannot devest rights of property already vested under it.*

"*If real estate be purchased or secured under a treaty, it would be most mischievous to admit that the extinguishment of the treaty extinguished the right to such estate. In truth, it no more affects such rights, than the repeal of a municipal law affects rights acquired under it. If, for example, a statute of descents be repealed, it has never been supposed that rights of property, already vested during its existence, were gone by such repeal. Such a construction would overturn the best established doctrines of law, and sap the very foundation on which property rests.*" (Italics ours.)

And a patent right is as much a "property right" as is the title to land, and may be secured by treaty as well as by statute—for instance, while the Constitution gives Congress power over Government lands (Art. IV, Sec. 3), just as also over patent rights, nevertheless it has long been established that the individual's title to such lands may be determined by mere self-executing provisions in a treaty (*Jones v. Meehan*, 175 U. S. 1, 19-20, 32; *Rhode Island v. Massachusetts*, 12 Peters 657, 747; *Orr v. Hodgson*, 4 Wheaton 453, 463-464;

*Society, &c., v. New Haven*, 8 Wheaton 464, 489-490). The Act of March 3, 1903, could not, and did not attempt to, divest patentees of the property right, in and to the rest of the "Seventeen years" term of their existing patents, that was already vested in them by the going into effect of the Treaty on September 14, 1902, six months before. The Cameron patent could not be divested, by any subsequent law, of any part of the rest of its seventeen years term, and cannot expire until October 3, 1916.

It may perhaps be noted that the Defendant-Appellee shows no special equities entitling it to any unusual consideration in this cause. The sworn Bill, uncontested, charges infringement of a patent that has been adjudicated valid, and charges that the infringement began before the time at which the Plea alleges the patent expired. The importance and value of the patented invention appear from the decision of the Court of Appeals of the Second Circuit adjudging the patent valid in the case of *Cameron Septic Tank Co. v. Village of Saratoga Springs*, *supra*, and further appear from the record in that case, which was filed with the petition for certiorari that this Supreme Court denied in 1908 (*supra*).

**ASSIGNMENT OF ERRORS.**

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The errors specified in the Assignment of Errors (Rec. 25) are as follows:—

1. The court erred in entering the decree dismissing the Bill of Complaint.
2. The court erred in sustaining the Plea of the defendant.
3. The court erred in holding that the United States patent sued upon expired on the eighth day of November, 1909, and that said expiring of said patent was due to the expiration, on said date, of the British patent named in the defendant's Plea.
4. The court erred in not holding that the United States patent sued upon is still in force and that the term thereof will not expire until October third, 1916, seventeen years from the date, October third, 1899, on which said patent was granted.
5. The court erred in not holding that the Treaty of Brussels of December 14, 1900, operated and had the effect, on November 8, 1909, of preventing the expiration of the term of said United States patent on, and because of, the expiration of the aforesaid British patent on said date of November 8, 1909.
6. The court erred in not holding that the said Treaty of Brussels went into effect on September 14, 1902, and then and there freed the said United States patent from any dependence on the term of any prior foreign patent, and then and there secured and confirmed to said United States patent

the full seventeen years' term named in the granting clause on the sealed face of the said patent; and in not holding that no subsequent legislative or other act has repealed or abrogated said effect of said Treaty.

7. The court erred in not overruling the Plea of the defendant and in not holding it to be disapproved.

8. The court erred in not entering a decree for complainant as prayed in the Bill.

The fundamental error of the lower court was of course the failure to hold that on September 14, 1902, the going into effect of Art. 4 *bis* of the aforesaid Treaty of Brussels relieved the Cameron patent of the collateral limitation of term incident to the old Section 4887 of 1874, and confirmed the Seventeen years term named—in accordance with the still effective Section 4884—in the grant on the sealed face of the patent; and that legislation subsequent to September 14, 1902, could not, and did not attempt to, divest the patent rights so vested under the Treaty.

**BRIEF OF ARGUMENT.**

Article 4 bis of the Treaty of Brussels was self-executing and secured to the Cameron Patent the full remainder of the "Seventeen years" term named (as provided in the still effective Sec. 4884 of 1874) in the grant on the sealed face of said patent.

This is shown by the matters already reviewed in the Statement of the Case, but may be here detailed somewhat more fully.

A statement of the law in respect to the self-executing nature of this Art. 4 bis of the Treaty is found in the *Shoe Machine Co.* case before referred to, the case in which the Court of Appeals of the First Circuit considered the said Article, as follows (*United Shoe Machine Co. v. Duplessis Shoe Machine Co.*, 155 Fed. Rep. 842, 844-846) :—

"One question is the weight to be given to the article 4 bis under the Constitution of the United States. The Constitution speaks of treaties and statutes in the same breath; and they have always been practically put in the same class by the Supreme Court. More than 100 years ago, in *United States v. The Schooner Peggy*, 1 Cranch, 103, 110 (2 L. Ed. 49) the Court said:

'But yet where a treaty is the law of the land, and as such affects the right of parties litigating in court, that treaty as much binds those rights, and is as much to be regarded by the court as an act of Congress.'

There never has been any doubt on this proposition. Consequently it was said in *The Cherokee Tobacco*, 11 Wall. 616, 621 (20 L. Ed. 227) :

'The effect of treaties and acts of congress, when in conflict, is not settled by the Constitution. But the question is not involved in any doubt as to its proper solution. A treaty may supersede a prior act of Congress, and an act of Congress may supersede a prior treaty.'

This has been repeated many times, the last in *Hijo v. United States*, 194 U. S. 315, 324, 24 Sup. Ct. 727, 48 L. Ed. 994. Consequently, so far as judicial action is concerned, a later treaty has the same effect on a prior statute as a later statute has; and, so far as the conventions pertinent here are concerned, the fact that the Constitution commits to Congress the power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' is of no consequence, because all the powers of Congress are especially vested, either directly or indirectly, by the Constitution in a similar manner; and to hold that a treaty could not abrogate a prior statute regarding patents because this particular legislative power is committed to Congress could not be permitted so long as the general rule as to statutes superseding treaties, and, *vice versa*, declared by the Supreme Court in the way we have pointed out exists. The rules which we have explained with reference to the relation of treaties to statutes, and as to treaties becoming immediately effective, are the necessary sequence of the decisions explained in *United States v. Lee Yen Tai*, 185 U. S. 213, 220, 221, 222 and 22 Sup. Ct. 629, 46 L. Ed. 878.

But the respondent, now the appellee, maintains that article 4 *bis* of the convention of 1900 was not effectual until enacted into a statute by Congress. An examination of the decisions of the Supreme Court on this topic will show there is no practical distinction whatever as between a statute and a treaty with regard to its becoming presently effective, without awaiting further legislation. A statute may be so

framed as to make it apparent that it does not become practically effective until something further is done, either by Congress itself or by some officer or commission entrusted with certain powers with reference thereto. The same may be said with regard to a treaty. *Both statutes and treaties become presently effective when their purposes are expressed as presently effective; and, on its face, article 4 bis of the convention in question is so expressed.* [Italics ours.] A striking illustration of the rule that treaties become effective in the same manner as statutes is found in *United States v. The Schooner Peggy*, 1 Cranch., 103, 2 L. Ed. 49, already cited. This vessel was condemned in the Circuit Court on September 23, 1800. A treaty with France became effective on September 30, 1800; and, inasmuch as the judgment of the Circuit Court was subject to a writ of error which was sued out on October 2, 1800, the Supreme Court held that the treaty annulled the condemnation."

Thus the Court of Appeals of the First Circuit plainly held that Art. 4 bis of the Treaty was self-executing. But they then went on to make the further holding whose error we have already indicated and will later more fully refer to, the holding that a subsequent Act of Congress, six months subsequent to the going into effect of the Treaty, and which was entirely silent as to said Art. 4 bis, had, by mere implication of its mere title, abrogated the Art. 4 bis, and so, in effect, had devested the property right, in and to the remainder of a seventeen years term, that had vested in the patentees of existing patents when the self-executing Art. 4 bis went into effect six months previously.

The plain error in this latter holding in the *Shoe Machine Co.* case, as to the effect of the subsequent Act of Congress, was pointed out, as we shall later

more fully state, in the *Hennebique* case already referred to—the other Court of Appeals case dealing with Art. 4 bis of the Treaty. But in the latter case, the same view was taken, as in the *Shoe Machine Co.* case, of the immediate effectiveness of Art. 4 bis, namely, that said Article was on its face plainly self-executing.

In the *Hennebique* case, the very full discussion of Art. 4 bis of the Treaty is found in the concurring opinion of Judge Archbald (172 Fed. Rep. 879, 880-891). But Judge Gray, presiding, though devoting his opinion to the proposition that the patent in suit could not have been limited at all by the admittedly void foreign patent cited against it, concluded his opinion by stating that although his view of the void foreign patent made it unnecessary to consider Art. 4 bis of the Treaty, nevertheless

*"if it is called for in order to support our judgment, I may say that I agree with the views on the subject expressed in the concurring opinion of Judge Archbald."* (172 Fed. Rep. 873-874.)

Thus Judges Gray and Archbald, constituting a majority of the Court of Appeals of the Third Circuit, were in entire agreement as to the effect of Art. 4 bis of the Treaty. The third judge, Judge Buffington, in a dissenting opinion entirely ignored and did not mention the Treaty, and stated his dissent entirely on the ground that in his view an entirely void foreign patent could limit the term of a domestic patent under Sec. 4887 of 1874. The other two judges had agreed that such a view of the effect of a void foreign patent was impossible (under the authority of such Supreme Court cases as *Pohl v. Anchor Brewing Co.*, 134 U. S. 381). And while this majority view that the void foreign patent was ab

*initio* without effect, may perhaps be regarded as the decisive opinion in the case, and may have made unnecessary the consideration of the Treaty, nevertheless the consideration given the Treaty is so full, and so plainly sound, and so explicitly concurred in by Judge Gray, that it is at least a judicial dictum of most persuasive force. We think it will stand securely on the plain soundness of its reasoning.

In this *Hennebique* case, the matter of the self-executing nature of Art. 4 *bis* is considered as follows (172 Fed. Rep. 880, 887-888) :—

“By the convention concluded at Brussels December 14, 1900, by the International Conference for the Protection of Industrial Property, at which the United States was represented, it was, among other things, ordained:

[Quoting Art. 4 *bis* in full.]

This convention was additional to that similarly concluded at Paris March 20, 1883, to which the United States was not originally a party but subsequently gave its adherence, and was ratified by the Senate March 7, 1901, and proclaimed by the President August 25, 1902, to go into effect September 14 following. 32 Stat. L. 1936. Taken as it reads, it provides for the absolute independence of previously inter-dependent domestic and foreign patents; and if self-executing, and not otherwise controlled, it relieves the patent in suit from the effect of the French patent to which reference has been made, whether valid or invalid.

[Here follows a review of the negotiations, which we will later refer to, that culminated in the Treaty of Brussels in question; resuming on p. 887 :—]

And, it having been in terms provided that the article should ‘apply to patents in existence at the time of its being put into force,’ subsisting patents, including the one in suit, were freed from their previous dependency, equally with

those granted afterwards; no saving distinction being made between them.

The article must also be regarded as self-executing. A contrary opinion was given by the Attorney General as to the treaty of 1883. 19 Opinions, 275. And this was followed by the Patent Office, as the correct construction, afterwards. *Ex parte Zwack & Co.*, 76 O. G. 1855; *Butterworth v. Boral*, 97 O. G. 1596. It was accepted, also, by the Court of Appeals of the District of Columbia in interference proceedings carried up from the Commissioner of Patents. *Parker v. Appert*, 75 O. G. 1201; *Rousseau v. Brown*, 104 O. G. 1120. In *United Shoe Company v. Duplessis Shoe Company*, 155 Fed. 842, 84 C. C. A. 76, [the *Shoe Machine Co.* case we have referred to] also, it was held by the Court of Appeals of the First Circuit, that, although article 4 bis on its face was self-executing, it was controlled by implication by the passage by Congress of act March 3, 1903, c. 1019, 32 Stat. 1225 (U. S. Comp. St. Supp. 1907, p. 1003), to give effect to it. But neither of these views in my judgment can be sustained. Having respect to their terms, it cannot be said that either the treaty of 1883 or the additional act of 1900 required legislation here to make it effective. They both undertake in the most direct and positive way to show what shall and what shall not be as to the matters with which they deal, and, being ratified in that form, nothing further, by our laws, was necessary to put them into operation. They cannot be treated as mere agreements by the high contracting parties to bring the domestic laws of each into conformity with them by subsequent action. That resulted by virtue of their own force and vigor.

A treaty is a law of the land, as an act of Congress is, whenever its provisions prescribe a rule by which the rights of the private citizens or subject may be determined. *Head Money Cases*, 112 U. S. 580, 598, 5 Sup. Ct. 247, 28 L. Ed. 798. [Here follows a review, by way of illustration, of Articles of the previous treaty,

of 1883, the treaty of which the Treaty of Brussels in question was amendatory.]

It is idle to suggest, in the face of these provisions and others of like character that could be quoted, that the treaty [of 1883] as well as the additional act [the Treaty of Brussels] by which it was supplemented, was inoperative and lay fallow until Congress, by statute, was moved to give life to it."

The opinion of the Attorney General referred to in the quotation just made from the *Hennebique* case, was, as there stated, an opinion given in 1889, many years prior to the Treaty of Brussels, and related only to the early Treaty of 1883, the treaty to which the Treaty of Brussels was amendatory. And though this 1889 opinion of Attorney General Miller was followed in several Patent Office cases, as stated in the above quotation from the *Hennebique* case, it is to be noted that not only was the Attorney General discussing a different treaty provision from the one here under consideration, but also he made the error of assuming that a treaty provision relating to patents could not be self-executing because the Constitution gives "Congress" power over patent rights and a treaty is made by only the Senate and President. But this view overlooked the fact that the Supreme Court has repeatedly held self-executing various treaty provisions relating to private rights in matters over which the Constitution gives power to the "Congress,"—such, for instance, as the title of individuals to lands in territory of the United States, although power over such territory is given to "Congress" by the second clause of Sec. 3 of Art. IV of the Constitution, just as another section of the Constitution gives Congress power over patent rights.

As we have stated, the *Shoe Machine Co.* case and the *Hennebique* case are the only Court of Appeals cases in which Art. 4 bis of the Treaty has been discussed. But several of the lower courts have had before them cases in which it was necessary to pass upon the matter, and have followed the decision in the *Shoe Machine Co.* case without adding anything materially to its discussion. Apparently the controlling circumstance has been that the *Shoe Machine Co.* case was a decision of an entire Court of Appeals, while the later consideration of the matter in the *Hennebique* case was the view of only a majority of the court. The several Circuit Court cases referred to are the following:—

In *Malignani, et al., v. Hill-Wright Electric Co.*, 177 Fed. Rep. 430, 434-5, Judge Hazel, in the Southern District of New York, says that he agrees with the views stated in the *Shoe Machine* case, and points out that the opinion in the *Hennebique* case, notwithstanding the concurrence of two of the judges in it, was not necessary to a decision of the case, and in this connection Judge Hazel refers to a remark made by Judge Archbald himself in the later case of *Union Typewriter Co. v. Smith & Bros.*, 173 Fed. Rep. 288, wherein Judge Archbald says that his opinion in the *Hennebique* case was not the opinion of the court. What Judge Archbald, in the last named case, said, was, that that case, then before him, was disposed of on other grounds, making it unnecessary to consider the term of the patent, and added

“but I am on record as holding, *Hennebique Construction Company v. Myers* (C. C. A.) 172 Fed. 869, that there was a complete doing away with the inter-dependence of foreign and do-

mestic patents by the industrial treaty of Brussels of 1900, which treaty was self-executing, and applied to existing patents, and would therefore be effective here. While my opinion was not the opinion of the court, and no point is made of the treaty by counsel at this time, I prefer—the case being otherwise disposed of—to say nothing to in any wise conflict with the views so expressed."

In other words, Judge Archbald reiterated his conclusions as to the Treaty, without undertaking a detailed rediscussion of the matter in a case where the issue was not raised; and merely remarked that, as we have already indicated, the discussion of the Treaty in the *Hennebique* case was perhaps unnecessary to the decision of that case,—although it was sufficiently in point and important to lead Judge Gray to make an express declaration of his concurrence with the view detailed by Judge Archbald. In the face of these circumstances, we think that in the *Malignani* case Judge Hazel's reference to the division of opinion in the *Hennebique* case amounts merely to a suggestion of a possible reason for not following the *Hennebique* case as the later and more fully considered of the two Courts of Appeals cases dealing with the Treaty question.

In another *Malignani* case, *Malignani, et al. v. Jasper Marsh Electric Lamp Co.*, 180 Fed. Rep. 442, 444-445, Judge Brown, in the District of Massachusetts, in the First Circuit, follows the *Shoe Machine Co.* case, as the authoritative decision of the Court of Appeals in that Circuit. He adds some remarks to the effect that there might be an objection to having Art. 4 *bis* operate on patents applied for by foreigners, while patents applied for by citizens remain unaffected. But this is quite beside the mark, be-

cause Art. 4 *bis* makes no discrimination between foreigners and citizens but applies to all the citizens and subjects of the contracting states. Judge Brown also suggests that there would be a difficulty in having the Treaty operate on our domestic patent laws, because both houses of Congress do not act in making a treaty, and in this connection he cites the opinion of Attorney General Miller on the prior treaty of 1883. We have already pointed out, and will later further state, the error in that opinion of the Attorney General.

In *Commercial Acetylene Co. v. Searchlight Gas Co.*, 197 Fed. Rep. 908, 918-919, Judge Kohlsaat, in the Northern District of Illinois, simply follows the *Shoe Machine Co.* case, as a decision of a Court of Appeals, and accepts the view that a subsequent act of Congress, by mere implication in its mere title, did away with Art. 4 *bis*, which was not mentioned in said act. We have already pointed out the plain error in this view, and also the impossibility that any subsequent act of Congress could devest rights that a treaty had six months previously vested in the patentees affected by Art. 4 *bis*.

There have been before other courts several cases involving patents that Art. 4 *bis* of the Treaty perhaps might have affected; but these cases have been disposed of on other grounds, so that the Treaty has not been discussed at all in the opinions of the courts. For instance, in *Commercial Acetylene Co. v. Acme*, 188 Fed. Rep. 89, 90, the lower court says that he assumes "without consideration" that the patent in suit was not affected by the Treaty; for he finds as a fact that the foreign patent cited is not actually for the same subject-matter as the patent in suit. And in the same case on appeal, 192 Fed.

Rep. 321, 326-329, the Court of Appeals also finds that the foreign patent cited is not for the same subject-matter as the patent in suit, and so no mention whatever is made of the Treaty. This last mentioned case follows the Supreme Court case of *Leeds & Catlin Co. v. Victor Co.*, 213 U. S. 301, in which the decision rested upon the want of identity between the foreign patent and the patent claims sued upon, so that the Court had no occasion to discuss and did not in any manner mention the Treaty.

And there have been some other cases recently where patents that might have been affected by the Treaty have been before the courts, but there has been no discussion of the matter in the decisions of the courts, because the cases were completely disposed of on other grounds, such as non-infringement or as want of identity between the foreign and domestic patents in controversy. We think perhaps also there has been some disposition on the part of the courts to avoid discussion of this Treaty where it was not essential to the disposition of a case, because it has been widely known that the whole matter was likely to be authoritatively determined by the Supreme Court at an early day.

*Article 4 bis of the Treaty is in terms of self-executing law and not of a contract to legislate.*

In the just preceding review, it has been shown that in both the *Shoe Machine Co.* case and the *Hennebique* case, the only Court of Appeals cases that have discussed the Treaty, it has been stated that Art. 4 bis is on its face plainly self-executing.

It has been noted that the terms of said article read:

"Patents applied for in the different contracting States \* \* \* shall be independent of the patents obtained for the same invention in the other States \* \* \*.

"This provision shall apply to patents existing at the time of its going into effect.

"The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion."

And obviously the phrases "*shall be independent*" and "*shall apply*" and "*The same rule applies*" are the language of self-executing law and not of a contract to legislate.

Identically similar language, in various treaties, has repeatedly been held by the Supreme Court to be self-executing,—as the following instances illustrate:—

In *Chew Heong v. United States*, 112 U. S. 536, 539-540, 542, 543, it was emphatically held that the treaty clause

"*shall be allowed to go and come of their own free will and accord*"

was distinctly self-executing and immediately effective upon the proclamation of the treaty; and in respect to such treaty provision this Court said (112 U. S. 540):—

"A treaty that operates by itself without the aid of legislation is equivalent to an act of Congress, and while in force constitutes a part of the supreme law of the land. *Foster v. Neilson*, 2 Pet. 253, 314. Aside from the duty imposed by the Constitution to respect treaty stipulations when they become the subject of judicial proceedings, the court cannot be unmindful of the fact, that the honor of the government and people of the United States is involved in every inquiry whether rights secured by such stipulations shall be recognized and protected."

In *Foster, et al. v. Neilson*, 2 Pet. 253, 314-315, Chief Justice MARSHALL, after remarking that a treaty was primarily of the nature of a contract rather than a legislative act, further says:—

“In the United States a different principle is established. Our Constitution declares a treaty to be the law of the land. It is, consequently, to be regarded in courts of justice as equivalent to an Act of the Legislature, whenever it operates of itself without the aid of any legislative provision.”

And then he goes on to point out that a treaty clause reading

“shall be valid”

would be self-executing and not be the language of contract. And “*shall be valid*” is obviously language identically paralleling the phrase “*shall be independent*” in the Art. 4 *bis* under consideration in the case at bar.

And in *Orr v. Hodgson*, 4 Wheat. 453, 463-464, this Court holds that treaty clauses reading “*shall continue*” and “*shall be regarded*”, relating to the title to lands, are plainly self-executing, and that “the treaty applies to the title, whatever it is, and gives it the same legal validity,” etc. And here again there is most obvious parallelism with the “*shall apply*” and “*shall be independent*” of the Art. 4 *bis* under consideration.

In *Chirac v. Chirac*, 2 Wheat. 259, 270-271, 277-278, Chief Justice MARSHALL considered a treaty article that provided that subjects of France

“*shall enjoy*, on their part, in all the dominions of the said [United] States, an entire and perfect reciprocity relative to the stipulations contained in the present articles”.

And he held that the “*shall enjoy*”—which exactly

parallels the "shall apply" in the Art. 4 bis here—was self-executing,—saying

"we are all of opinion that the treaty between the United States and France, ratified in 1778, enabled the subjects of France to hold lands in the United States.

Upon every principle of fair construction, this article gave to the subjects of France a right to purchase and hold lands in the United States.

The terms of this instrument [the treaty] leave no doubt on this subject. Its whole effect is immediate. The instant the descent is cast, the right of the party becomes as complete as it can afterwards be made. The French subject who acquired lands by descent the day before its [the treaty's] expiration, has precisely the same rights under it as he who acquired them the day after its formation. He is seized of the same estate, and has precisely the same power to dispose of it. \* \* \* the Court is of opinion, that the treaty had its full effect the instant the right was acquired under it; that it had nothing further to perform; that its expiration or continuance afterwards was unimportant."

It may also be noted that the Supreme Court has plainly indicated, in the "Vichy" trade mark case that the "shall enjoy" in article II of the prior Industrial Protection treaty of 1883, which was an article giving equal rights to citizens and foreigners and related to *patents* as well as trade marks, was self-executing,—for the Court said (*French Republic v. Saratoga Vichy Co.*, 191 U. S. 427, 439):—

"If there were any doubts about the rights of the plaintiffs under the eighth article they are completely removed by the wording of the second. The rights of the French Republic are the same, and no greater under this article than those of the United States would be."

The "shall enjoy" wording occurred in this second article in the expression.

"The subjects or citizens of each of the contracting States *shall enjoy*, in all of the other States of the Union, so far as concerns patents for inventions," etc.

Indeed that treaty in a further general article, article 17, expressly provided that its execution should depend on subsequent "formalities and rules" of the constitutional laws only in those of the contracting States who "*are bound* to ask the application thereof,"—and we have already noted that in the United States the treaty-making power is plenary and is not at all "*bound to ask*" for subsequent legislation, the Constitution of the United States differing in that respect from the constitutional rule in some countries where a treaty can never be more than a contract to legislate—as Chief Justice Marshall stated in *Foster et al. v. Neilson, supra*.—

"In the United States a different principle is established. Our Constitution declares a treaty to be the law of the land. It is, consequently, to be regarded in courts of justice as equivalent to an Act of the Legislature, whenever it operates of itself without the aid of any legislative provision."

Thus in repeated instances treaty clauses paralleling the language of the article here under consideration, have been held to be plainly self-executing, and to have been immediately operative, upon the going into effect of the treaty, to secure individual private rights, such as the title to lands, and so forth. A particularly pointed instance is to be noted in *Jones v. Meehan*, 175 U. S. 1, 19-20, in which this Court said:—

"By the treaty with the Chickasaws of May 24, 1834, it was agreed, in article 5, that 'the

following reservations be granted in fee: To heads of families, being Indians or having Indian families' a certain number of sections of land; and, by article 6, 'also reservations of a section to each shall be granted to' other members of the tribe, of the age of twenty-one years and upwards, according to a list to be made out by seven chiefs named in the treaty, and filed with the agent, 'upon whose certificate of its believed accuracy the register and receiver shall cause said reservations to be located upon lands fit for cultivation.' 7 Stat. 451, 452. It may be observed that article 6, differing in these respects from article 5, used the future tense 'shall be granted', and omitted the words 'in fee.' Yet in *Best v. Polk*, (1873) 18 Wall. 112, this court held that the treaty itself conferred a full title upon an Indian to whom lands were reserved by article 6, and, again speaking by Mr. Justice DAVIS said: '*Can it be doubted that it was the intention of both parties to the treaty to clothe the reservees with the full title? If it were not so, there would have been some words of limitation indicating a contrary intention.* Instead of this, there is nothing to show that a further grant, or any additional evidence of title, were contemplated. Nor was it necessary, for the treaty proceeded on the theory that *a grant is as valid by a treaty as by an act of Congress, and does not need a patent to perfect it.* [Italics ours]. We conclude, therefore, that the treaty conferred the title to these reservations, which was complete when the locations were made to identify them.' \* \* \* \* \* 'By this language [of article 6 of the treaty], a title in fee passed to such persons as were above the age of twenty-one. The term "reservation" was equivalent to an absolute grant. The title passed as effectually as if a grant had been executed.' 'The treaty has not contemplated a further grant, or other evidence of title—showing conclusively that by the terms used it was intended that a perfect title was thereby intended to be secured'."

So here again the Supreme Court expressly holds that self-executing treaty terms may of themselves grant as perfect and sufficient a title as a "patent" to lands,—and obviously there is no distinction between a treaty granting a patent right to lands and a treaty granting (or confirming or extending) a patent right to an invention; for the power to grant patent rights to lands of the United States is by the Constitution neither more nor less specially delegated to Congress than is the power to grant patent rights to inventions. The second clause of Section 3 of Article IV of the Constitution gives to Congress the power to dispose of lands of the United States, by patent or otherwise,

"The Congress shall have power to dispose of and make all needful Rules and Regulations respecting the Territory or other Property belonging to the United States",

just as the eighth clause of Section 8 of Article I of the Constitution gives to Congress the power to reward inventors by granting patent rights or otherwise. And nowhere in the Constitution is the treaty-making power prohibited from also doing either of these things. Neither does this come within that provision of the Constitution which precludes the treaty-making power from doing of itself things that require raising a revenue—the provision that "all bills for raising a revenue shall originate in the House of Representatives." Nor is it as with the "sole" power that is given the Senate in other matters. As the Court of Appeals said in the *Shoe Machine Co.* case, referring to the Art. 4 *bis* under consideration, (155 Fed. Rep. 845),

"so far as the conventions pertinent here are concerned, the fact that the Constitution commits to Congress the power 'to promote the

progress of science and useful arts, by securing for limited times to authors and inventors an exclusive right to their respective writings and discoveries', is of no consequence, because all the powers of Congress are especially vested, either directly or indirectly, by the Constitution in similar manner; and to hold that a treaty could not abrogate a prior statute regarding patents because this particular legislative power is committed to Congress, could not be permitted so long as the general rule as to statutes superseding treaties, and, *vice versa*, declared by the Supreme Court in the way we have pointed out, exists".

And this is in consonance with what was said by the Supreme Court in *Geofroy v. Riggs*, 133 U. S. 258, 267:—

"The treaty power, as expressed in the Constitution, is in terms unlimited except by those restraints which are found in that instrument against the action of the government or of its departments, and those arising from the nature of the government itself and of that of the States. It would not be contended that it extends so far as to authorize what the Constitution forbids, or a change in the character of the government or in that of one of the States, or a cession of any portion of the territory of the latter, without its consent. *Fort Leavenworth Railroad Co. v. Lowe*, 114 U. S. 525, 541. But with these exceptions, it is not perceived that there is any limit to the questions which can be adjusted touching any matter which is properly the subject of negotiation with a foreign country."

And certainly there is nothing in the Constitution to forbid the treaty-making power from directly confirming or extending patent rights for inventions any more than there is to forbid the treaty-making power from directly confirming or granting, as it repeatedly has, private rights and title in and to lands of the United States.

Further, comparing the plain words of Art. 4 *bis* with the prior statutes relating to the same subject, it is obvious that the one is as plainly self-executing as the other. The old Sec. 4887 of 1874 said domestic patents

*"shall be limited"*

by the foreign patents. And the Treaty said they

*"shall be independent"*.

And obviously the latter phrase is as self-executing as the former. And again,—when the Act of 1897 wiped out the limiting clause of the old Sec. 4887, and left domestic patents independent of foreign patents, the Sec. 8 of that Act said that this amendment

*"shall not apply"*

to existing patents. And then the subsequent Treaty said that the independence

*"shall apply"*

to existing patents. And obviously the latter phrase is just as self-executing as the former. If *"shall be limited"* is law in the older statute, *"shall be independent"* is law in the subsequent Treaty; and if *"shall not apply"* is law in the amending statute, *"shall apply"* is also law in the subsequent Treaty.

Thus it is plain that when Art. 4 *bis* declared that domestic and foreign patents *"shall be independent"* and that this *"shall apply"* to existing patents (and also *"applies"* to patents already existing on both sides in the case of the adhesion of new States to the Treaty), it acted directly and immediately, when the Treaty went into force (September 14, 1902), to do exactly what the definite words say—to relieve existing domestic patents of the only dependence they had, or ever had had, on foreign patents to the same inventors for the same inventions, the dependence expressed in the term-limiting clause in the old

section 4887 of 1874. And there is no possibility of agreeing with the remark made in the *Shoe Machine Co.* case to the effect that the treaty "paragraph relied on is obscure, because there are so many different aspects in which a patent, or anything, may be independent of or dependent on something else", —for this remark in that case obviously overlooks the fact that long ago the decisions of the Supreme Court established that absolutely the only dependence imposed upon domestic patents by the term-limiting clause in said Sec. 4887 of 1874, was the limitation of term to the maximum normal term of the foreign patent concerned, and that any nullity or premature lapsing of the foreign patent would not in any manner shorten the term of the domestic patent (*Pohl v. Brewing Co.*, 134 U. S. 381, 386-387). Only one form of dependence existed between such domestic and foreign patents, the dependence on the expiration, by lapse of time, of the normal term of the foreign patent; but, of that limitation the domestic patents (applied for before 1898) were not "independent" until Art. 4 bis of the Treaty declared and made them independent on September 14, 1902. Thereupon such domestic patents came into the full benefit of the seventeen years term named in the grant on the sealed face of each of them and expressly accorded to them by the still effective and unrepealed Sec. 4884 of 1874, the section that provides a seventeen year term for all United States Patents.

The clause of Sec. 4887 of 1874 that Art. 4 bis repealed as to those domestic patents which were still affected by it, was:—

"But every patent granted for an invention which has been previously patented in a foreign

country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term,"

but there still remain in force as to these domestic patents (applied for before 1898), the rest of Sec. 4887 and also Sec. 4884, as follows:—

"Sec. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. \* \* \* \* \* and in no case shall it be in force more than seventeen years.

Sec. 4884. *Every patent shall contain* a short title or description of the invention or discovery, correctly indicating its nature and design, and *a grant to the patentee, or his heirs or assigns, for the term of seventeen years*, of the exclusive right to make, use and vend the invention or discovery throughout the United States, and the territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof."

And under these still remaining statutory provisions (which were left in force by Sec. 8 of the Act of March 3, 1897, amending Sec. 4887, and were also unaffected by the Treaty), the seventeen year term of the patents in question stands unlimited by, and independent of any relation to, the term of any foreign patent.

*That the plain words of Article 4 bis determined the above-stated independence, and gave to the existing domestic patents the full term they would have without the former limitation by the terms of foreign patents, is also shown by the preliminary negotiations that culminated in the Treaty of Brussels as finally ratified and promulgated.*

As there is actually no ambiguity whatever in the plain words of Art. 4 *bis* of the Treaty, it is of course not at all permissible to go back into and give any controlling force to any of the preliminary discussions that led up to the final conclusion of the Treaty in the form in which it was ultimately ratified and put into effect. But as these preliminary discussions were referred to in both the *Shoe Machine Co.* case and the *Hennebique* case, and are not stated with entire clearness in either of those cases, it may be worth while to review briefly what actually occurred, for it serves to show that the framers of the Treaty knew that the actual words finally left standing in Art. 4 *bis* meant exactly what we have said those words mean.

While, as we have just said, it is not necessary that the court consider these preliminary proceedings that culminated in the Treaty, a full record of them may be found, if of interest, in the publication of the International Bureau of Berne, entitled "Union Internationale pour la Protection de la Propriété Industrielle. Conférence de Bruxelles Décembre 1897 et Décembre, 1900", which is on file at the State Department, and the pages of which are hereinbelow referred to.

The narrative sequence of events was as follows:—

Back in December of 1897, three years before the final Treaty was, at a later conference, agreed upon, there was held at Brussels a preliminary conference at which some of the provisions that were later put into the final Treaty were drawn up. This preliminary conference was held between December 3 and December 14, 1897.

At pages 31, 41 of the above mentioned record (Conf. Brux.) of the proceedings there appears a provisional program of advance proposals worked out by the International Bureau, with an explanation of purposes and propositions, and under the heading "Reciprocal Independence of Patents" there appears a statement of the purpose of the provision that ultimately became Art. 4 *bis*. The new article is designated "Article 4 *ter*", but its text is substantially identical with the Art. 4 *bis* of the final treaty. And in the prospectus we find it stated of this new article that

"The proposed provision tends to eliminate the effects of a limitation contained in several legislations, and according to which the duration of a patent is limited by that of a patent delivered previously for the same invention in another country. \* \* \* \* \* \* \* \* \* the reciprocal independence of patents, has been admitted without opposition by the Conferences of Rome and of Madrid [which had to do with the prior treaty of 1883]. \* \* \* \* \*

"There exists, however, a difference between the proposed provision and paragraph III of the Protocol IV adopted by the Conference of Madrid. In the latter, the reciprocal independence was only established between patents applied for, for the same invention, during the priority limit established by article 4 of the Convention. *The new article, on the contrary, should be applied to all existing patents, whatever the date on which they were delivered.* \*

[Here follows a statement of the more restricted action at the prior Conference of Madrid.] \* *But it now being a question of modifying the Convention, it is possible to go further and to grant this principle in a definite manner, that patents delivered upon the territory of the Union are absolutely independent from each other as to their duration.* And matters being thus settled, it is evident that neither will patents taken outside of the Union be able to influence those which will have been secured in its limits.

“The realization of this reform should naturally be accomplished by a provision which may be applied to *patents existing, either at the time of the enactment of the modified text or upon the adhesion of a new member to the Union.* It would be harsh, in fact, to deprive quite a large number of patent holders of this favor, whose rights are still valid, and who, consequently, may lawfully ask to take advantage of the improvements introduced in the convention.”

(Italics ours.)

And then follows the text of the proposed “Art. 4 ter” that, as we above said, is substantially identical with the final text of Art. 4 bis, containing the declaration that patents applied for, for the same invention, in the different contracting States, will be independent of each other, and the same clause

“This provision shall apply to *patents existing at the time of its going into effect*”

and also the clause that the same rule *applies to patents already existing* on both sides at the time of the adhesion of new States to the Treaty.

Thus the official prospectus of the Conference unequivocally declares in the foregoing extended quotation from it,—that the purpose of the text, modifying the prior convention and that became Art. 4 bis of the later Treaty, is to make “*all existing patents, whatever the date on which they*

were delivered \* \* \* absolutely independent from each other as to their duration" and applies to "patents existing either at the time of the enactment of the modified text or upon the adhesion of a new member to the Union." With this declaration the Conference proceeded.

On Friday, December 3, 1897, at the first meeting of the Conference, the new article was reported *unanimously* by the Committee thereon and was adopted (Conf. Brux., pp. 181, 183) identically as Art. 4 *bis* ultimately went into the Treaty (although it was then designated "Art. 4 *ter*").

On December 13, 1897, at the ninth meeting of the Conference, it was proposed (Conf. Brux., p. 307) that a Protocol, evidencing the various propositions agreed to by the Conference, should be signed, for purposes of submission by the delegates to their respective governments, the Conference adjourning meanwhile,

"in order to permit diplomatic negotiations to ascertain the probability of unanimous accord."

And then, later in the same meeting on December 13, 1897, the minutes note that (Conf. Brux., p. 311)

"The new article relative to the reciprocal independence of patents is *unanimously* agreed to. This article, which will bear the number 4 *bis*, is expressed in the following terms: [quoting identically the text that became Art. 4 *bis* of the Treaty finally made three years later]."

On the next following day, December 14, 1897, at the eleventh meeting of the Conference (Conf. Brux., p. 331) one of the delegates from the United States raised the objection that the Art. 4 *bis*, which had been *unanimously* adopted at the session of the previous day, would "receive objections on the part

of the American Government, objections of such a nature as to retard the signing of the additional act" because the provision that "the new order would apply 'to patents existing at the time of its going into effect' would have a retroactive effect" and, said the delegate, "in the United States the law cannot have a retroactive effect". And the delegate inquired if the new Art. 4 *bis* could not be made the subject of a *special Protocol*.

Of course the delegate was mistaken in supposing that a provision would not be a good and valid law in the United States when its retroactivity merely amounted to the extending of the term of an existing patent. It has always been within the legislative power to extend the term of any United States patent. Such retroactivity does not invalidate any law relating to United States patents, because the extending of the life of an existing patent obviously does not deprive the patentee, or his legal representatives or assigns, of any property right vested by the patent, and while a patent is still existing no one can acquire any vested property right in the patented invention except through the patentee or his legal representatives or assigns. As this Court said in *McClurg v. Kingsland*, 1 How. 202, 206, changes made in the patent law after the emanation of a patent "*may be retrospective in their operation*" and yet "*that is not a sound objection to their validity*", provided that they "*do not take away the rights of property in existing patents*", which of course is not done when an existing patent is merely extended as to its term. Until an invention is patented, and after its patent has expired, it is as free to all men as are the waves of the high seas, and is

as ownerless, save that the inventor may ask the sovereign power of government to hew out of such public domain a limited term for which he alone may enjoy the use of the invention; and the sovereign power may grant whatever term it sees fit, and may extend that grant without violating any principle of non-retroactivity—for such extension does not devest any property right in the invention that has already vested in any one. And both of the Courts of Appeals that have discussed this Art. 4 *bis* have agreed that a law would not be invalid for retroactivity when its retroactive action merely amounted to extending the term of existing patents.

But passing over this plain error of the delegate, at this meeting of the 1897 Conference, in suggesting that a law extending the term of a United States patent would be invalid for retroactivity,—the point of interest is that the delegate clearly recognized that the text of Art. 4 *bis*, identically as it was three years later embodied in the Treaty finally promulgated, was a text that plainly wiped out all shortening of the seventeen year term of existing United States patents.

In response to the above-mentioned inquiry of the American delegate, as to whether "article 4 *bis* could not be made the subject of a *special Protocol*", the President of the Conference (Conf. Brux., p. 331), at this same meeting on December 14, 1897, inquired of the Conference whether it would be agreeable to modify the text of article 4 *bis*, or whether it would be sufficient to mention in the minutes of the meeting the reservation suggested by the American delegate.

The American delegate said that the matter ought

to be clearly understood. And he further explained that the then recent Act of Congress of March 3, 1897, which would go into effect at the end of that present month, December, 1897, provided that United States patents thereafter applied for would not have their seventeen year term limited by any foreign patent, but also provided that existing patents

"remain dependent so far as their term is concerned, upon the corresponding foreign patent taken out for the same invention;"

and he again repeated that the retroactive effect of Art. 4 *bis* would remove this dependence from existing patents and such retroactivity would be objectionable in the United States.

The delegate from Belgium then suggested that Art. 4 *bis* was designed only to produce effects after the patent issued and not to retroactively modify the previously fixed term of the patent.

But the American delegate evidently saw that this was a mere argumentative suggestion contrary to the already declared purpose of the article, for he immediately again insisted that it would be necessary to state the point very precisely if the new act were to be accepted by the United States.

Another delegate, the director of the International Bureau, then called "attention to the object aimed at by the Conference in voting article 4 *bis*". (We have already quoted the statement of this object, as made in the prospectus program of the Conference,—and obviously the object was to secure the complete independence as to existing patents as well as future patents.) And the director then suggested that to give satisfaction to the American delegate the paragraph reading

"This provision shall apply to patents in existence at the time of its going into effect" should be amended by adding a clause reading "its effects are, however, limited to nullities and lapses which would affect anterior patents".

But the delegate from France objected to such amendment, remarking that

*"the reciprocal principle of independence being admitted, it is not advisable to restrict the same by new provisions".*

The delegate from Belgium again suggested that Art. 4 bis as it stood would relate only to lapses and nullities.

But the delegate from France said that

*"the independence has the precise effect of superseding all relations between the various patents and leaves to each national law the care of regulating all matters pertaining to patents taken out in the country".*

Then the other American delegate asked if the paragraph of Art. 4 bis, as to existing patents, could not be amended by adding the words

*"however the term fixed by the internal law of each country remains intact."*

But the Conference evidently did not wish to amend the paragraph, for the President then proposed, apparently as a compromise suggestion, that the text of Art. 4 bis should be left without any change, and that it be merely stated in the minutes of the meeting that the article should receive the interpretation that the American delegates desired.

The American delegate replied that this suggestion would be satisfactory

*"if it meets with the unanimous adhesion of the Conference".*

For he evidently realized that such a mere entry on the minutes would be of no effect whatever without "*unanimous adhesion*" of the entire Conference. But the immediately succeeding record shows that such "*unanimous*" adhesion was *not* obtained.

The delegate from Sweden, evidently also seeing the idleness of such a mere entry in the minutes, said that an amendment ought to be made to Art. 4 *bis* itself.

And the delegate from Great Britain immediately insisted that in view of the reciprocal equal privileges the Convention was aiming to secure between the citizens and subjects of the different States, the subjects of Great Britain were entitled to a full *seventeen* years term for their United States patents.

Then the delegate from Belgium seconded the suggestion of the President as to making the mere entry in the minutes of the meeting; and the President put to a vote the adoption of the same text previously adopted for Art. 4 *bis*, with the interpretation which the American delegation desired in proposing to complete the second paragraph by the explanatory clause

"However, the term fixed by the internal law of each country remains intact".

But though the minutes of the meeting record that "article 4 *bis* is definitely adopted with these conditions", the amendatory clause was actually never in any manner added to Art. 4 *bis* itself, nor in any manner appended to the treaty. And immediately, as the same minutes further record, the delegate from Great Britain entered his protest as follows:

"The Very Honorable C.-B. Stuart Worley [delegate from Great Britain] remarks that he could take the indicated act of interpretation

*only as a declaration of the American delegation, and not as a decision of the Conference."*

And yet the American delegation made no further effort to obtain the "*unanimous*" adhesion which they had thus failed to obtain, and which they had declared would be necessary to make any effective modification of the plain words of Art. 4 *bis* as it stood.

And then in a report as to the Conference, dated the next day, December 15, 1897, which the American delegates addressed to the Secretary of State of the United States, these delegates entirely ignored the express protest which the delegate from Great Britain had made, and, saying nothing about such protest, reported that it was the "*unanimous*" sense of the Conference that Art. 4 *bis* would not affect existing United States patents but had to do only with such existing foreign patents as would be limited in term by the nullity or premature lapsing of patents in other countries. This report was of course plainly wrong, because such "*unanimous*" consent had *not* been obtained, the delegate from Great Britain having expressly declared that he could take the interpretive entry on the mere minutes

*"only as a declaration of the American delegation, and not as a decision of the Conference."*

But the erroneous report of the American delegates is also inconsequent because the 1897 session of the Brussels Conference did not result in the making of a treaty between the Sovereign States, and afterwards three years elapsed, and other matters transpired, before a long subsequent session of the Conference, in December, 1900, finally consummated and signed the Treaty of Brussels that was actually, in 1901 and 1902, ratified and put into effect. But

if it were attempted to give any force to the above-mentioned erroneous report of the American delegates from the long prior Conference session of 1897, the situation would plainly deserve the remark made in reference to it in the *Hennebique* case, at 172 Fed. Rep. 883:—

“There is no better example of the uncertainty introduced, when parole evidence is resorted to, to control the effect of a written instrument, than is afforded in the present instance. By the plain terms of the article [4 *bis*] foreign and domestic patents are rendered independent, and this provision is expressly made to apply to existing patents without any apparent restriction or qualification; complete independence being substituted for the previous interdependence by which up to that time they had been hampered.”

The whole matter is further disposed of by what subsequently happened, before any treaty was actually made.

In a report made Nov. 27, 1900, by a commission appointed in 1898 to advise Congress of any changes that appeared to be needed to bring our patent statutes into harmony with the prior treaties of 1883 and 1891, and with the protocol drawn up at the 1897 Brussels Conference (but which had not then eventuated in any treaty), the commissioners, in referring to the proposed Art. 4 *bis*, said that

“It provides that patents granted in the different countries ‘shall be independent’; that is, *shall not be limited in terms by the term of any patent previously taken out in another country*, and shall not be made void by the forfeiture of a patent in another country.”

And it will be noticed that the clause we have here italicized sets forth the *retroactive operation* of Art.

4 *bis*, while the clause following it refers only to the prospective operation of preventing a term being shortened by mere premature lapse of a foreign patent. And both of these things are thus declared to be included in the operation of Art. 4 *bis*. Further, the commissioners say that this proposed Art. 4 *bis* "*is directly in line with the change in our law*" in the Act of Mar. 3, 1897,—and yet the only independence of foreign patents that that law had introduced was as to removing the limitation of domestic patents by the normal term (not the premature lapsing) of foreign patents. And then the commissioners make no suggestion of any need for changing our statutes to effectuate the Art. 4 *bis*,—evidently because the Act of Mar. 3, 1897, had already taken care of all patents issuing on applications filed after 1897, and the Art. 4 *bis* would itself take care of all other existing patents when the Treaty went into effect, and thereafter there would be nothing further to be done under Art. 4 *bis* as a matter of administrative law in the granting of patents, and it was not to be supposed that the courts would ever fail to give that self-executing article the force of law if it ever came before them.

Three years had passed without any treaty coming out of the Conference session of 1897. Then another session of the Conference was held at Brussels in December, 1900. The personnel of the American delegation was changed, two new delegates—one of them the new Envoy and Minister, the Hon. Lawrence Townsend—replacing one of the former delegates.

And the minutes of the sitting held on December 12, 1900, show (Conf. Brux., p. 388) that the Direct-

or of the International Bureau, M. Morel, declared in the Conference that Art. 4 *bis* of the convention is and is intended to be *retroactive* in its effect; and the American delegation made no objection, and the article was adopted as a part of the final Treaty submitted for ratification by the respective governments. And the American delegation to the 1900 Conference made no reference whatever to the article when they reported to the State Department the final Treaty actually signed by all of the delegates at Brussels on December 14, 1900. The declaration as to the retroactive character of Art. 4 *bis*, at this Conference in December, 1900, is found in the following extract from the minutes of the above mentioned meeting on December 12, 1900 (Conf. Brux., p. 388) :—

“M. Le Commandeur Gabba, Delegate from Italy, recalls that he would like to see it established that the respite of priority of twelve months is *applicable to those patents issued before the going into effect of the new act* for which the respite of priority of six months actually existing would not yet have expired at the time of this going into effect.

M. Morel, Director of the International Bureau, declares himself absolutely in sympathy with this idea, which could be interpreted by an arrangement *inspired by article 4 bis of the convention*.

The Honorable Representative of the International Bureau recalls that the delegate from Portugal has raised an analogous question in regard to number 3 *bis* of the Protocol de clôture. There also, says M. Morel, the introduction of a retroactive arrangement could have its usefulness.

*There would then be in the convention three arrangements concerning retroactivity: one in Article 4, another in Article 4 bis, the third number 3 bis of the Protocol de clôture.” (Italics ours).*

A provision affecting mere future contingencies that might befall patents would be prospective and not "retroactive." And it was the "retroactive," not prospective, operation of Art. 4 *bis* that had been debated back in the three years prior session in 1897. Whence it conclusively appears that the understanding of Art. 4 *bis* when, in December, 1900, the Treaty was actually made and signed by the delegates to the final Conference at Brussels, was exactly what we have pointed out the plain words of that article mean—that "*shall be independent*" and "*this provision shall apply to patents existing*" are a plain and simple retroactive ending of the former dependence of existing domestic patents upon the running of the terms allowed to foreign patents. It would be a mere idle misuse of words to declare existing domestic patents "independent" of foreign patents, if it were intended that the domestic patent should still die at the end of a term short of the normal term of domestic patents and fixed only by the length of the term allowed to a foreign patent.

No protocol in any way limiting Art. 4 *bis* was annexed to the Treaty when it was finally adopted at Brussels in 1900; and no protest was made against Art. 4 *bis* by the Government of the United States, and the article was ratified by the Senate and proclaimed by the President without any qualification whatsoever.

It might also be remarked that only two days after the Treaty of Brussels went into effect, the International Union for the Protection of Industrial Property, at the Convention of Turin, held September 16th to 18th, 1902, passed the following resolution:—

"The independence of patents, proclaimed by the Additional Act of Brussels, ought to be construed in the broadest sense, and particularly in such manner that the term of a patent shall not, in any case, be dependent upon the term of another patent."

This is at least of interest as a forcible declaration of the actual intention of the high contracting parties to the Treaty.

From the foregoing review of the events that led up to the final conclusion of the Treaty between the contracting powers, it is clear that the conferees who framed the Treaty fully realized that the plain words of Art. 4 *bis* mean exactly what we have said they mean. It was the simplest matter possible to modify the language of Art. 4 *bis* if the final Conference over the Treaty wanted the article to mean something else. But no change was made, and certainly the article will not now be amended by the courts. It could not be done for a private contract, and still less could it be done for a solemn international contract such as a treaty.

Some of the remarks made in the *Shoe Machine Co.* case and the *Hennebique* case, indicate that in those cases an effort was made, in the defense, to have the Court somehow modify the plain words of Art. 4 *bis* by some sort of construing of the proceedings at the preliminary conferences; but neither of the Courts of Appeals did no. In the *Shoe Machine Co.* case the Court based its opinion on the proposition that a *subsequent* Act of Congress had somehow resulted in preventing the Treaty from having the effect that the plain words of Art. 4 *bis* import. And in the *Hennebique* case there was an emphatic refusal to engraft upon Art. 4 *bis* a meaning contrary

to its plain terms, and the following pertinent remarks were made (172 Fed. Rep. 885) :—

“Upon being ratified by the States participating in the conference, in the form in which it was so cast, it [Art. 4 *bis*] became the treaty law between them, mutually governing their citizens and subjects, to be interpreted according to the terms in which it was couched, unaffected by any reservation or explanatory restriction not expressed in it. A treaty is a contract and is to be so construed as to carry out the *apparent* intention of the parties as disclosed by *its terms*. *Geofrey v. Riggs*, 133 U. S. 258, 10 Sup. Ct. 295, 33 L. Ed. 642. Where the words have a definite meaning, and there is no contradiction between the different parts of it, the meaning deduced from the face of the instrument is the one to be taken, and courts are not at liberty to add to or detract from it. Or, in other words, the meaning is to be ascertained by the same rules of construction and course of reasoning as are applied to the interpretation of private contracts. 28 Am. & Eng. Ency. Law, 488. *Tucker v. Alexandroff*, 183 U. S. 424, 437, 22 Sup. Ct. 195, 46 L. Ed. 264. With due deference, therefore, to the apparent position to the contrary taken at the first [1897] session of the Brussels Conference, it is not to be thought of that a treaty ratified and confirmed by the participating powers in a definite and unambiguous form can be limited or qualified by a resolution passed at a preliminary conference, which is not by reference or otherwise incorporated into or made a part of its terms, so as to be submitted to the different countries called upon to consider and ratify it. Where qualifications are found necessary, after a treaty has been formulated, if the text is not changed, they are brought in by way of explanatory protocols at the end, as is shown by the treaty of 1883 in question, where a number of them will be found. And this may have been what Mr. Forbes [one of the American delegates] had in mind, when he proposed a special protocol against article 4 *bis* being given a

retroactive effect. And, had this course been pursued, it would have removed all difficulty. But unfortunately it was not. And a mere resolution on the minutes of the Conference cannot be held to take its place."

And the matter is still further cleared, as we have indicated, by the fact that even at the first Conference, in 1897, there was *not* the "unanimous" adhesion the American delegate had asked, to the mere interpretive entry in the minutes, for the delegate from Great Britain insisted that such entry was *not* "a decision of the Conference"; and then three years later, at the final Conference of 1900, the Director of the International Bureau expressly declared, without objection from the American delegation, that Art. 4 *bis* was "retroactive" as to existing patents. And thereafter the United States ratified Art. 4 *bis* without objection or amendment.

In *Little v. Watson*, 32 Me. 214, 223, there was an able consideration of a contention that prior negotiations should be resorted to for a limiting of the general terms in which a class of land grants had been made in a treaty, and the court very properly held that (as is well summed up in the Syllabus, p. 214) :—

"When the language used in a treaty clearly declares a fact, or grants, confirms or defines a right, it must be effectual, even if found to be inconsistent with the purpose disclosed by the correspondence which preceded it."

And still more does the principle of not limiting a plain general grant by reference to prior negotiations hold good where, as we have seen in the present case, the whole primary purpose was to give the plain words of the Treaty their full force, and notwithstanding some attempt to introduce limitations at the earlier conference, the attempt failed of

unanimity and was never repeated, and the three years later session of the conference reiterated the broad primary purpose of retroactivity and concluded the Treaty without suggestion of any of the very simple verbal changes which could have been made, by amendment or annexed special protocol, if it had been desired to limit in any manner the broad terms actually used and finally ratified.

It may also be considered, for instance, how the States from time to time newly adhering to the Treaty would be wrongfully misled by the last paragraph of Art. 4 *bis*, the clause reading

“The *same* rule applies, in the case of adhesion of new States, to *patents already existing* on *both* sides at the time of the adhesion”, if the immediately preceding clause were to be limited by something not expressed in it but drawn from some prior negotiations. The newly adhering State would be under no obligation, moral or legal, to search back into the prior negotiations, but would be entitled, by every tenet of contract and international law, to assume in good faith that the Treaty meant only what its own plain words expressed,— and the newly adhering State so misled would justly be able to say what the Supreme Court said about an attempt made to limit a treaty by Senate resolutions that were passed when it was ratified but were not expressed in it (in *New York Indians v. United States*, 170 U. S. 1, 22-23) :—

“There is something, too, which shocks the conscience in the idea that a treaty can be put forth as embodying the terms of an arrangement with a foreign power or an Indian tribe, a material provision of which is unknown to one of the contracting parties and is kept in the background to be used by the other only when the exigencies of a particular case may demand it.”

And this of course suggests but one of the manifold

reasons for the elemental rule of contract law that (Wigmore on Evidence, V. 4, Sec. 2425) :—

“When a legal act is reduced into a single memorandum, all other utterances of the party are legally immaterial for the purpose of determining what are the terms of their act.”

The remarks of Mr. Justice Story, speaking for the Supreme Court, in *The sabella*, 6 Wheat. 1, 71-72, are pertinent here:—

“In the first place, this court does not possess any treaty-making power. That power belongs by the Constitution to another department of the government; and to alter, amend, or add to any treaty, by inserting any clause, whether small or great, important or trivial, would be on our part a usurpation of power, and not an exercise of judicial functions. It would be to make, and not to construe a treaty. Neither can this court supply a *casus omissus* in a treaty, any more than in a law. We are to find out the intention of the parties by just rules of interpretation applied to the subject-matter; and having found that, our duty is to follow it as far as it goes, and to stop where that stops—whatever may be the imperfections or difficulties which it leaves behind. The parties who formed this treaty, and they alone, have a right to annex the form of the passport. It is a high act of sovereignty, as high as the formation of any other stipulation of the treaty. It is a matter of negotiation between the governments; the treaty does not leave it to the discretion of either party to annex the form of the passport; it requires it to be the joint act of both; and that act is to be expressed by both parties in the only manner known between independent nations—by a solemn compact through agents specially delegated, *and by a formal ratification.*”

It is idle to suggest that any court shall so construe Art. 4 *bis* as to leave in any manner dependent

the existing patents that the plain words of the Article declare "shall be independent" of foreign patents.

**The Act of Congress of March 3, 1903, 32 Stat. L. 1225, six months subsequent to the going into effect of the Treaty, did not affect Article 4 bis.**

As we have already indicated, in the Statement of the Case, it would in any event be impossible for any subsequent Act of Congress to divest the property right, in and to the remainder of a seventeen year term, that had vested in the patentees of existing patents immediately that Art. 4 *bis* went into effect on September 14, 1902; and we will presently refer again to that plain proposition in more detail. It actually entirely disposes of any real need for considering the Act of March 3, 1903, at all; but in view of the fact that much was said about that Act, and some supposed effect of it, in the *Shoe Machine Co.* case in the Court of Appeals of the First Circuit, we may here, though it is perhaps a mere digression, point out more fully that, as we have already briefly indicated, the Act of March 3, 1903, did not have, and was not intended to have, any effect whatever upon Art. 4 *bis*.

Nowhere in the body of the Act of March 3, 1903, is there to be found any reference or allusion, directly or indirectly, to the subject-matter of Art. 4 *bis*. The entire Act is simply absolutely silent with respect to Art. 4 *bis*. But in the *Shoe Machine Co.* case the Court of Appeals of the First District advanced the proposition that the said Act of 1903 in effect abrogated Art. 4 *bis*, simply be-

cause said Act was entirely silent about that Article and yet was entitled

"An Act to effectuate the provisions of the additional act of the international convention for the protection of industrial property." (The said "additional act" being the Treaty of Brussels).

And the Court in the *Shoe Machine Co.* case, held that because of the wording of this mere title, any part of the Treaty that was not provided for in the body of this Act of 1903 would be ineffective and so virtually abrogated,—and as *Art. 4 bis* was nowhere mentioned in the body of the act of 1903, *Art. 4 bis* has been a mere nullity in the United States.

Obviously this was giving a most impossible force to the mere title of the Act of 1903.

Of course, where the body of an act is ambiguous in respect to any matter actually contained therein, the title of the act may be resorted to if it can give any aid in clearing the ambiguity. But to say that the body of the Act is ambiguous as to *Art 4 bis* when it has nothing whatever in it about that article, is just as impossible as to say that a man is ambidextrous who has no hands.

The mere title cannot be used to import into the body of the act a matter upon which the body of the act is absolutely silent. The title itself may be too broad, or may be inapt, or may itself be ambiguous,—but ambiguity in the mere title of an act does not give that title a force which the body of the act does not have.

The whole proposition is disposed of in the statement of the Supreme Court in *United States v. Oregon, &c. Railroad*, 164 U. S. 526, 541:—

"The title is no part of an act and cannot en-

*large or confer powers, or control the words of the act unless they are doubtful or ambiguous. United States v. Fisher, 2 Cranch. 358, 386; Yazoo & Mississippi Railroad v. Thomas, 132 U. S. 174, 188. The ambiguity must be in the context and not in the title to render the latter of any avail.*" (Italics ours.)

And there is no ambiguity in the context, for, as we have said the body of the act has nothing whatever to say about Art. 4 *bis*. But in the *Shoe Machine Co.* case, the Court of Appeals quotes a statement from the ruling of the Supreme Court in *Dallemagne v. Moisan*, 197 U. S. 169, 175, and then says, at 155 Fed. Rep. 848:—

"Fairly paraphrasing the language of the Supreme Court cited, we may say that the statute of 1903, having been passed for the purpose of executing treaties, must be regarded as expressing the only effect which Congress intended they should have to the extent of the subject matters to which the act relates."

This is wholly beside the mark,—because Art. 4 *bis* is not referred to in the body of the statute at all. Nor is it mentioned in the title, unless the title be regarded, by a stretch of implication, to refer necessarily to everything in the Treaty. And then the suggested "paraphrasing" of the language of the Supreme Court does not "fairly" paraphrase what the Supreme Court either said or meant in the case of *Dallemagne v. Moisan* referred to. For upon examining said case, it will be found that the force the Supreme Court there gave to the title of an act was simply the following:—A clause in a treaty had provided that certain matters should be referred to "local authorities" at certain places, and then a later statute, intended as an act to effectuate that treaty, had specified and defined what "local author-

ties" should be resorted to. Obviously this was a mere direct defining, by Congress, of the "local authorities" referred to in the Treaty, and was an utterly different matter from undertaking to construe the mere title of an act as by mere implication abrogating an entire treaty clause upon which the body of the act was wholly silent.

The several other cases cited in this connection in the *Shoe Machine Co.* opinion were still further beside the mark, as we may here note:—in *The Bark Eudora*, 190 U. S. 169, 172-3, the Supreme Court, though remarking that the title may sometimes aid the interpreting of ambiguous language in the body of the act, nevertheless expressly held that the words "American seaman" in the title of an act would not exclude provisions for "foreign seaman" contained in the body of the act,—and this, if pertinent at all, is obviously against instead of in support of the proposition in the *Shoe Machine Co.* case. And in the other cited case of *Rogers v. United States*, 152 Fed. Rep. 346, 350, all the court actually did was to construe the word "aliens" as meaning "immigrants" in an act whose title referred to immigrant aliens in the same sense in which the whole body of the act plainly intended the word "aliens"; so that the title was merely very properly resorted to to help clear an evident ambiguity in the use of the word "aliens" in the body of the act,—and this again is a far cry from making the title of an act abrogate by mere implication a treaty-clause which the body of the act in no manner mentions.

The body of the Act of 1903 was devoted merely to bringing into harmony with the Treaty several statutes that prescribed matters of administrative

law relating to future patent applications, and as to which future applicants for patents, as well as the administrative officers of the Patent Office, would be in confusion between conflicting provisions of the Treaty and the former Statutes. And in fact part of the Act related to matters that had no apparent connection with the Treaty,—a circumstance that is a further commentary upon the inaptness and uncertainty of the mere title as a guide to the scope of the enacted law.

There was no need for the act to provide anything as to Art. 4 *bis* of the Treaty, because all that ever could be accomplished by that article had been accomplished the instant the Treaty went into effect, and there was nothing further to be done as a matter of administrative law. The patents affected were all patents that had already been issued and that already had the "seventeen years" term written in the grant on the sealed face of each of them. No change had to be made in any one of them by any executive officer of the Government. A mere disability had been lifted from them,—a disability that was not expressed in them but to which the courts, upon proper evidence, could hold them if the seventeen year term named in their sealed grants were disputed. The treaty had secured to them this stated seventeen year term, and no further legislative or executive act was required. And no future patent applications were concerned with Art. 4 *bis*, because their independence of foreign patents had long before been settled by the Act of March 3, 1897, which amended the old section 4887 some years prior to the Treaty.

The just above indicated limitations of the Act

of March 3, 1903, will be apparent upon noting the subjects of its four sections:—Section 1 merely provides for bringing an older statute into harmony with that section of the Treaty which related to the so-called "periods of priority" within which an application filed in one country secured the right to file in other countries irrespectively of any intervening publication or public use, etc.,—and here there was plain need for remedying such confusion as would arise from the fact that the old statute, purporting to determine filing rights, named "*seven*" months for the period of priority that the treaty had changed to "*twelve*" months,—and this was confusing both to future applicants and to the executive departments. Section 2 merely provides for the manner of making oath to future applications when the applicant is resident in a foreign country; and so this also relates to future administrative procedure. Section 3 merely provides for the action of the foreign executors or administrators of applicants whose death may occur while they are domiciled abroad; and so this also relates to future administrative procedure. And the remaining section, section 4, merely provides for a correction in the old statute relating to caveats, changing the words "citizen of the United States" to read "person," so that that statute on caveats might be consistent with what the treaties had already provided, thereby saving the confusion that might occur in further administrative procedure under the caveat privileges of the Patent Office. This last section was especially needed because of the manner in which the Patent Office had been led astray by the opinion of Attorney General Miller, years previously, as to caveat provisions of the older Treaty of 1883,—the opinion which, as we

have already pointed out, made the plain error of assuming that a self-executing treaty-clause could not operate upon patents because the Constitution gave "Congress" power to make patent laws—over-looking the fact that the treaty-making power was in no manner prohibited from dealing directly with patents also, as we have already pointed out.

Among the strained arguments that have been advanced in the effort to nullify the effect of Art. 4 *bis*, another has been to the effect that in a speech made by the chairman of the committee on patents in the House, *five months after the Treaty went into effect*, he said, in support of the then proposed Act of March 3, 1903, that the said Act did not extend any patent terms. Of course it did not,—for all the extending that was to be done had become an accomplished fact when the Treaty went into effect on September 14, 1902, five months before he made this speech. And even if he had meant to imply anything contrary to the Treaty, obviously a mere speech in Congress will not import into a subsequent Act an implied abrogation of a long prior treaty-clause as to which the Act is entirely silent.

The whole proposition of the *Shoe Machine Co.* case as to the effect of the Act of March 3, 1903, is so well dealt with in the *Hennebique* case, that perhaps it will be convenient and worth while to make the following full quotation from said case, quoting from pages 889-891 of the 172 Fed. Rep.:—

"It is further said, however, that Act March 3, 1903, c. 1019, 32 Stat. 1225 (U. S. Comp. St. Supp. 1907, p. 1003), having been passed for the avowed object of effectuating the provisions of the treaty, Congress, in so undertaking to act, in effect declared against the self-executing

character of the treaty, and that the construction so put upon it is to be respected, if, indeed, it is not controlling. This is the view taken in *United Shoe Company v. Duplessis Shoe Company*, 155 Fed. 842, 84 C. C. A. 76, referred to above. But it was recognized in that case that article 4 *bis*, and, if so, the whole treaty, was self-executing on its face, and it is giving altogether too much force to the action of Congress to have it do away with this simply by implication. If the engagement between the high contracting parties, who entered into the treaty, was, by its terms, immediate and unqualified, which is not only demonstrated above, but is there conceded, no legislative declaration afterwards, on the part of one of them, is competent to qualify it. No doubt the treaty could be denounced or superseded by appropriate action; but it is not to be set aside or deprived of its inherent force because of acts based upon the assumed necessity for bringing the statute law into harmony with its provisions.

But it is further said that, the act of 1903 coming after the treaty and being confined to giving effect to a part only of its provisions, Congress having deemed it advisable to go no further in that direction, the treaty is to that extent abrogated; the act as so passed being inconsistent with it. There can be no question that, as declared in the *Cherokee Tobacco* case, 11 Wall. 616, 621 (20 L. Ed. 227), 'a treaty may supersede a prior act of Congress, and an act of Congress may supersede a treaty'. And so far as this is the necessary result of the act in the present instance, being later than the treaty, this effect must be given to it. The act of 1903, however, is somewhat peculiar. It is not confined to the purpose expressed in the title, but undertakes to amend, not only section 4887, but sections 4892, 4896, and 4902, also, only the first of which has anything to do with the present subject. And as to section 4887 it simply re-enacts it as amended by Act March 3, 1897, c. 391, Sec. 3, 29 Stat. 692, except that it enlarges

the time after which an application for a patent filed abroad shall debar the obtaining of a patent here for the same invention from 7 months to 12 months, this period in the case of designs being fixed at 4 months; and except, also, that it provides in a new and distinct paragraph that an application filed here within the period so limited, after an application for the same invention filed abroad, shall have the same force and effect as if filed here at the time it was filed there, provided similar privileges are afforded by such foreign country to citizens of the United States by law or treaty; and provided, further, that no patent shall be granted for an invention patented or described in a printed publication in this or any foreign country more than two years before the filing in this country for a like previous period.

But it is difficult to see, upon the most liberal construction, how, as so enacted, it can be given the restrictive effect that is now claimed for it. It is true that it provides for but a small part of that which is covered by the treaty, and if legislation was necessary to give effect to the treaty there would not be much left to it. But that, as we have seen, is not the case. The treaty, if uncontrolled, is self-executing. It is only as Congress in this abbreviated fashion has apparently seen fit to proceed upon a different assumption that any doubt is cast upon it. A repeal by implication is never favored, even between statute and statute; and much more is not a treaty, which has been mutually agreed to, to be overturned by a later statute, which is the individual act of one of the parties. To sustain that view in any case there must be such a clear repugnancy that treaty and statute cannot stand together, which, in the present instance, will hardly be contended for. The only inconsistency, as just stated, is that, where one deals with the subject comprehensively, the other does so restrictedly, which is not sufficient; there being nothing to convince that this was the purpose.

It is said that this is shown by the title, which commits the act to the carrying out of the treaty, which must thus be regarded as the only means appropriate for doing so. *Dallemande v. Moisan*, 197 U. S. 169, 25 Sup. Ct. 422, 49 L. Ed. 709. The title of an act may no doubt be resorted to, under proper circumstances, to explain or give character to the body of it. But that it should be allowed controlling force, under the showing that is made here, is entirely unwarranted. Only about one-tenth of the act in question has anything to do with the title; the rest of it, as we have seen, being entirely unrelated, except as it deals with the general subject of patents. And with the little heed that is so paid to it in the body, it would be straining a point to accord to the title the predominant part that is now urged for it. The title being disposed of, there is nothing in the act itself to in any way disturb us. It did not undertake to undo what had been done by the treaty. At most it merely neglected to take such steps as would have brought the statute law into complete conformity with its provisions. *But the treaty was not dependent upon this. It went into effect of its own force some six months before.* And it is not to be set aside in any such indirect and inconclusive manner after that. *It is also further to be observed that, even if the act of 1903 is held to have superseded or abrogated the treaty, the treaty having gone into effect in this way meantime, the patent in suit and others similarly situated were thereby freed from their dependency upon corresponding foreign patents, and they could not be put back by the act into their former position, which would offend against the principle of nonretroactivity contended for, even more seriously than anything which is now complained of.*

Taking treaty and acts of Congress together, therefore, the case stands this way: By section 4887, Rev. St., a domestic patent for the same invention previously patented abroad was made

dependent on the term of such foreign patent, by which it was limited. The act of March 3, 1897, removed this restriction, but provided (section 8) that it should not apply to patents granted prior to January 1, 1898, nor to applications filed before that on which patents were subsequently granted. This prevented the patent in suit, for the time, from having the benefit of this legislation, having been applied for December 29, 1897, two days within the period fixed by the proviso. Then the additional act of Brussels of 1900 was ratified, by which, according to article 4 *bis*, there was a complete unfettering of foreign and domestic patents for the same invention; and this by express terms was made to apply to existing patents. *Such was the state of the law, and such the position of the patent in suit, when the act of March 3, 1903, came into existence. As just stated, this could not undo what had already been done, nor put back the patent into its former dependent condition. Having become entitled to the full term of 17 years accorded to patents generally, it could not thereafter be again restricted.* Nor did the act of 1903 indeed, undertake to do so. It simply re-enacted section 4887, as amended by the act of 1897, leaving out the limitation which time and treaty had doubly disposed of, and introducing certain provisions in conformity with the treaty. *It is only by reading into this record that which is not to be found there, and has no rightful place in it—that the treaty was not retroactive, and was not self-executing, contrary to the plain effect of it—that the patent can be cut down or made dependent again upon the term of the French patent.”* (Italics ours.)

It is beyond question that the Act of 1903 had no effect whatever on Art 4 *bis* of the Treaty, an article as to which said act was entirely silent; but, as we have before said, this matter, though so much discussed in the two Court of Appeals cases that

have considered Art. 4 *bis*, is wholly immaterial, because it is impossible that any subsequent act of Congress whatsoever should divest the property rights already vested in patentees by the going into effect of the self-executing Art. 4 *bis* of the Treaty,—and to this we may now again more particularly refer in the next following paragraphs.

**Neither the Act of March 3, 1903, nor any other subsequent legislation, could divest the patent rights that had already vested under Article 4 bis of the Treaty when the latter went into effect on September 14, 1902.**

The mere statement of this proposition is its own substantiation. We have already quoted, near the end of the Statement of the Case, the statement of the Supreme Court in *Society, etc., v. New Haven*, 8 Wheat. 464, 493, but it is so much in point that it may conveniently be re-quoted here:—

“But there is still a more decisive answer to this objection, which is, that *the termination of a treaty cannot divest rights of property already vested under it.*”

*If real estate be purchased or secured under a treaty, it would be most mischievous to admit that the extinguishment of the treaty extinguished the right to such estate. In truth, it no more affects such rights, than the repeal of a municipal law affects rights acquired under it. If, for example, a statute of descents was repealed, it has never been supposed that rights of property, already vested during its existence, were gone by such repeal. Such a construction would overturn the best established doctrines of law, and sap the very foundation on which property rests.” (Italics ours.)*

We also quoted in the Statement of the Case, and

need not here repeat, the familiar holding in *McClurg v. Kingsland* to the effect that the repeal of a law relating to patents cannot take away the rights of property vested in the patentee.

A further statement much in point may be noted in *Chirac v. Chirac*, 2 Wheat. 259, 277-278:—

“If a treaty, or any other law, has performed its office by giving a right, the expiration of the treaty or law cannot extinguish that right. Let us, then, inquire whether this temporary treaty [a treaty that had ended after eight years] gave rights which existed only for eight years, or gave rights during eight years which survived it.

The terms of this instrument leave no doubt on this subject. Its whole effect is immediate. \* \* \* \* \* the Court is of opinion, that the treaty had its full effect the instant a right was acquired under it; that it had nothing further to perform; and that its expiration or continuance afterwards was unimportant.”

And again, much more recently, this Court said, in *Jones v. Meehan*, 175 U. S. 1, 32:—

“*The title to the strip of land in controversy, having been granted by the United States \* \* \* by the treaty itself, and having descended, \* \* \* \* \* passed by the lease, to the plaintiffs; and their rights under that lease could not be divested by any subsequent action of the lessor, or of Congress, or of the Executive Departments. The construction of treaties is the peculiar province of the judiciary; and, except in cases purely political, Congress has no constitutional power to settle the rights under a treaty, or to affect titles already granted by the treaty itself.*” (Italics ours.)

There is aptness in a remark made by Judge Dennison (and quoted with approval by the decision affirming him in the Court of Appeals for the Sixth

Circuit), in a case where want of identity with a foreign patent was held to preclude applying the old Sec. 4887 of 1874 (p. 92 of *Commercial Acetylene Co. v. Acme Co., supra*) :—

“In the present status of the matter, it is to be assumed that the patent in suit is for an invention very useful to the public. It was granted in 1900 for 17 years. The Patent Office did not require it to be limited on its face, although the British patent was of record in the United States Patent Office. Now to shorten the 17-year term into a 10-year term is a step that I think should not be taken unless the statute is clearly applicable.”

And still less is it to be thought of that after the Treaty, in 1902, had confirmed and vested the remainder of the seventeen years term, the subsequent statutory enactment of 1903 could be supposed to devest that already vested property right,—even if such enactment had attempted, as it did not, to abrogate the Treaty.

**In Conclusion.**

In the foregoing Statement of the Case and Brief of Argument, it is shown that:—

It was within the treaty-making power to grant and confirm, by a self-executing treaty-clause, the remainder of the seventeen years term named (as provided in Sec. 4884 of 1874) in the grant on the sealed face of an existing patent.

Art. 4 *bis* of the Treaty of Brussels was self-executing, and did, on September 14, 1902, grant and confirm the remainder of the seventeen years term named (as provided in Sec. 4884 of 1874) in the grant on the sealed face of such then existing domestic patents as were still subject to the collateral limitation of term provided for in Sec. 4887 of 1874.

The Act of March 3, 1903, did not attempt to abrogate Art. 4 *bis* of the Treaty; and further:—

Neither the Act of March 3, 1903, nor any other act subsequent to the going into effect of the Treaty, could divest the already vested right of the patentees in and to the aforesaid remainder of the seventeen years term granted and confirmed by Art. 4 *bis*.

The Cameron patent sued upon does not expire until October third, nineteen hundred and sixteen.

Wherefore the Plea should not have been sustained, and the final decree of the court below should be reversed, with costs.

Respectfully submitted,

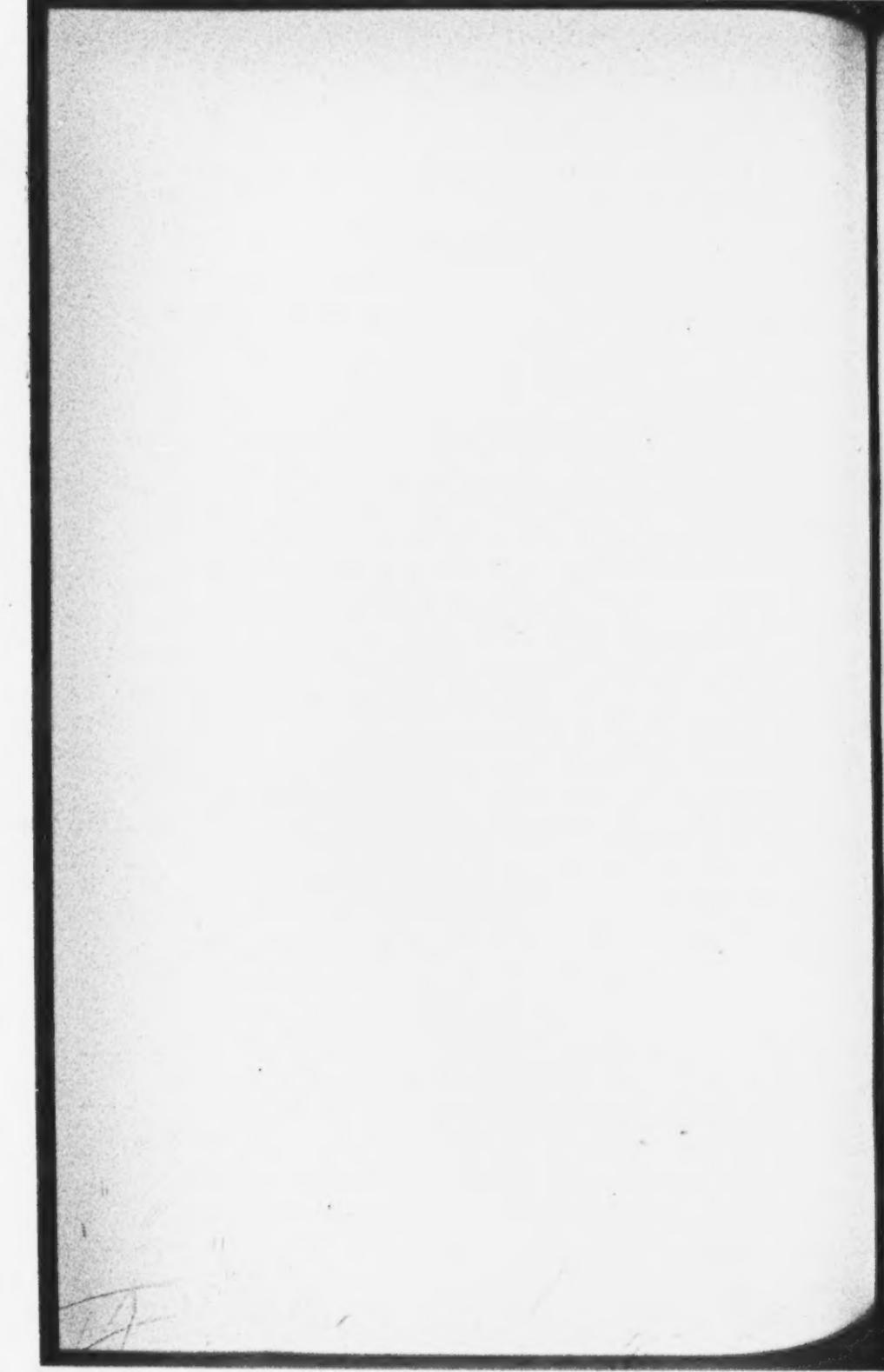
MUNDAY, EVARTS, ADCOCK & CLARKE,

*Counsel for Appellant.*

HENRY LOVE CLARKE,

*Of Counsel.*

Dated, CHICAGO, October 23, 1912.



**APPENDIX.**

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**Photo-reproduction of State Department Re-  
print of the President's Proclamation of the  
Treaty of Brussels.**

**(32 Stat. L. 1936-1943.)**

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**Also, Copy of Record of Deposit of Ratifica-  
tions of the Treaty.**

## INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY.

AN ADDITIONAL ACT, CONCLUDED AT BRUSSELS DECEMBER 14, 1900, BY THE PLENIPOTENTIARIES OF THE UNITED STATES AND OTHER COUNTRIES, FOR THE PROTECTION OF INDUSTRIAL PROPERTY, MODIFYING THE INDUSTRIAL PROPERTY CONVENTION OF MARCH 20, 1883.

*Signed at Brussels, December 14, 1900.*

*Ratification advised by the Senate March 7, 1901.*

*Ratified by the President, April 16, 1901.*

*Ratification deposited at Brussels, May 3, 1901.*

*Proclaimed, August 25, 1902.*

BY THE PRESIDENT OF THE UNITED STATES OF AMERICA.

## A PROCLAMATION.

Whereas an Additional Act modifying the Industrial Property Convention of March 20, 1883, was signed at Brussels, on December 14, 1900, by the Plenipotentiaries of the United States and other Powers, a true copy of which Additional Act, in the French language is word for word as follows:

[Translation.]

*Union internationale pour la protection de la propriété industrielle*

*International union for the protection of industrial property.*

ACTE ADDITIONNEL DU 14 DÉCEMBRE 1900 MODIFIANT LA CONVENTION DU 20 MARS 1883 AINSI QUE LE PROTOCOLE DE CLÔTURE Y ANNEXÉ.

ADDITIONAL ACT OF DECEMBER 14, 1900, MODIFYING THE CONVENTION OF MARCH 20, 1883, AS WELL AS THE FINAL PROTOCOL THERETO ANNEXED.

Sa Majesté le Roi des Belges; le Président des États-Unis du Brésil; Sa Majesté le Roi de Danemark; le Président de la République Dominicaine; Sa Majesté le Roi d'Espagne et, en son nom, Sa Majesté la Reine Régente du Royaume; le Président des États-Unis d'Amérique; le Président de la République Française; Sa Majesté la Reine du Royaume-Uni de la Grande-Bretagne et d'Irlande, Impératrice des Indes; Sa Majesté le Roi d'Italie; Sa Majesté l'Em-

His Majesty the King of the Belgians; The President of the United States of Brazil; His Majesty the King of Denmark; the President of the Dominican Republic; His Majesty the King of Spain, and in his name, Her Majesty the Queen, Regent of the Kingdom; The President of the United States of America; The President of the French Republic; Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, Empress of India; His Majesty the

pereur du Japon; Sa Majesté la Reine des Pays-Bas; Sa Majesté le Roi de Portugal et des Algarves; Sa Majesté le Roi de Serbie; Sa Majesté le Roi de Suède et de Norvège; le Conseil Fédéral de la Confédération Suisse; le Gouvernement Tunisien, ayant jugé utile d'apporter certaines modifications et additions à la Convention internationale du 20 mars 1883, ainsi qu'au Protocole de clôture annexé à ladite Convention, ont nommé pour Leurs Plénipotentiaires, savoir:

Sa Majesté le Roi des Belges: M. A. Nysaens, Ancien Ministre de l'Industrie et du Travail; M. L. Capelle, Envoyé Extraordinaire et Ministre Plénipotentiaire, Directeur général du Commerce et des Consulats au Ministère des Affaires Etrangères; M. Georges de Ro, Avocat à la Cour d'Appel de Bruxelles, Ancien Secrétaire de l'Ordre; M. J. Dubois, Directeur général au Ministère de l'Industrie et du Travail.

Le Président des États-Unis du Brésil: M. da Cunha, Envoyé Extraordinaire et Ministre Plénipotentiaire des États-Unis du Brésil près Sa Majesté le Roi des Belges.

Sa Majesté le Roi de Danemark: M. H. Holten-Nielsen, Membre de la Commission des Brevets, Enregistreur des marques de fabrique.

Le Président de la République Dominicaine: M. J. W. Hunter, Consul général de la République Dominicaine à Anvers.

Sa Majesté le Roi d'Espagne et, en son nom, Sa Majesté la Reine Régente du Royaume: M. de Villa Urrutia, Son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges.

Le Président des États-Unis d'Amérique: M. Lawrence Town-

King of Italy; His Majesty the Emperor of Japan; Her Majesty the Queen of the Netherlands; His Majesty the King of Portugal and the Algarves; His Majesty the King of Servia; His Majesty the King of Sweden and Norway; The Federal Council of the Swiss Confederation; The Government of Tunis, having deemed it useful to make certain modifications and additions to the International Convention of March 20, 1883, as well as to the Final Protocol annexed to said Convention, have named for their Plenipotentiaries the following:

His Majesty the King of the Belgians: Mr. A. Nysaens, former Minister of Industry and of Labor; Mr. L. Capelle, Envoy Extraordinary and Minister Plenipotentiary, Director General of Commerce and of Consulates in the Ministry of Foreign Affairs; Mr. Georges de Ro, Advocate at the Court of Appeal of Brussels, former Secretary of the order. Mr. J. Dubois, Director General in the Ministry of Industry and Labor.

The President of the United States of Brazil: Mr. da Cunha, Envoy Extraordinary and Minister Plenipotentiary of the United States of Brazil near His Majesty the King of the Belgians.

His Majesty the King of Denmark: Mr. H. Holten-Nielsen, Member of the Patent Commission, Registrar of Trade-Marks.

The President of the Dominican Republic: Mr. J. W. Hunter, Consul General of the Dominican Republic at Antwerp.

His Majesty the King of Spain, and, in His name, Her Majesty the Queen Regent of the Kingdom: Mr. de Villa Urrutia, His Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians.

The President of the United States of America: Mr. Lawrence

send, Envoyé Extraordinaire et Ministre Plénipotentiaire des Etats-Unis d'Amérique près Sa Majesté le Roi des Belges; M. Francis Forbes; M. Walter H. Chamberlin, Assistant Commissioner of Patents.

Le Président de la République Française: M. Gérard, Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges; M. C. Nicolas, Ancien Conseiller d'Etat, Directeur honoraire au Ministère du Commerce, de l'Industrie, des Postes et des Télégraphes; M. Michel Pelletier, Avocat à la Cour d'Appel de Paris.

Sa Majesté la Reine du Royaume-Uni de la Grande-Bretagne et d'Irlande, Impératrice des Indes: Le Très Honble. C. B. Stuart Wortley, M. P.; Sir Henry Bergne, K. C. M. G., Chef du Département commercial au Foreign Office; M. C. N. Dalton, C. B., Comptroller General of Patents.

Sa Majesté le Roi d'Italie: M. Romeo Cantagalli, Son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges; M. le commandeur Carlo-Francesco Gabba, Sénateur, Professeur à l'Université de Pise; M. le chevalier Samuele Ottolenghi, Chef de division au Ministère de l'Agriculture, de l'Industrie et du Commerce, Directeur du Bureau de la Propriété industrielle.

Sa Majesté l'Empereur du Japon: M. Itchiro Motono, Son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges.

Sa Majesté la Reine des Pays-Bas: M. F. -W. J. -G. Snyder van Wissenkerke, Docteur en droit, Conseiller au Ministère de la Justice, Directeur du Bureau de la Propriété industrielle.

Sa Majesté le Roi de Portugal et des Algarves: M. le Conseiller

Townsend, Envoy Extraordinary and Minister Plenipotentiary of the United States of America near His Majesty the King of the Belgians; Mr. Francis Forbes; Mr. Walter H. Chamberlin, Assistant Commissioner of Patents.

The President of the French Republic: Mr. Gérard, Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians; Mr. C. Nicolas, Former Councillor of State, Honorary Director at the Ministry of Commerce, of Industry, of Posts and Telegraphs; Mr. Michel Pelletier, Advocate at the Court of Appeal of Paris.

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, Empress of India: The Right Honorable C. B. Stuart Wortley, M. P.; Sir Henry Bergne, K. C. M. G., Chief of the Commercial Department at the Foreign Office; Mr. C. N. Dalton, C. B., Comptroller General of Patents.

His Majesty the King of Italy: Mr. Romeo Cantagalli, His Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians; Commander Carlo-Francesco Gabba, Senator, Professor at the University of Pisa; Chevalier Samuele Ottolenghi, Chief of Division at the Ministry of Agriculture, of Industry and of Commerce, Director of the Bureau on Industrial Property.

His Majesty the Emperor of Japan: Mr. Itchiro Motono, His Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians.

Her Majesty the Queen of the Netherlands: Mr. F. W. J. G. Snyder van Wissenkerke, Doctor of Laws, Councillor at the Ministry of Justice, Director of the Bureau on Industrial Property.

His Majesty the King of Portugal and of the Algarves: Coun-

E. Madeira Pinto, Directeur Général au Ministère des Travaux Publics, du Commerce et de l'Industrie.

Sa Majesté le Roi de Serbie: M. le Dr. Michel Vouitch, Son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris.

Sa Majesté le Roi de Suède et de Norvège: M. le comte Wrangel, Son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges.

Le Conseil Fédéral de la Confédération Suisse: M. J. Borel, Consul Général de la Confédération suisse à Bruxelles; M. le Dr. Louis-Rodolphe de Salis, Professeur à Berne.

Le Président de la République Française, pour la Tunisie: M. Gérard, Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges; M. Bladé, Consul de première classe au Ministère des Affaires Etrangères de France.

Lesquels, après s'être communiqués leurs pleins pouvoirs respectifs, trouvés en bonne et due forme, sont convenus des articles suivants:

#### ARTICLE PREMIER.

La Convention internationale du 20 mars 1883 est modifiée ainsi qu'il suit:

I.—L'article 3 de la Convention aura la teneur suivante:

ART. 3.—Sont assimilés aux sujets ou citoyens des États contractants, les sujets ou citoyens des États ne faisant pas partie de l'Union, qui sont domiciliés ou ont des établissements industriels ou commerciaux effectifs et sérieux sur le territoire de l'un des États de l'Union.

II.—L'article 4 aura la teneur suivante:

ART. 4.—Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin

cillor E. Madeira Pinto, Director General at the Ministry of Public Works, of Commerce and Industry.

His Majesty the King of Servia: Dr. Michel Vouitch, His Envoy Extraordinary and Minister Plenipotentiary at Paris.

His Majesty the King of Sweden and Norway: Count Wrangel, His Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians.

The Federal Council of the Swiss Confederation: Mr. J. Borel, Consul General of the Swiss Confederation at Brussels; Doctor Louis-Rodolphe de Salis, Professor at Berne.

The President of the French Republic, for Tunis: Mr. Gérard, Envoy Extraordinary and Minister Plenipotentiary near his Majesty the King of the Belgians; Mr. Bladé, Consul of the 1st Class at the Ministry of Foreign Affairs of France.

Who, after having communicated to each other their full powers, found to be in good and due form, have agreed upon the following articles:

#### ARTICLE 1.

The International Convention of March 20, 1883, is modified as follows:

I. Article 3 of the Convention shall read as follows:

ART. 3. Are assimilated to the subjects or citizens of the contracting States, the subjects of citizens of States not forming part of the union, who are domiciled or have bona fide industrial or commercial establishments upon the territory of one of the States of the Union.

II. Article 4 shall read as follows:

ART. 4. Any one who shall have regularly deposited an application for a patent of invention, of an in-

ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des États contractants, jouira, pour effecteur le dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après. En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union, avant l'expiration de ces délais, ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de douze mois pour les brevets d'invention, et de quatre mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce.

III.—Il est inséré dans la Convention un article 4 *bis* ainsi conçu:

ART. 4 *bis*.—Les brevets demandés dans les différents États contractants par des personnes admises au bénéfice de la Convention aux termes des articles 2 et 3, seront indépendants des brevets obtenus pour la même invention dans les autres États adhérents ou non à l'Union.

Cette disposition s'appliquera aux brevets existants au moment de sa mise en vigueur.

Il en sera de même, en cas d'accession de nouveaux États, pour les brevets existant de part et d'autre au moment de l'accession.

IV.—Il est ajouté à l'article 9 deux alinéas ainsi conçus:

Dans les États dont la législation n'admet pas la saisie à l'importation, cette saisie pourra être remplacée par la prohibition d'importation.

dustrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter mentioned.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks.

III. There is inserted in the Convention an article 4 *bis*, as follows:

ART. 4 *bis*. Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion.

IV. There are added to Article 9 two paragraphs, as follows:

In the States whose legislation does not admit of seizure on importation, such seizure may be replaced by prohibition of importation.

[Underscoring ours]

Les autorités ne seront pas tenues d'effectuer la saisie en cas de transit.

V.—L'article 10 aura la teneur suivante:

ART. 10.—Les dispositions de l'article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout producteur, fabricant ou commerçant, engagé dans la production, la fabrication ou le commerce de ce produit, et établi soit dans la localité faussement indiquée comme lieu de provenance, soit dans la région où cette localité est située.

VI.—Il est inséré dans la Convention un article 10 bis ainsi conçu:

ART. 10 bis.—Les ressortissants de la Convention (art. 2 et 3), jouiront, dans tous les Etats de l'Union, de la protection accordée aux nationaux contre la concurrence déloyale.

VII.—L'article 11 aura la teneur suivante:

ART. 11.—Les Hautes Parties contractantes accorderont, conformément à la législation de chaque pays, une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions internationales officielles ou officiellement reconnues, organisées sur le territoire de l'une d'elles.

VIII.—L'article 14 aura la teneur suivante:

ART. 14.—La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

The authorities shall not be required to make the seizure in case of transit.

V. Article 10 shall read as follows:

ART. 10. The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every producer, manufacturer, or trader engaged in the production, the manufacture, or the sale of this production when established either in the locality falsely indicated as place of origin, or in the region where that locality is situated.

VI. There is inserted in the Convention an article 10 *bis*, as follows:

ART. 10 bis. Those entitled of right under the Convention (art. 2 and 3), shall enjoy, in all the States of the Union, the protection accorded to citizens or subjects against unfair competition.

VII. Article 11 shall read as follows:

ART. 11. The high contracting parties shall accord conformably to the legislation of each country a temporary protection to patentable inventions, to industrial designs, or models, as well as to trademarks for the productions which shall be shown at official or officially recognized International Expositions organized upon the territory of one of them.

VIII. Article 14 shall read as follows:

ART. 14. The present Convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the Union.

A cet effet, des Conférences auront lieu successivement dans l'un des États contractants, entre les Délégués desdits États.

IX.—L'article 16 aura la teneur suivante:

ART. 16.—Les États qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention, et produira ses effets un mois après l'envoi de la notification faite par le Gouvernement suisse aux autres États unionistes, à moins qu'une date postérieure n'ait été indiquée par l'État adhérent.

#### ARTICLE 2.

Le Protocole de clôture annexé à la Convention internationale du 20 mars 1883 est complété par l'addition d'un numéro 3 bis, ainsi conçu:

3 bis. Le breveté, dans chaque pays, ne pourra être frappé de déchéance pour cause de non-exploitation qu'après un délai minimum de trois ans, à dater du dépôt de la demande dans le pays dont il s'agit, et dans le cas où le breveté ne justifierait pas des causes de son inaction.

#### ARTICLE 3.

Le présent Acte additionnel aura même valeur et durée que la Convention du 20 mars 1883.

Il sera ratifié, et les ratifications en seront déposées à Bruxelles, au Ministère des Affaires Etrangères, aussitôt que faire se pourra, et au

With this object conferences shall take place successively in one of the contracting States between the delegates of said States.

IX. Article 16 shall read as follows:

ART. 16. The States that have not taken part in the present convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all the others.

It shall convey of full right, accession to all the clauses, and admission to all the advantages stipulated by the present convention, and shall go into force a month after the sending of the notification given by the Swiss Government to the Unionist States, unless a later date shall have been indicated by the adhering State.

#### ARTICLE 2.

The Final Protocol annexed to the International Convention of March 20, 1883, is completed by the addition of a number 3 bis, as follows:

ART. 3 bis. The patentee, in each country, shall not suffer forfeiture because of non-working until after a minimum period of three years, to date from the deposit of the application in the country concerned, and in the case where the patentee shall not justify the reasons of his inaction.

#### ARTICLE 3.

The present Additional Act shall have the same force and duration as the Convention of March 20, 1883.

It shall be ratified and the ratifications shall be deposited at the Ministry of Foreign Affairs at Brussels as soon as may be and at

plus tard dans le délai de dix-huit mois à dater du jour de la signature.

Il entrera en vigueur trois mois après la clôture du procès-verbal de dépôt.

En Foi De Quoi les Plénipotentiaires respectifs ont signé le présent Acte additionnel.

Fait à Bruxelles, en un seul exemplaire, le 14 décembre 1900.

Pour la Belgique:

Signé: A. NYSENS.

“ CAPELLE.

“ GEORGES DE RO.

“ J. DUBOIS.

Pour le Brésil:

Signé: F. XAVIER DA CUNHA.

Pour le Danemark:

Signé: H. HOLTE NIELSEN.

Pour la République Dominicaine:

Signé: JOHN W. HUNTER.

Pour l'Espagne:

Signé: W. R. DE VILLA URRUTIA.

Pour les États-Unis d'Amérique:

Signé: LAWRENCE TOWNSEND.

“ FRANCIS FORBES.

“ WALTER H. CHAMBERLIN.

Pour la France:

Signé: A. GÉRARD.

“ C. NICOLAS.

“ MICHEL PELLETIER.

Pour la Grande-Bretagne:

Signé: CHARLES B. STUART WORTLEY.

“ H. G. BERGNE.

“ C. N. DALTON.

Pour l'Italie:

Signé: R. CANTAGALLI.

“ C. F. GABBA.

“ S. OTTOLENGHI.

Pour le Japon:

Signé: I. MOTONO.

Pour la Norvège:

Signé: Cte WRANGEL.

the latest within the period of eighteen months dated from the day of signature.

It shall go into effect three months after the close of the record of deposit.

In witness whereof the respective Plenipotentiaries have signed the present Additional Act.

Done at Brussels, in a single copy, December 14, 1900.

For Belgium:

Signed: A. NYSENS.

CAPELLE.

GEORGES DE RO.

J. DUBOIS.

For Brazil:

Signed: F. XAVIER DA CUNHA.

For Denmark:

Signed: H. HOLTE NIELSEN.

For the Dominican Republic:

Signed: JOHN W. HUNTER.

For Spain:

Signed: W. R. DE VILLA URRUTIA.

For the United States of America:

Signed: LAWRENCE TOWNSEND.

FRANCIS FORBES.

WALTER H. CHAMBERLIN.

For France:

Signed: A. GÉRARD.

C. NICOLAS.

MICHEL PELLETIER.

For Great Britain:

Signed: CHARLES B. STUART WORTLEY.

H. G. BERGNE.

C. N. DALTON.

For Italy:

Signed: R. CANTAGALLI.

C. F. GABBA.

S. OTTOLENGHI.

For Japan:

Signed: I. MOTONO.

For Norway:

Signed: Cte WRANGEL.

Pour les Pays-Bas:

Signé: SNYDER VAN WISSENKERKE.

Pour le Portugal:

Signé: ERNESTO MADEIRA PINTO.

Pour la Serbie:

Signé: Dr. MICHEL VOUILLET.

Pour la Suède:

Signé: Cte WRANGEL.

Pour la Suisse:

Signé: JULES BOREL.  
" L. R. DE SALIS.

Pour la Tunisie:

Signé: A. GÉRARD.  
" ETIENNE BLADÉ.

Certifié conforme: Bruxelles, le  
7 Février 1901.

Le Secrétaire Général du Mi-  
nistère des Affaires Etrangères de  
Belgique,

B<sup>on</sup> LAMBERMONT.

And whereas the said Additional Act was ratified by the Government of the United States, by and with the advice and consent of the Senate thereof, and by the other signatory Governments with the exception of those of Brazil, the Dominican Republic, Spain and Servia, and the ratifications have been deposited with the Ministry of Foreign Affairs at Brussels, as required by Article 3 of the Act;

And whereas it is agreed between the ratifying Governments that the said Additional Act shall go into effect between them on September 14, 1902, notwithstanding the non-ratification thereof by the four signatory governments above mentioned, which have reserved the right to ratify the same at a later date;

Now therefore, be it known that I, Theodore Roosevelt, President of the United States of America, have caused the said Additional Act to be made public, to the end that the same and every article and clause thereof may be observed and fulfilled with good faith by the United States and the citizens thereof.

In testimony whereof, I have hereunto set my hand and caused the seal of the United States to be affixed.

Done at the City of Washington, this twenty-fifth day of August in  
the year of our Lord one thousand nine hundred and two,  
[SEAL.] and of the Independence of the United States the one hundred and twenty-seventh.

THEODORE ROOSEVELT

By the President:

ALVEY A. ADEE  
Acting Secretary of State.

**Copy of Record of Deposit of Ratifications of the Treaty.**

REPRINTED FROM THE BRITISH BLUE-BOOK OF 1902, TREATY SERIES,  
No. 15. (Italics ours.)

*Procès-Verbal.*

The Contracting Parties having unanimously agreed that the exchange of the ratifications of the Additional Act to the Convention of the 20th March, 1883, signed at Brussels on the 14th December, 1900, shall be effected by means of the deposit of the respective instruments in the archives of the Belgian Ministry for Foreign Affairs, the present Protocol recording the deposit has been, for this purpose, drawn up at the Ministry for Foreign Affairs *this 3rd day of May, 1901.*

(Signed)

LAWRENCE TOWNSEND.

*On this day the ratification of the President of the United States of America has been deposited.*

In succession have been deposited:

On the 5th August, 1901, the ratification of the Swiss Federal Council.

On the 10th October, 1901, the ratification of His Majesty the King of Denmark.

On the 5th November, 1901, the ratification of His Majesty the King of Portugal and the Algarves.

On the 6th December, 1901, the ratification of His Majesty the King of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas, Emperor of India.

On the 10th December, 1901, the ratification of His Majesty the King of the Belgians.

On the 12th December, 1901, the ratification of His Majesty the King of Italy.

(Signed)

JULES BOREL.

(Signed)

F. G. SCHACK DE BROCKDORFF.

(Signed)

CTE. DE TOVAR.

(Signed)

CONSTANTINE PHIPPS.

(Signed)

P. DE FAVEREAU.

(Signed)

R. CANTAGALLI.

(Signed)  
S. MATSUGATA.

(Signed)  
A. GERARD.

(Signed)  
CTE. WRANGEL.

(Signed)  
CTE. WRANGEL.

(Signed)  
R. DE PESTEL.

On the 21st April, 1902, the ratification of His Majesty the Emperor of Japan.

On the 23rd May, 1902, the ratifications of the President of the French Republic and of the Government of Tunis.

On the 5th June, 1902, the ratification of His Majesty the King of Sweden and Norway, on behalf of Sweden.

On the same day, the ratifications of His Majesty the King of Sweden and Norway, on behalf of Norway.

On the 10th June, 1902, the ratification of Her Majesty the Queen of the Netherlands.

In conformity with Article 3 of the Additional Act of the 14th December, 1900, *the present Protocol has been closed on this date.*

The Belgian Minister for Foreign Affairs,

(Signed) P. DE FAVEREAU.

Brussels, June 14, 1902.

It not having been possible to deposit the ratifications of the President of the United States of Brazil, the President of the Dominican Republic, His Majesty the King of Spain, and His Majesty the King of Servia, within the stipulated period, the Governments of Belgium, Denmark, *the United States of America*, France, *Great Britain*, Italy, Japan, Norway, the Netherlands, Portugal, Sweden, Switzerland, and Tunis *have unanimously agreed that the Additional Act of the 14th December, 1900, shall from the 14th September, 1902, take effect as regards themselves* and also as regards those of the other four Signatory States whose ratifications may in the interval have been deposited.

Certified copy:

The Secretary-General  
of the Belgian Ministry for Foreign  
Affairs,

(Signed) BARON LAMBERMONT.

## INDEX OF CASES CITED.

PAGES

Ah Lung, 18 Fed. Rep., 28.....	29, 30
Bate Refrigerating Co. <i>v.</i> Gillett, 31 Fed., 809.....	7
Beach <i>v.</i> Nixon, 9 N. Y., 35.....	8
Bonsack Mach. Co. <i>et al. v.</i> Smith <i>et al.</i> , 70 Fed., 392.....	8
Bate Refrigerating Co. <i>v.</i> Sulzberger, 157 U. S., 1.....	
.....9, 10, 11, 14	
Butterworth <i>v.</i> Boral & Kymer <i>et al.</i> , 97 O. G., 1596.....	23
Bartram <i>v.</i> Robertson, 15 Fed. Rep., 212.....	29
Coml. Acet. Co. <i>v.</i> Searchlight Gas Co., 188 Fed., 85.....	12
Coml. Acet. Co. <i>v.</i> Searchlight Gas Co., 197 Fed., 918.20, 27	27
Chinese Exclusion Case, 130 U. S., 581.....	30
Dallemagne <i>v.</i> Moisan, 197 U. S., 169.....	20, 21, 27
De Geofroy <i>v.</i> Riggs, 133 U. S., 258.....	24
Edison Electric Light Co. <i>v.</i> U. S. Electric Lighting Co.,	
35 Fed., 134.....	11
Evans <i>v.</i> Robinson, Fed. Cas., 4571.....	25
Edye <i>et al. v.</i> Robertson, 112 U. S., 580.....	28
<i>Ex parte</i> Zwaek & Co., 76 O. G., 1855.....	23
Farnum <i>v.</i> Platt, 8 Pick., 338.....	8
French Republic <i>v.</i> Saratoga Vichy Co., 191 U. S., 427.....	19
Ft. Leavenworth Ry. Co. <i>v.</i> Lowe, 114 U. S., 525.....	24
Foster <i>v.</i> Neilson, 2 Peters, 253.....	26
Henry <i>v.</i> Providence Tool Co., 3 Ban. & A., 501.....	7
Hennebique Construction Co. <i>v.</i> Myers, 172 Fed., 874.....	
.....9, 16, 21, 22, 25, 26	
Head-Money cases, 112 U. S., 580.....	30
Highland Glass Company <i>v.</i> Schmertz Wire Glass Co.	
<i>et al.</i> , 178 Fed., 944.....	17, 20
Horner <i>v.</i> U. S., 143 U. S., 570.....	30
Interlocking Steel Sheeting Co. <i>v.</i> Friestedt Interlock, C.	
Bar Co., 182 Fed., 398.....	22
Jones <i>v.</i> Walker, Fed. Cas., 7507.....	24

Leeds & Catlin Co. <i>v.</i> Victor Co., 213 U. S., 301.....	11	22
La Republique Francaise <i>v.</i> Schultz, 57 Fed., 37.....		30
Malignani <i>et al v.</i> Hill-Wright Electric Co., 177 Fed.,		
430.....	12, 17, 20	21
Malignani <i>et al v.</i> Jasper Marsh Consol. Elec. Lamp Co.,		
180 Fed., 442.....	12, 17, 18, 19, 20,	21
Oakley <i>v.</i> Schoonmaker, 15 Wend., 226.....		8
Opinion of W. H. H. Miller, Atty. Genl., 47 O. G., 397.....		
.....	19, 20-23, 24-26,	32
Paillard <i>v.</i> Bruno (C. C.), 29 Fed., 864.....		7
Protective Co. <i>v.</i> Burglar Alarm Co., 21 Fed., 458.....		7
Pohl <i>v.</i> Anchor Brewing Co., 134 U. S., 381.....		8
Reissner <i>v.</i> Sharp, 16 Blatchf., 383.....		7
Refrigerator Co. <i>v.</i> Hammond, 129 U. S., 151.....		10
Rousseau <i>v.</i> Brown, 104 O. G., 1120.....		23
Ropes <i>v.</i> Clinch, 8 Blatchford, 304.....		29
Sawyer Spindle Co. <i>v.</i> Carpenter, 143 Fed., 976.....		21
Taylor <i>et al. v.</i> Morton, 2 Curtis, C. C., 454.....	27,	28
The Cherokee Tobacco, 78 U. S., 616.....		28
Thomson-Houston Electric Co. <i>v.</i> McLean, 153 Fed., 883		12
United States Shoe Machinery Co. <i>v.</i> Duplessis Shoe		
Machinery Co., 155 Fed., 842.....	12, 15-16, 18, 20, 21,	27
Union Typewriter Co. <i>v.</i> L. C. Smith & Bros., 173 Fed.,		
288.....	16, 17, 18, 21,	22
Westinghouse Elec. & Mfg. Co. <i>v.</i> Bullock Elec. & Mfg.		
Co. (unreported).....		21
Whitney <i>v.</i> Robertson, 124 U. S., 190.....		30

## INDEX.

	PAGE
Statement . . . . .	1
Treaty of 1902 basis of appellant's claim . . . . .	3
Law governing issue of Cameron patent . . . . .	6
Treaty does not extend life of patent . . . . .	11
Patents not extended without Act of Congress . . . . .	24
Historical sketch of treaty . . . . .	32
Summary . . . . .	42

## APPENDIX.

Treaty of 1883 . . . . .	43
Opinion of Attorney-General Miller—1889 . . . . .	53
Extract from Convention of 1897 . . . . .	59
Report of United States Delegates, December, 1897 . . . . .	69
Report of British Delegates, December, 1897 . . . . .	75
Appointment of Commissioners to revise laws pursuant to treaty . . . . .	76
Report of Commissioners so appointed . . . . .	78
Conference of Brussels, December, 1900 . . . . .	83
Report of United States Delegates, December, 1900 . . . . .	85
Ratification and Proclamation, 1902 . . . . .	91
Special foreign laws to carry out treaty . . . . .	96
Turin resolution . . . . .	104
Letters Swiss <i>Chargé d'Affaires</i> . . . . .	104
Reply by Secretary of State . . . . .	107
Report of House Committee on Act to Effectuate Treaty . . . . .	108
Report of Senate Committee on same Act . . . . .	112
Congressional Debate on Act to Effectuate Treaty . . . . .	116
French Ratification of Treaty . . . . .	118



IN THE

**SUPREME COURT OF THE UNITED STATES.**

**OCTOBER TERM A. D. 1912.**

**No. 82.**

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(No. 326. October Term, 1911.)

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**CAMERON SEPTIC TANK COMPANY,**

*Appellant,*

**vs.**

**CITY OF KNOXVILLE, IN THE COUNTY OF MARION AND  
STATE OF IOWA,**

*Appellee.*

Appeal from the Circuit Court of the United States for the Southern District of Iowa

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**BRIEF FOR APPELLEE.**

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**Statement.**

The single issue here, arising upon the plea sustained below, is *whether a United States patent applied for prior to January 1, 1898, for an invention which had been previously patented abroad by the same patentees, expired with the prior foreign patent.* Appellee contends that it did so ex-

pire under Section 4887 of the Act of June 22, 1874, which reads as follows:

"SEC. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. *But every patent granted for an invention which has previously been patented in a foreign country, shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.*" (See also Sec. 25, Act of 1870.)

This is the statute under which the patent issued, and by which its term was fixed at the date of issue. The suit is upon the Cameron *et al.* patent No. 634,423, applied for March 15, 1897, and issued October 13, 1899. The plea (R., p. 18) is that the invention patented by the patent in suit had been previously patented in the United Kingdom of Great Britain to the same patentees by letters patent dated November 8, 1895, and which expired on or before November 8, 1909, being the expiration of the term for which it was granted, and that the United States patent in suit had expired, and became terminated by law on or before the same date. The fact that the same invention had been previously patented by this British patent, and that the British patent expired on the 8th day of November, 1909, being the expiration of the term for which it was granted, is expressly admitted by stipulation (R., p. 21).

**The Treaty of 1902, the Basis of Appellant's Claim for the Extension of Its Patent Beyond the Term Authorized by the Statute Under Which it was Granted.**

The appellant's claim that the Cameron *et al.* United States patent has not expired is entirely based on the treaty of 1902 entitled "An Additional Act Concluded at Brussels December 14th, 1900, for the Protection of Industrial Property, ratified by the Senate March 7th, 1901, by the President April 16th, 1901, and Proclaimed August 25th, 1902," and particularly that clause of the treaty which reads:

"Article 4 *bis*. Patents applied for in the different contracting states, by persons admitted to the benefit of the Convention, under the terms of articles 2 and 3, shall be independent of the patents obtained for the same invention in the other states, adherents or non-adherents to the Union.

"This provision shall apply to patents existing at the time of its going into effect.

"The same rule applies in the case of adhesion of new states, to patents already existing on both sides at the time of the adhesion."

The appellant must further claim that the Act of Congress of 1903, an Act entitled "An Act to effectuate the Provisions of the Additional Act of the International Convention for the Protection of Industrial Property," does not do what its title purports, and that the Congressional Act of 1903 is not the law in existence at the present time, neither of which contentions is maintainable.

Appellee insists that the patent in suit expired with the prior British patent for the same invention; that the law under which it was granted authorized and created no monopoly beyond this, and its term was fixed by this British patent at the date of issue; that the treaty upon which appellant relies did not extend, was not intended to extend, and could not extend, the term of the patent authorized by the law

under which it issued; that the only intent or effect of the treaty was to render patents immune from expiration before the end of the term so fixed, by reason of forfeiture, lapse or cancellation of foreign patents prior to the expiration of their nominal terms, and extend to foreign countries in which that rule had not been adopted, the same rule which this court was then administering with reference to the term of United States patents, viz., that their term, being fixed by conditions as they existed at the time of the grant, should be independent of any subsequent premature defeasance of the prior foreign patent before the expiration of its term (patents of many countries in the convention having been subject to such defeasance); that this is evident from the terms of the treaty and is made entirely clear by the reported discussions at the time the treaty was adopted, by the enactment of 1903 recited as for the purpose of giving effect to the treaty, and by the report of the Congressional committee upon the passage of that bill; that it was not contemplated that the term of any patent granted under the above quoted section should be extended beyond the full statutory term of the prior foreign patent by which it was limited at the time of its grant; that the treaty makes no distinction between patents granted to United States citizens and patents granted to aliens; and that it would not be competent by treaty to change the term of previously existing patents, and this was recognized in the convention; that the treaty plainly contemplated legislation to carry it into effect wherever it modified the existing law, and to whatever extent it modified the existing law; that such legislation was, pursuant to the treaty, obtained by the Act of Congress above referred to; that it conferred no extension of term, but left the effect of the statute in this country precisely what this court had already determined it to be; and that this has been the interpretation acted upon by Congress, generally accepted by the courts, and acted upon by the public.

On August 25, 1902, when the treaty referred to was proclaimed by the President, there were a large number of patents in existence which were limited by the Statute under which they were taken out, to expire with the foreign patent issued to the same patentees for the same invention, and if there were more than one such foreign patent, with that one having the shortest term. The patent here in suit was one of those patents and it expired by virtue of the Statute (Section 4887, R. S., an Act of 1874) under which it was taken out, with the expiration of the British patent referred to in the Cameron *et al.* patent here sued upon, as being for the same invention as this United States patent, on November 8, 1909.

Appellant's contention, if followed, would have the effect of extending the Cameron *et al.* patent in suit nearly seven years (from November 8, 1909, to October 3, 1916), and not only give the patentees an additional term over that which they expected and which was allowed them by Congress at the time they made application for patent, but would also give them a protection in the use of their patent in this country seven years after it had expired in other countries, so that while the public was entitled to use this invention during that seven-year period in other countries, it could not be used in this country without the patentee's consent.

In the present case it would enable the various cities of foreign countries to use processes of disposing of sewage in their cities without any tribute to the patentees of the patent in suit, while the cities of the United States may be excluded from any practice of the processes disclosed in the Cameron *et al.* patent until the latter part of 1916.

### The Law Governing the Issue of the Cameron et als. Patent.

By examining Section 4887 of the Act of June, 1874, already referred to, under which this patent was applied for and issued, it will be seen that—

*"Every patent for an invention which has previously been patented in a foreign country, shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force for more than seventeen years."* (See also Sec. 25, Act of 1870.)

It must be borne in mind that the Cameron et als. patent was applied for and issued under this Statute of 1874 (this is conceded by appellant) and the grant of the patent by the Government was based on this Statute, and hence, by the very nature of the grant itself, the term of the patent was fixed and limited to expire with the expiration of the earliest foreign patent, that is, not later than November 8, 1909.

The Statute enacted March 3, 1897, effective January 1, 1898 (Revised Section 4887 of 1874), which compelled an inventor who had first obtained a patent in a foreign country to make application for his patent in this country within seven months of the application in the foreign country, instead of permitting him to file it at any time after the foreign patent had issued and having his patent expire with the earliest expiring foreign patent, did not in any way affect or change the term of any patent applied for under the Statute of 1874, as this Act specifically provides that it "*shall not apply*" to any patent granted prior to January 1, 1898, "*nor to any application filed prior to said date nor to any patent granted on such an application.*" (29 Stat. L. 692, Sec. 8.)

This Statute of 1874 clearly means that the term of a United States patent issued under it to an inventor who had first patented his device in a foreign country, was fixed to expire on the date of the expiration of the earliest foreign

patent, and it has been uniformly construed as granting a predetermined and not a post-determinable term.

Mr. Justice Bradley in *Bate Refrigerating Co. v. Gillett*, 31 Fed., 809, holds that Revised Statute §4887 unchangeably fixed the term of the American patent regardless of whether the foreign patent has lapsed or become forfeited by non-performance of a condition subsequent and that the United States patent continues in force for the fixed term, regardless of what happens to the term of the foreign patent, when he says (p. 814):

“The term of the English patent fixed the term of the American patent; nothing more, nothing less. The subsequent fate of the English patent had no effect upon the American. The life of each after its inception proceeded independently of the life of the other. See *Protective Co. v. Burglar Alarm Co.*, 21 Fed. 458; *Paillard v. Bruno (C. C.)*, 29 Fed. 864.”

In *Protective Co. v. Burglar Alarm Co.*, 21 Fed., 458, Judge Wheeler said:

“It is also urged that the patent has expired, because the invention is the subject of a prior English patent which has been suffered to lapse for non-payment of tax. The statute merely requires that in such case the patent shall be so limited as to expire at the same time with the foreign patent. Rev. St. Sec. 4887. This seems to mean that the term of the patent here shall be as long as the remainder of the term for which the patent was granted there, without reference to incidents occurring after the grant. *Henry v. Providence Tool Co.*, 3 Ban. & A. 501; *Reisner v. Sharp*, 16 Blatchf. 383. It refers to fixing the term, not to keeping the foreign patent in force.”

The words of the statute §4887

“so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term”

are capable of no misunderstanding in view of the decisions of this and other courts.

In *Pohl v. Anchor Brewing Co.*, 134 U. S., 381, 386, this court says:

"Section 4887 requires that the United States patent shall be so limited as to expire at the same time with the term limited by the foreign patent issued prior to the issuing of the United States patent, having then the shortest time to run. There is nothing in the statute which admits of the view that the duration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent, by means of the operation of a condition subsequent, according to the foreign statute. In saying that 'every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent,' the statute manifestly assumes that the patent previously granted in a foreign country is one granted for a definite term; and its meaning is, that the United States patent shall be so limited as to expire at the same time with such term of the foreign patent.

In the view that section 4887 is to be read as if it said that the United States patent is to be so limited as to expire at the same time with the expiration of the term of the foreign patent, or if there be more than one, at the same time with the expiration of the term of the one having the shortest term, the interpretation we have given to it is in harmony with the interpretation of the words 'expiration of term' in analogous cases. *Oakley v. Schoonmaker*, 15 Wend. 226; *Beach v. Nixon*, 9 N. Y. 35; *Farnum v. Platt*, 8 Pick. 338. In those cases it was held that the words 'expiration of term' do not mean expiration of term through a forfeiture by breach of a condition, but mean expiration by lapse of time." See also *Bonsack Mach. Co. et al. v. Smith et al.*, 70 Fed., 392.

The United States by Statute, Sec. 4887 of 1874, fixed the expiration of any patent applied for under it and the inventor applying for his patent which has been previously patented in a foreign country, accepts the contract

between himself and the Government and secures his monopoly for the term fixed by the statute and that only.

As was said by Judge Buffington in the Hennebique Const. Co. case (*infra*), in his very able dissenting opinion,

" 'length of term was the only test,' or as Justice Bradley puts it in his direct, forcible words:

'The term of the English (foreign) patent fixes the term of the American patent, nothing more, nothing less.'

"That is the plain meaning of the words. There is no ground for construction or the interjection of supposed intent. By the use of apt words of reference to the term of the foreign patent as a measure of time, and by its omission to refer to the terminable character of such foreign patent, Congress has made the then existing foreign time term the sole pertinent factor to fix the future time of the domestic patent."

In *Bate Refrigerating Co. v. Sulzberger*, 157 U. S., 1, this court reviewed to some extent the successive legislation in this country touching this subject, saying of the statute here under consideration (p. 36):

" 'Congress, in effect, by the existing law, says to an inventor seeking to enjoy the exclusive use in this country of his invention for the full term prescribed by law: "If your invention has not been introduced into public use in the United States for more than two years, you may, upon complying with the conditions prescribed, obtain an American patent, and you may, if you can, obtain a foreign patent. But the American patent will be granted on the condition that if you obtain the foreign patent first, your invention shall be free to the American people whenever by reason of the expiration of the foreign patent it becomes free to people abroad; but in no case shall the term of the American patent exceed seventeen years.' " This we deem to be a sound interpretation of the statute, giving to the words used the meaning required by their ordinary signification.' "

It declined to yield to the argument of very distinguished counsel to the effect that the statute was so unreasonable

that it should be mitigated or curtailed by interpretation, saying (p. 43):

"What may be due to inventors is a matter about which there may well exist differences of opinion. It is the province of the legislative branch of the government to say when a patent to an inventor shall expire, and therefore, when the public may enjoy, without charge, the benefit of the invention covered by it."

It then referred to considerations in behalf of the public which might have induced Congress to introduce this safeguard against the patent continuing in force in this country after the invention had accrued to the public in a country in which it had before been patented, saying (p. 44):

"We need not say whether these considerations were or were not sufficient to induce the change first made by the twenty-fifth section of the act of 1870 and perpetuated in the existing statute. They are referred to only as showing what Congress may have had in view when it provided, as it did, that an invention covered by a foreign patent, obtained or caused to be obtained before an American patent is granted for the same invention, should be free to the American public as soon as it became by reason of the expiration of the foreign patent free to the people of other countries."

As is conceded in appellant's brief (p. 6, also p. 11), although it appears on the face of the Cameron patent that it is granted for a term of seventeen years, Section 4887 of 1874 still applies to it under the decisions of this court. In *Refrigerator Co. v. Hammond*, 129 U. S., 151, 167, this court says:

"Under Sec. 4887 (of 1874), although, in the case provided for by it, the United States patent may on its face run for seventeen years from its date, it is to be so limited *by the courts, as a matter to be adjudicated on evidence in pais*, as to expire at the same time with the foreign patent, not running in any case more than seventeen years; but, subject to the latter limitation, it is to

be in force as long as the foreign patent is in force.  
(Italics ours.)"

In *Bate Refrigerating Co. v. Sulzberger*, 157 U. S., 43, this court says:

"the American patent is limited by law, whether it is so expressed or not in the patent itself, to expire with the foreign patent having the shortest term." See also *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 35 Fed., 134; *Leeds & Catlin Co. v. Victor Co.*, 213 U. S., 301, 325.

The Cameron *et al.* patent having thus been applied for under the law of 1874, which definitely and unchangeably fixed its term as fourteen years from November 8th, 1895, that is November 8th, 1909, expired on the latter date, with the British patent for the same invention, issued to the same patentees. Appellant cannot, nor do we understand that it does, contend that the United States Cameron *et al.* patent is still in force, unless the treaty of 1902 extended its normal life for a period of about seven years beyond the term fixed by the statute under which it was issued and beyond the term permitted in any foreign country, which is a party to this treaty.

#### The Treaty of 1902 Does Not Extend the Life of the Cameron *et al.* Patent in Suit.

It is our contention, in view of the treaty itself, the minutes of the convention, the circumstances under which it was made acceptable to the United States Government and the interpretation which has been put upon it by Congress and the courts, that the treaty of 1902 does not extend the life of any patents issued under the Statute, §4887 of 1874, and that the act of Congress of 1903, enacted to "effectuate the treaty," simply modified the Statutes of 1874 and 1897,

without extending the term of the Cameron *et al.* patent beyond the date of the expiration of the foreign patent (the British patent) having the shortest term, issued to the same patentees for the same invention.

It was contended in *Thomson-Houston Elec. Co. v. McLean*, 153 Fed., 883, especially in the Circuit Court, and in *United States Shoe Machinery Co. v. Duplessis Shoe Machinery Co.*, both in the Circuit Court and in the Court of Appeals, that the limitation imposed upon the term of United States letters patent by prior foreign patents had been repealed by the Statute of 1903 and by the treaty of 1902. Both of these contentions were overruled. See *United States Shoe Machinery Co. v. Duplessis Shoe Machinery Co.*, 155 Fed., 842. The same contentions have been further considered and overruled in subsequent cases. See *Malignani et al. v. Hill-Wright Electric Co.*, 177 Fed., 430; *Malignani et al. v. Jasper Marsh Consol. Elec. Lamp Co.*, 180 Fed., 442; *Coml. Acet. Co. v. Searchlight Gas Co.*, 188 Fed., 85.

Irrespective of whether it is to be presumed that a treaty could operate to extend United States patents beyond the term for which they were granted by the Patent Office or could have been legally granted at the time they were issued, without any modification in the law by act of Congress, it is certain that no such extraordinary interpretation and operation could be given to the treaty unless its terms unmistakably required it; and it is equally certain that no such effect was ever contemplated when this treaty was made. There is nothing in its language which could operate as an extension of patents whose terms had already been fixed by the law under which they issued, or which was intended to have any such effect.

There was at the time a controversy over the question whether where (as in many of the European countries) a patent expired with any foreign patent to the same inventor, and where (as also was the rule in many foreign countries par-

ticipating in this treaty) the foreign patent, while nominally granted for a specified term, might lapse before the end of that term if fees were not paid and other conditions complied with, such subsequent lapse of the foreign patent should operate to terminate the domestic patent, or whether it should be unaffected by any lapse of the foreign patent occurring after its issue, but before the end of the nominal term of the foreign patent.

The purpose of this treaty was plainly not to extend the life domestic patent beyond the term for which the foreign patent was presumably in force at the time of issue of the domestic patent, but to prevent the domestic patent which issued while the foreign patent was in force from being terminated before the statutory term for which the foreign patent then appeared to run. This was the meaning of the provision that patents in the different contracting states

" . . . shall be independent of the patents obtained for the same invention in the other states . . . "

The object was not to remove the limitations of the Statute upon their term as fixed by conditions existing at the time the patents issued, or to extend them beyond the term authorized at the time of issue, but to make them independent of any forfeiture of the foreign patents from occurrences subsequent to the issue of the United States patent, so that the term of the patent should be determined by conditions existing when it issued, and from that time forward should be independent of what might subsequently befall patents in other countries. It was to secure in all foreign countries the same rule in this respect which was applied by this court and other courts of this country, to which attention has already been called.

There was not the slightest intention of accomplishing more than this, and the language of the Statute imports no more.

It is entirely plain from the treaty itself and from the Act of Congress which was intended to effectuate it that the treaty was not intended to prevent patents from expiring with the

term of the foreign patent as that term existed at the time the domestic patent issued, but only to safeguard the domestic patent against being still further limited by the lapse of the foreign patent after the domestic patent was granted (and its term had become fixed by the nominal term of the earlier foreign patent).

The phrase "patents existing" of Article 4 *bis* assumes and includes an already fixed, definite and vested term in the existing patent just as much as it assumes and includes a fixed and definite invention as the subject-matter of that existing patent.

Such an existing patent with its subject-matter defined and its term already limited and defined shall in the future be independent says Article 4 *bis* of the patents obtained for the same invention in the other states.

The only scope that is left for such independence is with respect to any subsequent premature forfeiture or lapsing of the patents obtained for the same invention in other states.

Any extension of the independence of existing patents beyond this would be extraordinary and unnatural and wholly contrary to the spirit of our laws, as Mr. Forbes stated at the Brussels Conference in 1897, and probably contrary to the spirit of the laws of most nations.

It would have a retroactive effect not sanctioned by the laws of the United States.

Thus patents whose terms were fixed under Section 4887 of 1874 (including the patent in suit), invariably have the seventeen years' term written on the face of the grant, but it has been consistently and uniformly held that this is not the real term of the patent, but that the real term is something else and is what the law and the facts on the day of issue of the patent determine, just as if that term so determined had been written in the body of the grant as so many years and months and days.

*Bate Refrigerator Co. v. Sulzberger*, 157 U. S., 1, 43.

In the case of United States patents like appellant's, whose term is fixed by Section 4887 (of 1874), the dependence of the United States patent is upon the Statute rather than upon the foreign patent, although the normal term of the foreign patent has fixed the term of the United States patent.

Once issued, the United States patent has not the slightest dependence upon the foreign patent. On August 25, 1902, such patents were independent of foreign patents and Article 4 *bis* did not change their status in that regard.

The Chairman of the House Committee on Patents said to the House of Representatives when urging the passage of the law of 1903 to effectuate the treaty:

“The additional Act there agreed upon (referring to the then recent Brussels Convention of 1900) . . . does not extend by a single instant the life of any patent now in existence.”

The treaty was effectuated in the United States with this understanding. Any other interpretation would discriminate unfairly and unnecessarily in favor of foreign patentees and against United States citizens.

There can be no possible doubt that the rights of an applicant filing an application for patent under Section 4887 of 1874 are fixed by the Statutes and not enlarged by the treaty in any aspect of the case.

The court below, in dismissing the bill of complaint on the plea which brought in question the expiry of the United States patent by virtue of the expiration of the British patent issued to the same patentees for the same invention, has followed what has been unanimously adopted as the law of this country both before and since, and neither the treaty of 1902 nor the Statute of 1903 extends the life of the Cameron *et al.* patent beyond the term fixed by the Statute of 1874 under which it was applied for and issued.

The Circuit Court of Appeals in the case of the *United Shoe Machinery Company v. Duplessis Shoe Machinery Co.*

(155 Fed., 842), in affirming the Circuit Court, held, in substance, that:

"Article 4 bis, inserted in the international convention for the protection of industrial property of March 20, 1883, by the additional convention or act of December 14, 1900, proclaimed by the President August 25, 1902 (32 Stat. 1936, 1939), as controlled and construed by Act March 3, 1903, c. 1019, 32 Stat. 1225 (U. S. Comp. St. Supp. 1905, p. 663), 'to effectuate the provisions' of such additional act of convention, did not have the effect of changing the term of an existing United States patent as fixed by statute at the time of its issuance; and such a patent granted prior to January 1, 1898, and which is limited by the provisions of Rev. St. 4887 (U. S. Comp. St. 1901, p. 3382), to the term of a prior foreign patent, is not extended by such additional act."

(The court's particular attention is called to pages 846, 847, 848 and 849.)

In *Hennebique Construction Co. v. Myers* (172 Fed., 874), Judge Buffington, in a very able dissenting opinion, reaches the same conclusions as adopted in the First Circuit, although his reasoning is somewhat different. This dissenting opinion is pertinent, as the majority of the court did not consider it necessary to determine this treaty question in deciding the case before them, and Judge Archbald, who filed the concurring opinion, admits (in the recent case of *Union Typewriter Company v. L. C. Smith & Bros.*, 173 Fed., 288 298) that his opinion, which is adverse to that of Judge Buffington and of the Court of Appeals of the First Circuit, was not the opinion of the court, and indicates that the opinion he expressed in the Hennebique case might not be his present opinion, as he uses the following language in the Union Typewriter Company case when referring to this Hennebique case:

"While my opinion was not the opinion of the Court, and no point is made of the treaty by counsel at this time; I prefer, the case being otherwise disposed of, to

*say nothing to anywise conflict with the views so expressed."*

Since that time even the Court of Appeals of the Third Circuit, in which Judge Archbald was sitting when writing his concurring opinion in the Hennebique case, recognizes the law as settled, that the statutory limitations determine the expiry of United States patents with the expiry of the earlier foreign patents having the shortest term, upon applications filed before January 1, 1898; as in the case of *Highland Glass Company v. Schmertz Wire Glass Co. et al.*, 178 Fed., 944, 951, the court says:

"Whether priority should be awarded by the court to the Schmertz claim or the Appert claim, the Mississippi Company would own the successful claim. There was this difference, however: *If the Appert patent won, the monopoly of the Mississippi Company under it would expire on April 14, 1908, with the expiration of the prior British patent.* If the Schmertz patent won, the same monopoly would be continued in the Mississippi Company to the end of the term of these patents, which would not expire until 1922."

Judge Buffington's opinion in the Hennebique case, which is in accordance with the decision of the lower court, so clearly states the law on this subject when taken in connection with the opinions of the Court of Appeals of the First Circuit and the opinions of the other courts herein cited, that particular attention is called to it in view of the fact that it reaches the same conclusion as all of the courts which have passed upon the subject, and as the only view adverse thereto is the one ventured by Judge Archbald, which he expressly states was not the opinion of the court and which has not been considered the law of the Court of Appeals of the Third Circuit, nor by any other court since, and this, Judge Archbald himself indicates may not be even his opinion at the present time.

In *Malignani et al. v. Hill-Wright Electric Co.*, 177 Fed.,

430, 434, Judge Hazel, of the Southern District of New York, in refusing to follow the opinion of Judge Archbald, says:

"The effect of the decision in the Hennebique case, if followed by this court, would be that the patent in suit, which supposedly has expired, in reality remains valid and inforceable for 17 years from April 16, 1895, and is wholly unaffected by the prior Italian patent or the term for which it was limited. A careful perusal of the opinions written by Judges Gray, Buffington and Archbald indicates that the holding of Judge Archbald, in which Judge Gray concurred, was not actually necessary to a decision of the case, and in view of his later remarks in *Union Typewriter Co. v. L. C. Smith & Bros.* (C. C.), 173 Fed. 288, wherein he states that his opinion on this subject was not the opinion of the court, I do not feel bound to follow it. Moreover, I am persuaded by the additional briefs submitted by counsel bearing upon this question since the Hennebique decision was reported that article 4 *bis*, or the treaty is not entitled to receive the construction given it. The article or treaty and the subsequent Act of Congress of March 3, 1903, to effectuate the provisions of the additional acts of the convention have heretofore been passed upon and construed by the Circuit Court of Appeals for the First Circuit. *United Shoe Co. v. Duplessis Shoe Co.*, 155 Fed. 842, 84 C. C. A. 76. In that case it was unqualifiedly held that the Act of March 3, 1903, did not alter or vary the terms of an existing United States patent as established by law at the time the patent was granted; that Congress by its enactment had declared by implication that article 4 *bis* of the treaty was without retroactive effect." (Italics ours.)

Judge Hazel in this case holds that the patent in suit expired

"because of the expiration of the prior Italian patent for the same invention."

In the case of *Malignani et al. v. Jasper Marsh Consol. Electric Lamp Co.*, 180 Fed., 442, Judge Brown of the Circuit Court of Massachusetts holds that

"Article 4 *bis* provided by the International Conven-

tion for the Protection of Industrial Property of December 14, 1900, at Brussels, ratified by the United States Senate and proclaimed by the President to take effect September 14, 1902 (President's Proclamation, Dec. 14, 1900, 32 Stat. 1940), did not repeal the limitation of the United States patent to the term of the previous foreign patent for the same invention."

In this case Judge Brown calls attention to the decisions preceding his, and very clearly points out the harmful effects of supporting the contentions made by the complainants here in the following language (p. 445):

"Section 4887, Rev. St. (U. S. Comp. St. 1901, p. 3382), as it stood at the time of the grant of letters patent to Malignani, limited every United States patent to expire at the same time with a previous foreign patent for the same invention. It made no discrimination between American and foreign inventors in this respect. It applied as well to a citizen of the United States who first patented his invention in a foreign country as to a citizen of a foreign state who first patented his invention in a foreign country.

"It was no part of the scheme of the treaty to enlarge the terms of United States patents granted to citizens of the United States.

"To give to article 4 *bis* the effect of enlarging the terms of United States patents granted to citizens of foreign states, without enlarging the terms of United States patents granted to citizens of the United States, would put citizens of other countries on a more favorable footing than our own citizens. This would directly conflict with the terms of article II, and with the rule of construction applied in *French Republic v. Saratoga Vichy Co.*, 191 U. S. 427, 24 Sup. Ct. 145, 48 L. Ed. 247.

"To avoid this inequality by holding that the treaty so changed the domestic law as to enlarge also the terms of grants of United States patents to citizens of the United States would raise a question of the constitutional power of the President and Senate, even if the power to admit citizens of foreign states to equal rights with citizens of the United States be conceded. Opinion of W. H. H. Miller, Atty. Gen., 47 O. G. 397.

"Construing article 4 *bis* with article II, it seems to

have no proper application to a statute which is a part of the domestic law concerning the terms of United States patents, affording equal legal rights to citizens of foreign countries and to citizens of the United States.

"We must conclude, therefore, that the patent in suit expired on March 31, 1909. The question remaining is of the complainants' right to an accounting up to that date."

In the very recent case of *Coml. Acet. Co. v. Searchlight Gas Co.*, 197 Fed., 918, Judge Kohlsaat holds that the treaty does not affect or change the term of a United States patent applied for prior to January 1, 1898, under the Statute of 1874, and briefly reviews the prior decisions on the subject as follows (p. 919) :

"The effect of this treaty was under consideration by the Circuit Court of Appeals for the First Circuit in the case of *United Shoe Co. v. Duplessis Shoe Co.*, 155 Fed. 842, 84 C. C. A. 76, where it was held that the treaty did not have the effect of removing the limitation thereto existing upon a patent applied for before January 1, 1898, under the provisions of the Act of July 8, 1870, c. 230, 16 Stat. 201, whereby the lifetime of a later domestic patent was limited to that of the foreign patent. That case is well considered and very persuasive. It is deemed to be the correct expression of the law for the purposes of this hearing. It has been followed in *Malignani v. Hill-Wright Electric Company* (C. C.), 177 Fed. 430; *Malignani v. Jasper Marsh Consolidated Electric Lamp Company* (C. C.), 180 Fed. 442. The same doctrine is approved in *Highland Glass Co. v. Schmertz Wire Glass Company*, 178 Fed. 944, 102 C. C. A. 316. Commenting upon the act of 1903 entitled 'An act to effectuate the provisions of the additional act of the international convention (of December 14, 1900) for the protection of industrial property,' the court in *Shoe Machine Co. v. Duplessis Shoe Mach. Co.*, *supra*, having reference to the language of *Dallemagne v. Moisan*, 197 U. S., 169, 25 Sup. Ct. 422, 49 L. Ed. 709, said:

" 'Fairly paraphrasing the language of the Supreme Court cited, we may say that the statute of 1903, having been found for the purpose of executing treaties, must be regarded as expressing the only effect which

Congress intended they should have to the extent of the subject-matters to which the act relates. In re-enacts section 4887 in such form as Congress desired, faithfully omitting such parts of the convention of 1900 as referred to patents existing at the time it went into effect, or as referred to newly adhering states.'

"Under the authorities, except perhaps the opinion of Judge Archbald in *Hennebique Construction Co. v. Myers*, 172 Fed. 869, 97 C. C. A. 289, the rule is well settled that the treaty of Brussels did not affect the life of a patent issued in this country where a foreign patent had been first granted. The opinion of Judge Archbald is conceded to be not the opinion of the Court of Appeals for the Third Circuit. *Union Typewriter Company v. L. C. Smith & Bros.* (C. C.), 173 Fed. 288, 298, 299. Nor was the life of the domestic patent in such case extended by the act of 1903. This is deemed satisfactorily demonstrated by the reasoning in the following cases, viz.: *Sawyer Spindle Co. v. Carpenter*, 143 Fed. 976, 75 C. C. A. 162; *Shoe Co. v. Shoe Co.*, *supra*; *Malignani v. Hill-Wright Elec. Co.*, *supra*; *Malignani v. Marsh Consolidated Electric Lamp Co.*, *supra*."

There is also an unreported decision in *Westinghouse Elec. & Mfg. Co. v. Bullock Elec. & Mfg. Co.*, by Judge Sater of the Sixth Circuit, holding that the patent there sued on expired July 28, 1906, with the English patent which was issued July 28, 1892. Judge Sater cites with approval the cases relied upon here to support appellee's contention, and calls attention to the opinion of Judge Archbald in the Hennebique case, and to his subsequent opinion in *Union Typewriter Co. v. L. C. Smith*, 173 Fed., 289, in which he states that his opinion in the Hennebique Construction case was not that of the court. Judge Sater says:

"The patent expired July 28, 1906, with the English patent which was issued July 28, 1892. *U. S. Shoe Mach. Co. v. Duplessis Shoe Mach. Co.*, 155 Fed. Rep., 842; *Malignani v. Jasper Marsh Consol. Elec. Lamp Co.*, 180 Fed. Rep., 442; *Malignani v. Hill-Wright Elec. Co.*, 177 Fed. Rep., 430. I am aware that the conclusion thus

reached is not in harmony with the construction placed by Judge Archbald in *Hennebique Const. Co. v. Myers*, 172 Fed. Rep., 869, on the treaty of December 14, 1900, and the enactments of Congress. Judge Gray concurred with him in his conclusion, but held that a determination of the effect of such treaty and legislation was unnecessary to a decision of the case. The court divided, each judge submitting an opinion. In *Union Typewriter Co. v. L. C. Smith & Bros.*, 173 Fed. Rep., 288, 289, Judge Archbald expressly states that his opinion in the Hennebique Construction Company case was not that of the court. The case is cited in *Interlocking Steel Sheetings Co. v. Friestedt Interlock, C. Bar Co.*, 182 Fed. Rep., 398, but whether with approval or disapproval, cannot with certainty be determined."

The conclusions unanimously reached by the Circuit Court of Appeals of the first Circuit, by Judges Lowell and Brown of the First Circuit, by Judge Hazel of the Second Circuit, by Judge McPherson of the Third Circuit, by Judge Sater of the Sixth Circuit, by Judge Kohlsaat of the Seventh Circuit, by Judge McPherson of the Eighth Circuit, and the opinion of Judge Buffington of the Third Circuit, which is acquiesced in by the Court of Appeals of the Third Circuit in subsequent cases, are uniformly supported by authorities both directly and indirectly bearing upon the subject.

In *Leeds & Catlin v. Victor Co.*, 213 U. S., 301, this court went into an extended discussion of the question whether the patent in suit was still in force, or had expired by reason of the expiration of the prior foreign patents. That discussion, extending over many pages, turned on the issue whether the invention of the claims in suit being the principal invention of the patent, was disclosed in the prior foreign patents. The case was earnestly litigated through the Circuit Court, the Court of Appeals of the Second Circuit, and this court. The entire discussion in all the courts proceeded upon the assumption that the above-mentioned Section 4887 was still in force, and governed the term of the patent in suit. If it had not been regarded as still in force, alike in this court and in each of the subordinate courts, there would have been

an end to that discussion. It is impossible to believe that this court or the subordinate courts would have entered seriously into the long discussion of fact and law if they had regarded the treaty (with which they were all familiar) as having relieved all patents then in force from the limitations imposed upon them at the time they were granted by reason of prior foreign patents.

In *Rousseau v. Brown*, decided by the Court of Appeals for the District of Columbia, January 20, 1903, 104 O. G., 1120, the court, referring to the treaty concluded at Paris March 20, 1883, to which the treaty of August 25, 1902, here in controversy was simply supplementary, holds in substance that,

"The international convention for the protection of industrial property, concluded at Paris, March 20th, 1883, is in the nature of a contract between the parties and is not self-executing. It requires legislation by Congress to render it effective in this country."

and that,

"The various stipulations of the Convention of 1883 are of such a character as to require a modification of the statutes in this country to give them full force and effect."

The same situation exists in the present case as existed in the case referred to, so far as the law is concerned, and the Court of Appeals of the District of Columbia disposed of it in this decision.

See also,

*Butterworth v. Boral & Kymer et al.*, decided in 1901, 97 O. G., 1596.

*Ex parte Zwack & Co.*, decided June 16, 1896, 76 O. G., 1855.

Hon. W. H. H. Miller, Attorney General of the United States, 47 O. G., 397, held that treaties relating to patents are not self-executing, but require legislation to render them effective for the modification of existing laws. The at-

torney general in this opinion indicates clearly that the very treaty under consideration here as originally in force did not become a law until enacted by Congress under the constitutional provisions giving Congress the power (Art. 1, Sec. 8, Par. 8),

"To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive rights to their writings and discoveries."

and he indicates the danger of failing to provide in such treaties that they shall not become effective until Congress shall have made them laws, in the following language:

"If the treaty making power in all treaties whose execution requires the exercise of powers committed to Congress, should uniformly provide in the treaties for their proper submission to Congress before they should be effective, consequences might be avoided which may jeopardize the credit of a nation."

It being conceded that the foreign patents have expired, appellee contends that, the British patent to Cameron *et al.* being admittedly for the same invention as disclosed in the United States patent to these inventors, the United States patent was necessarily terminated by the grant itself at the same time as the British patent.

#### **Treaty Making Power Controlled by Constitution, and Treaties Relative to Patents to Become Binding on Citizens of United States Must Be Enacted by Congress.**

Certain fundamental propositions of law determine the construction which is to be placed upon the treaty:

*First.* It has been repeatedly held that the treaty making representatives of the government are controlled by and cannot go beyond the Constitution of the United States.

*De Geofroy v. Riggs*, 133 U. S., 258, 267, 33 L. Ed. 264.  
*Ft. Leavenworth Ry. Co. v. Lowe*, 114 U. S., 525, 29 L. Ed., 264.

*Jones v. Walker*, Fed. Cas., 7507.

*Second.* The treaty making department of the Government can only bind the United States in relation to patents to such extent as Congress later ratifies, as Congress has the power to grant patents for limited times, under the Constitution and this power cannot be divested by the treaty making power.

Article 1, Sec. 8, of the Constitution, reads:

Sec. 8. "Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries."

*Evans v. Robinson*, Fed. Cas., 4571.

*Third.* Congress by statutory provision, Rev. Stat. (Sec. 4887) of 1874, under which the Cameron *et al.* patent was applied for and taken out, fixed the term of this United States patent, which had been previously granted to the same patentees for the same invention in certain foreign countries, to be so limited in term as to expire with the foreign patent having the shortest term (to-wit, the British patent of Nov. 8, 1895).

*Fourth.* The treaty in question cannot be self-executing because the constitutional right to grant patents is in Congress and the Congressional Act of 1903 entitled "An act to effectuate the provisions of the additional act of the international convention, for the protection of industrial property," distinctly shows that *Congress itself did not consider the treaty as self-executed, nor did it consider it as retroactive in effect, or as in any manner applying to patents existing when the treaty was ratified.* *Congress interpreted the treaty as it was intended to be interpreted by the convention, whose minutes show distinctly that this treaty was to be considered as not applying to existing patents*, and hence not applicable to extend or in any way affect the duration of the patent here in question, which expired on Nov. 8, 1909, For notes of convention see *Hennebique Construction Com-*

*pany v. Myers*, 172 Fed., 881, 882 and 883; also Appendix, *infra*, pp. 59-69:

In *Foster v. Neilson*, 2 Peters, 253, 313-314, Chief Justice Marshall, rendering the opinion of the court, in discussing the effectiveness of treaties, declared:

"A treaty is in its nature a contract between two nations, not a legislative act. It does not generally effect of itself the object to be accomplished, especially so far as its operation is *infra* territorial, but is carried into execution by the sovereign power of the respective parties to the instrument.

"In the United States a different principle is established. Our constitution declares a treaty to be the law of the land. It is, consequently, to be regarded in courts of justice as equivalent to an act of the legislature, whenever it operates of itself without the aid of any legislative provision. But *when the terms of the stipulation import a contract, when either of the parties engages to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the court.*" (Italics ours.)

Attorney-General Miller, in citing this case with approval (in his opinion, 47 O. G., 397, Appendix, *infra*, pp. 53-58), says of the principle thus stated by Justice Marshall that it

"has been generally accepted as a true interpretation of the constitutional provisions relating to the subject of treaties. It establishes that there is a class of treaties which, without legislation, do not become self-executing as a rule of municipal law."

And in speaking of the original treaty to which the treaty (urged by appellant here) of 1902 is simply supplemental, the Attorney-General says:

"It is a contract operative in the future *infraterritorially*. It is therefore not self-executing but requires legislation to render it effective for the modification of existing laws."

In this opinion the Attorney-General discusses quite fully the different conditions which have arisen out of the execution of treaties in general and the way in which their execution has been treated by the United States and other countries, and clearly demonstrates that the treaty does not extend the life of the patent in suit, which was limited by the statute under which it was taken out to expire with the patentee's foreign patent having the shortest term.

*Fifth.* To the extent that Congress did not adopt the provisions of the treaty of 1902, it repealed and modified this treaty in conformance with the intention expressed in the minutes of the convention, to the effect that it should not apply to patents in existence at the time of the ratification of the treaty.

In *Dallemande v. Moisan*, 197 U. S., 169, 175, this court said in relation to "an act to provide for the execution of treaties, etc.":

"The act was carried forward in substance, into the Revised Statutes of the United States. . . . This Statute having been passed by the United States for the purpose of executing the treaties it had entered into with foreign governments, must be regarded as the only means proper to be adopted for that purpose." (Italics ours.)

See also,

*United Shoe Machinery Co. v. Duplessis Shoe Machinery Co.*, 155 Fed., 842, 848.

*Commercial Acetylene Co. v. Searchlight Gas Co.*, 197 Fed., 908, 919.

Congress can modify or annul treaties, by laws within its legislative powers, and as the Constitution gives to Congress the right to grant patents, the treaty in question only becomes effective on the people of the United States when and to the extent that the provisions of the treaty were enacted by Congress.

In *Taylor et al. v. Morton*, 2 Curtis, C. C., 454, 457, Mr.

Justice Curtis, who heard the case while sitting in Circuit, said:

"It must be admitted, also, that in general, power to legislate on a particular subject, includes power to modify and repeal existing laws on that subject, and either substitute new laws in their place, or leave the subject without regulation, in those particulars to which the repealed laws applied. *There is therefore nothing in the mere fact that a treaty is a law, which would prevent Congress from repealing it.*"

*The Cherokee Tobacco*, 78 U. S., 616, 20 L. Ed., 227.

In the very important case of *Edye et al. v. Robertson*, 112 U. S., 580, 28 L. Ed., 266, which is commonly known as the "Head Money Case," this court holds that

"so far as the provisions of a treaty can become the subject of judicial cognizance in the courts of the country, *they are subject to such acts as Congress may pass for their enforcement, modification, or repeal.*" (Italics ours.)

In this case, this Court cites with highest approbation, the decision of Mr. Justice Curtis in *Taylor v. Morton*, 2 Curtis, 454, and that of Mr. Justice Field in the case of *Ah Lung*, 18 Fed. Rep., 28, referred to herein.

The court says in this connection:

"The precise question involved here, namely, a supposed conflict between an Act of Congress imposing a customs duty and a treaty with Russia on that subject in force when the Act was passed, came before the Circuit Court for the District of Massachusetts in 1855. It received the consideration of that eminent jurist, Mr. Justice Curtis of this court, who in a very learned opinion exhausted the sources of argument on the subject, holding that if there were such conflict the Act of Congress must prevail in a judicial forum. *Taylor v. Morton*, 2 Curtis, 454. And Mr. Justice Field in a very recent case, in the Ninth Circuit, that of *Ah Lung*, 18 Fed. Rep., 28, on a writ of *habeas corpus*, has delivered an opinion sustaining the same doctrine in reference to a statute regulating the immigration of Chinamen into this country. In

the Clinton Bridge case, Woolworth, 150, 156, the writer of this opinion expressed the same views as did Judge Woodruff on full consideration in *Ropes v. Clinch*, 8 Blatchford, 304, and Judge Wallace, in the same circuit, in *Bartram v. Robertson*, 15 Fed. Rep., 212. It is very difficult to understand how any different doctrine can be sustained."

This court, after thus unqualifiedly approving the decisions of Mr. Justice Curtis and Mr. Justice Field to the effect that an Act of Congress if later in date, repeals a treaty inconsistent with it, very clearly demonstrates that it is fundamental that there is nothing in a treaty made law which prevents Congress from modifying or repealing it or passing Acts for its enforcement as follows:

"But even in this aspect of the case there is nothing in this law which makes it irrepealable or unchangeable. The Constitution gives it no superiority over an act of Congress in this respect, which may be repealed or modified by an act of a later date. Nor is there anything in its essential character, or in the branches of the government by which the treaty is made, which gives it this superior sanctity.

"A treaty is made by the President and the Senate. Statutes are made by the President, the Senate and the House of Representatives. The addition of the latter body to the other two in making a law, certainly does not render it less entitled to respect in the matter of its repeal or modification than a treaty made by the other two. If there be any difference in this regard, it would seem to be in favor of an act in which all three of the bodies participate. And such is, in fact, the case in a declaration of war, which must be made by Congress, and which, when made, usually suspends or destroys existing treaties between the nations thus at war.

"In short, we are of opinion that, *so far as a treaty made by the United States with any foreign nation can become the subject of judicial cognizance in the courts of this country, it is subject to such acts as Congress may pass for its enforcement, modification, or repeal.*" (Italics ours.)

In *Horner v. U. S.*, 143 U. S., 570, 36 L. Ed., 266, this court holds (p. 578) :

"The proposition that that section is void if it contravenes a treaty between the United States and Austria is not tenable. *The statute is a law equally with the treaty, and, if subsequent and conflicting with the treaty, supersedes the latter.* *Head-Money Cases*, 112 U. S., 580; *Whitney v. Robertson*, 124 U. S., 190; *Chinese Exclusion Case*, 130 U. S., 581." (Italics ours.)

*In re Ah Lung*, 18 Fed., 28, Mr. Justice Field, with whom also sat Circuit Judge Sawyer, in this case very clearly defines the way in which this Government recognizes treaties and Acts of Congress in their relation to each other, in the following language (p. 29) :

"A treaty is, in its nature, a contract between two nations, and by writers on public law is generally so treated and not as having of itself the force of a legislative act. The constitution of the United States, however, places both treaties and laws, made in pursuance thereof, in the same category, and declares them to be the supreme law of the land. It does not give to either a paramount authority over the other. So far as a treaty operates by its own force without legislation, it is to be regarded by the Court as equivalent to a legislative act, but nothing further. *If the subject to which it relates be one upon which Congress can also act, that body may modify its provisions or supersede them entirely.*" (Italics ours.)

See, also, *La Republique Francaise v. Schultz*, 57 Fed., 37.

It is our contention that Congress in passing the Statute of 1903 to effectuate the Brussels treaty interpreted this treaty as it had been interpreted by the Brussels conference, by the representatives at that conference, and by the administrative officers and courts of the United States.

This Statute puts into effect Article 4 bis of the Brussels treaty to just the extent that the Brussels convention and Congress intended to have it operate and no more. The treaty became effective only so far as it was enacted under the laws of this country by the Statute of 1903. That

Statute does not give the treaty a retroactive effect, nor does it in any way limit the terms of United States patents whose terms had already been previously fixed at the time of their issue by the Statute of 1874 (Sec. 4887) to expire with the foreign patent having the shortest term.

The appellant's brief refers to the Act of 1903 as disturbing vested rights acquired under the treaty. This argument is unsound, as no rights ever vested in the holders of any patents issued on applications filed under the Revised Statutes (Sec. 4887) of 1874 to extend the life of patents granted for a specific term, for by the very grant itself the term was limited by Congress, and no additional rights could be conferred, except such as were conferred by Congress itself. The only vested rights in any way affecting the patent in suit are those which the Statute of 1874 fixed at the time this patent was issued. If appellant's contentions to the effect that an act of Congress could not affect rights which they claim were vested under the treaty, are to be believed, certainly then the treaty of 1902 could not divest rights vested in the public and patentee by the Statute under which the patent in suit was applied for and issued, and under which the public has always acted in the transaction of its business relative to such patents.

The very source from which the treaty-making representatives of this Government derive their right is the Constitution of the United States, and to permit the treaty-making branch to override the power which gives it existence and usurp the powers of Congress, in order to sustain appellant's contention as to the extension of existing patents by treaty, is incomprehensible. The courts have realized this, as evidenced by the uniformity of decisions to the effect that neither the treaty of 1902, nor the statute of 1903 in any way extended the life of United States patents which were limited, to expire with the foreign patent having the shortest term, by the statutes under which they were applied for and granted.

### Historical Sketch of Brussels Treaty.

THE MINUTES OF THE CONVENTIONS, THE REPORTS OF DELEGATES TO THE UNITED STATES, AND THE PASSAGE OF THE ACT OF CONGRESS TO EFFECTUATE THE TREATY, CLEARLY DEMONSTRATE THAT THE ONLY EFFECT TO BE GIVEN TO ARTICLE 4 BIS, WAS TO PREVENT ANY SUBSEQUENT ACT IN A FOREIGN COUNTRY TERMINATING UNITED STATES PATENTS ONCE ISSUED, BUT NOT IN ANY WAY TO EXTEND THE LIFE OF PATENTS FIXED BY THE STATUTE UNDER WHICH THEY ARE TAKEN OUT.

In order that the court may have before it in as concise form as possible, what led up to the treaty in question and its additional act, its proclamation by the President of the United States, and the Act of Congress to effectuate this treaty, we have printed in an appendix (*infra*, pp. 43-119), such portions of the documents as we have been able to find in any way bearing on these questions.

In 1883, representatives of various nations met for the purpose of securing protection to industrial property by entering into certain reciprocal relations relative thereto. The execution of the treaty resulting, was subordinated to the

“formalities and rules established by the constitutional laws of such of the high contracting parties as are bound to ask the application thereof which they agree to do within the shortest delay possible.”

On May 30th, 1887, the United States acceded to this convention of 1883, and the accession was proclaimed by the President on June 11th, 1887. (See Appendix, *infra*, p. 43.)

The Attorney General of the United States in 1889, in a well-considered opinion (*infra*, p. 58), held that this treaty could not be regarded as self-executing, and this view was followed by the Patent Office and the Court of Appeals of the District of Columbia in the cases heretofore cited (*supra*, p. 23).

From the date of this opinion until March 3rd, 1897 (effective January 1st, 1898), Congress had passed no special legislation to effectuate the treaty of 1883. The United States during this period allowed patentees in foreign countries to apply for patents in this country under the statute of 1874 (Sec. 4887), and limited such to expire with the foreign patent having the shortest term.

The administrative officers of the Government, including those in charge of the United States Patent Office, have acted under this opinion of the Attorney General, and it has been approved by the courts.

A second International Conference was held at Brussels in December, 1897, for the purpose of considering the advance proposals of the International Bureau which had been created by the Convention of 1883, and the minutes of the proceedings show that Article 4 *bis*, under consideration here, and the effect which it was to have on the normal term of existing patents, was very fully discussed.

The representatives of the United States Government were Bellamy Storer, Esq., and Francis Forbes, Esq.

At the time Article 4 *bis* was under consideration, Mr. Forbes stated that any act which could be considered as retroactive would not be considered with favor in the United States, as it was contrary to the spirit of our laws.

In order to obviate the objections made by Mr. Forbes, the Belgian delegate, Dubois, gave it as his opinion that this article as it now appears, was not intended to extend the term fixed by law at the date of issue, and thus act retroactively, but to leave patents thus issued in full force for the term thus fixed in the following language (*infra*, p. 65) :

"It is really not the purpose to retroactively modify the normal term of the patent which remains such as it was fixed by law at the time of its issuance",

and Article 4 *bis* as it now stands (*infra*, p. 66) :

"establishes the principle of Independence as to incidents,

notable lapses and nullities which may occur after the issuance of the patent; but the internal law can fix the normal duration of a patent taken out in the country."

Even in view of these remarks, the United States representatives insisted on having the true and intended construction of this Article precisely stated, and Mr. Morel, President of the Convention and Director of the International Bureau, suggested that Article 4 *bis* be amended by adding to the second paragraph the words:

"This provision shall apply to patents in existence at the time of its being put into force; its effects are, however, limited to nullities and lapses which would affect anterior patents."

The French delegate, Mr. Pelletier, expressed the opinion that this Article (*infra*, p. 66),

"leaves to each national law the care of regulating all matters pertaining to patents taken out in the country",

thus confirming the opinion of the Belgian delegate.

The United States delegate, Bellamy Storer, then asked that there be added to this Article the words (*infra*, p. 66):

"However, the term fixed by the internal law of each country remains intact."

In order to have the Act passed immediately, Mr. Morel, the President (*infra*, p. 66):

"proposes to leave the text of article 4 *bis* without any change, and to state in the minutes of the meeting that this article should receive the interpretation which has just been indicated. The American Delegation would thus obtain complete satisfaction."

Mr. Bellamy Storer for the United States then (*infra*, p. 67),

"declares this combination acceptable, if it meets with the unanimous adhesion of the Conference."

After some further discussion, Mr. Morel, President (*infra*, p. 67),

"puts to a vote the adoption of the text previously adopted for Article 4 *bis*, with the interpretation which the American Delegation desire to specifically point out by proposing to complete the second paragraph by this explanatory clause:—'However, the term fixed by the internal law of each country remains intact'—"

The next record which appears on the minutes of the proceeding is (*infra*, p. 67),

"Article 4 *bis* is definitely adopted with these conditions."

These minutes show the construction placed upon Article 4 *bis* in question, by the Convention itself.

(For minutes of this Conference, see (*infra*, pp. 61-69), also *Construction Co. v. Myers*, 172 Fed., pages 881-2-3).

The United States delegates, Messrs. Forbes and Storer, in order to prevent any misconstruction of the Treaty in making their report to the Secretary of State, Honorable John Sherman, concerning Article 4 *bis*, say (*infra*, pp. 67-70):

"In order to avoid any confusion in regard to the interpretation hereafter to be given to the second paragraph, which reads:—'This provision shall apply to all patents existing at the time of its entering into force,' we called attention to it in the regular meeting and found that it was the *unanimous sense* of the Conference that the paragraph was not applicable to existing United States patents, but only to those patents whose terms might be shortened by the laws of those States of the Union in which provision is made for a shortening of the term on the lapsing of patents for the same invention in other States.

"An existing United States patent cannot be affected by what may take place in regard to a patent for the same invention abroad. The limitation of the terms of the United States patents imposed by section 4887 was a determination at the moment of the grant of the patent of its term, and therefore the duration of the patent is unaffected by the subsequent expiration of a foreign patent

for the same invention by reason of non-payment of taxes or non-working."

It will thus be seen that the delegates of the United States interpreted Article 4 *bis* as not applying to any existing United States patent, and gave the United States Government to understand that this was to be the unanimous interpretation of the countries accepting it, and that the term of a United States patent taken out under Section 4887, as has been held repeatedly by the courts of this country, was fixed at the date of its issue.

The English delegates in their reports to their Government, try to make it appear that the subjects of Great Britain are going to secure some very material advantage in the United States over the advantage given to United States citizens in Great Britain, by stating that (*infra*, pp. 75-76),

"The ordinary life of a British patent is shorter than that of a patent in any other State in the Union and consequently, the alteration is in favor of British patentees", but are forced to admit the interpretation which has been given to Article 4 *bis* by the Convention, when they say (*infra*, p. 76) :

"But the Delegate of the United States made a declaration at the final stage of the proceedings that his country could not bring the legislation which would be necessary to carry the second paragraph of this new article into effect, so far as the United States were concerned."

On June 4th, 1898, an Act was passed by Congress to amend the United States laws relative to patents and trade-marks (*infra*, pp. 76-77) :

"So far as the same relates to matters contained in or affected by the Convention for the Protection of Industrial Property concluded at Paris March twentieth, eighteen hundred and eighty-three, and agreements made under said convention concluded at Madrid April fourteenth, eighteen hundred and ninety-one, and the protocols adopted by the conference held under such con-

vention at Brussels, eighteen hundred and ninety-seven, and the treaties of the United States, and the laws of other nations."

This Act effectuated the original Treaty of 1883, and demonstrates that legislation was necessary to carry such a treaty into effect to act infraterritorially.

The report of the commissioners appointed by the President, Mr. Francis Forbes, Judge Peter S. Grosscup and Mr. Arthur P. Greeley, was printed by the Government November 27th, 1900.

While this report contains information as to the existing patent laws of different nations, discusses changes in the patent laws and recommends that bills be enacted by Congress concerning the same and the treaty obligations of the United States in regard to foreign patents, there is nothing in it which has any particular significance in this consideration of Article 4 *bis*. However, we have printed (*infra*, pp. 78-82) certain statements of the committee which seem most pertinent.

On December 11th, 1900, the International Conference for the Protection of Industrial Property, which had suspended its work in 1897, convened to take definite action concerning matters before it in 1897.

The United States was represented by Mr. Lawrence Townsend, Mr. Francis Forbes and Mr. Walter H. Chamberlin. The minutes of this convention (*infra*, pp. 83-87) show that it in no wise changed the interpretation of Article 4 *bis* given by the delegates at the Brussels Convention in 1897, to the effect that the term of a United States patent issued under Section 4887 of 1874, was not extended by the treaty, but that the term when thus fixed, remained unchanged.

The report of the United States delegates is to the same effect (*infra*, pp. 85-87).

The Act resulting from the sessions at Brussels of 1897 and 1900, entitled "An Additional Act to the Convention," has embodied in it, Article 4 *bis* (now before the court) in the

same form (save for slight differences in translation) as was before the Convention of 1900, was signed by the delegates of the United States on December 14th, 1900 (*infra*, p. 90), ratified by the Senate March 7th, 1901 (*infra*, p. 91), and proclaimed by the President August 25th, 1902 (*infra*, pp. 91, 95).

The domestic laws of different countries which had been a party to the convention of 1900 show, that they all changed the time which was allowed foreigners to file an application for patent in these countries after it had been applied for in a foreign country, from seven months to twelve months, as was the expressed intention of the convention, but no one of them changes the term of existing patents (*infra*, pp. 96-103).

On September 16th, 1902, the International Union for the Protection of Industrial Property passed a resolution to the effect that the additional Act of Brussels

“ought to be construed in its broadest sense”, but there is no suggestion that any retroactive effect be given to the act to limit the term of patents then in existence and whose term had already been fixed by the statutes under which these patents were issued.

This resolution does nothing more than Article 4 *bis* itself, when considered in connection with the minutes of the Convention that adopted it.

Congress did not, immediately after the execution of the treaty, pass an act to effectuate the provisions of this treaty, and on October 29th, 1902, the Charge d' Affaires of Switzerland, Lardy (*infra*, pp. 104-106), wrote Mr. John Hay, then Secretary of State, protesting that the United States had not passed such an act, and that it was imperative to have this enacted, as certain countries which had been parties to the treaty were bound to

“grant a priority period of twelve months to applications for patent presented by persons entitled to the benefits of the Convention”,

while in the United States they were allowed only the seven

months period in which to file applications for patents which had been previously applied for in other countries under Section 4887, as amended and effective January 1st, 1898.

The reason for complaint was that it was understood (on account of the opinion of Attorney General Miller, *supra*) that the treaty

"could not be enforced in the United States except so far as it accorded to the law of the country",

and he urged immediate action on the part of Congress to make the additional act of the convention binding on the United States, because the International Bureau was

"constrained to admit that according to judicial precedents, the new Treaty provisions could not be enforced until the corresponding legislation shall have been revised."

On December 29th, the Secretary of State informed the Charge d'Affaires of Switzerland (*infra*, p. 107),

"that the Commissioner of Patents has prepared a bill, to make effective, in this country the Convention and the modifying Act in question."

On January 31st, 1903, Mr. Currier, from the House Committee on patents, presented to the House a report on the bill to

"Effectuate the Provisions of the Additional Act of the International Convention for the Protection of Industrial Property",

and stated that the purpose of a portion of the bill was (*infra*, p. 108),

"to carry into effect the provisions of an additional act concluded at Brussels December 14th, 1900, by the Convention for the International Protection of Industrial Property, which act modified the act of the Convention of March 20th, 1883."

On February 24th, 1903, practically the same bill was reported to the Senate by the Senate Committee on patents (*infra*, p. 112),

The additional Act, which included Article 4 *bis*, was debated in the House and the statements made by Mr. Currier for the committee on patents of the House and by the senators who discussed it, support the contentions that the treaty required an Act of Congress to make it effective in this country, and that the terms fixed by the statute of 1874 and in force until January 1st, 1898, were not in any manner changed by the treaty. Mr. Currier when he moved to pass the bill,

“To Effectuate the Provisions of the Additional Act of the International Convention for the Protection of Industrial Property”,

said:

“at the recent Brussels convention the following countries were represented: . . .”

and that

“Nearly all of the nations which were represented there have already passed the necessary legislation to give force to this act. . . .”

“It seems but fair that this country should take similar action.”

He then explains this Additional Act agreed upon at the Brussels Convention, which he desires to have effectuated by an Act of Congress, as follows:

“The additional act there agreed upon simply extends the period of priority in applications for patents from seven to twelve months. *It does not extend by a single instant the life of any patent now in existence, or any patent that may be granted hereafter.*”

The plain purposes of the Act passed as a result of these representations, as shown by this debate, was to make effective the articles of the international convention and to extend the seven months period allowed inventors for filing application here (when they had previously filed abroad) to twelve months to conform with the agreements of the Treaty of 1902. This Act of Congress is in strict accord with the

minutes of the Brussels conferences; with the reports of Messrs. Forbes and Storer to the Secretary of State in 1897; and in accordance with the application of the Treaty by other countries. The treaty had no retroactive effect and did not extend the life of a United States patent whose term had already been fixed by this statute of 1874 (Sec. 4887), under which it was taken out.

The French Government, in ratifying the Additional Act of Brussels, simply confirms what had been said at the Conventions, discussing Article 4 *bis*, when it says (*infra*, p. 66):

“the provisions made by this article will have the effect of suppressing all connection between different patents, and of leaving to the law of each State the regulation of the term of patents taken out in that country.”

The language of Article 4 *bis* of the treaty itself, and particularly when interpreted by the clearly evidenced agreement of the contracting parties, by the representatives of the United States at the various international conferences, by the Secretary of State, by the House and Senate of the United States which passed the act to effectuate the treaty, demonstrates that this Article 4 *bis* did not extend the terms of existing patents fixed prior to its being agreed upon.

This is the interpretation given it uniformly by the executive, legislative and judicial branches of the United States and vast business interests have been predicated upon it.

The courts have been uniform in holding that Article 4 *bis* of the Treaty of 1902 did not extend the life of the patents applied for under Section 4887 (of 1874), which definitely fixed the term of such patents and limited them to expire with the term of the foreign patent having the shortest term. The term of the Cameron patent in suit thus fixed, expired on November 8th, 1909.

### Summary.

The United States patent to Cameron *et al.* applied for prior to Jan. 1st, 1898, for an invention which had been previously patented abroad by the same patentees, expired with the prior foreign patent. The treaty of 1902 did not operate to extend the term of a United States patent which was definitely and unchangeably fixed long prior to the time when the treaty was promulgated.

The language of the treaty itself; the interpretation given it by the contracting parties, by the representatives of the United States and other countries at the various international conventions, by the Secretary of State, by the House and Senate of the United States; and the act to effectuate the treaty, clearly establish that the fixed terms of existing patents were in no wise extended thereby.

The courts have uniformly held that the terms of such patents, having been fixed at the time of issue, were not extended by the treaty of 1902, and the business community has acted accordingly in its transactions relative to such patents.

The plea was properly sustained and the decree of the court below should be affirmed.

Respectfully submitted,

WALLACE R. LANE,  
*Counsel for Appellee.*

**APPENDIX.****Convention and Final Protocol for the Protection of Industrial Property Between the United States, Belgium, Brazil, the Dominican Republic, France, Great Britain, Guatemala, Italy, the Netherlands, Norway, Portugal, Salvador, Servia, Spain, Sweden, the Swiss Confederation and Tunis.**

[Concluded at Paris, March 20, 1883. Exchange of ratifications by signatory powers, June 6, 1884. Adhesion to the convention advised by the Senate, March 2, 1887. Ratified by the President, March 29, 1887. Accession of the United States to the Union announced by the Minister Resident and Consul-General of the United States at Berne to the Federal Council of Switzerland, May 30, 1887. Proclaimed, June 11, 1887.]

**ARTICLE I.**

The Governments of Belgium, of Brazil, of Spain, of France, of Guatemala, of Italy, of the Netherlands, of Portugal, of Salvador, of Servia, and of Switzerland have constituted themselves into a state of Union for the protection of Industrial Property.

**ARTICLE II.**

The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterward accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

## ARTICLE III.

Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States, not forming part of the Union, who are domiciled or have industrial or commercial establishments upon the territory of one of the States of the Union.

## ARTICLE IV.

Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

In consequence, the deposit subsequently made in one of the other States of the Union, before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit by the publication of the invention or its working by a third party, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above-mentioned shall be six months for patents of invention, and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas.

## ARTICLE V.

The introduction by the patentee into countries where the patent has been granted, of articles manufactured in any other of the States of the Union, shall not entail forfeiture.

The patentee, however, shall be subject to the obligation of working his patent conformably to the laws of the country into which he has introduced the patented articles.

### ARTICLE VI.

Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union.

Shall be considered as country of origin, the country where the depositor has his principal establishment.

If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs.

The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order.

### ARTICLE VII.

The nature of the production upon which the trade or commercial mark is to be affixed cannot in any case be an obstacle to the deposit of the mark.

### ARTICLE VIII.

The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not, of a trade or commercial mark.

### ARTICLE IX.

Every production bearing, unlawfully, a trade or commercial mark, or a commercial name, may be seized upon importation into those of the States of the Union in which such mark or such commercial name has a right to legal protection.

The seizure shall take place either at the instance of the public prosecutor or of the interested party, conformably to the domestic legislation of each State.

### ARTICLE X.

The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality, when this indication shall be

joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every manufacturer or trader engaged in the manufacture or sale of this production, when established in the locality falsely indicated as the place of export?

#### ARTICLE XI.

The High Contracting parties engage between themselves to accord a temporary protection to patentable inventions, to industrial designs or models, as well as to trade or commercial marks for the productions, which may figure at official or officially recognized International Exhibitions.

#### ARTICLE XII.

Each one of the High Contracting parties engages to establish a special service of Industrial Property and a Central Depôt, for giving information to the public, concerning patents of invention, industrial designs or models and trade or commercial marks.

#### ARTICLE XIII.

An International Office shall be organized under the title of "International Bureau of the Union for the Protection of Industrial Property."

This Bureau, the cost of which shall be supported by the Governments of all the contracting States, shall be placed under the high authority of the Superior Administration of the Swiss Confederation, and shall work under its supervision. Its powers shall be determined by common accord between the States of the Union.

#### ARTICLE XIV.

The present convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the Union.

With this object, Conferences shall take place successively in one of the contracting States between the delegates of said States.

The next meeting shall take place in 1885 at Rome.

#### ARTICLE XV.

It is understood that the High Contracting parties respectively reserve the right to make, separately, between themselves, special arrangements for the protection of industrial property, so far as these arrangements shall not interfere with the provisions of the present convention.

#### ARTICLE XVI.

The States that have not taken part in the present convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all the others.

It shall convey, of full right, accession to all the clauses and admission to all the advantages stipulated by the present convention.

#### ARTICLE XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated so far as needful, to the accomplishment of the formalities and rules established by the constitutional laws of such of the High Contracting parties as are bound to ask the application thereof, which they agree to do within the shortest delay possible.

#### ARTICLE XVIII.

The present Convention shall be put into execution within a month after exchange of ratifications, and shall remain in force during a period of time not determined, until the ex-

piration of one year from the day upon which the denunciation shall be made.

This denunciation shall be addressed to the Government empowered to receive adhesions. It shall only produce its effect as regards the State making it, the convention remaining executory for the other contracting parties.

#### ARTICLE XIX.

The present Convention shall be ratified and the ratifications shall be exchanged at Paris, within the period of one year at the latest.

In witness whereof the respective Plenipotentiaries have signed it and affixed to it their seals.

Done at Paris the 20th of March, 1883.

(Seal)	Beyens.
“	Villeneuve.
“	Duc de Fernan-Nuñez.
“	P. Challemel-Lacour.
“	Ch. Hérisson.
“	Ch. Jagerschmidt.
“	Crisanto Medina.
“	Ressman.
“	Baron de Zuylen de Nyeveldt.
“	José da Silva Mendes Leal.
“	F. D'Azevedo.
“	J. M. Torres-Caicedo.
“	Sima M. Marinovitch.
“	Lardy.
“	J. Weibel.

## FINAL PROTOCOL.

On proceeding to the signature of the convention, concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed on the following:

1. The words *Industrial Property* are to be understood in their widest acceptation, in the sense that they apply not only to the productions of industry properly so called, but equally to the productions of agriculture (wines, grains, fruits, cattle, &c.) and to mineral productions used in commerce (mineral waters, &c.).
2. Under the name *Patents of Invention* are included the various classes of industrial patents granted by the laws of the contracting states, such as patents of importation, patents of improvement, &c.
3. It is understood that the final provision of Article 2 of the convention shall in no respect infringe upon the laws of each of the contracting states, so far as concerns the procedure before the courts and the competence of the said courts.
4. Paragraph 1 of Article 6 is to be understood in the sense that no trade or commercial mark shall be excluded from protection, in one of the states of the Union, by the mere fact that it may not satisfy, in respect to the signs composing it, the conditions of the laws of this state, provided that it does satisfy, in this regard, the laws of the country of origin, and that it has been in this latter country, duly deposited. Saving this exception which concerns only the form of the mark, and under reservation of the provisions of the other articles of the convention, the domestic legislation of each of the states shall receive its due application.

In order to avoid all misinterpretation, it is understood

that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of the final paragraph of Article 6.

5. The organization of a special service of Industrial Property mentioned in Article 12 shall include, as far as is possible, the publication in each state of an official periodical.

6. The common expenses of the International Bureau, created by Article 13, shall in no case exceed yearly a sum-total representing a mean of 2,000 francs for each contracting state.<sup>1</sup>

In order to determine the contributory share of each of the states in this sum-total of expenses, the contracting states, and those who may hereafter adhere to the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:

1st class .....	25	units
2nd " .....	20	"
3rd " .....	15	"
4th " .....	10	"
5th " .....	5	"
6th " .....	3	"

These coefficients shall be multiplied by the number of the states of each class, and the sum of the products thus obtained shall furnish the number of units by which the total expense is to be divided. The quotient will give the amount of the unit of expense.

The contracting states are classified as follows in respect to the division of the expenses:

1st class.—France, Italy.

2nd " —Spain.

3rd " —Belgium, Brazil, Portugal, Switzerland.

4th " —Netherlands.

5th " —Servia.

6th " —Guatemala, Salvador.

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<sup>1</sup>Amended. See Article 1 Third Protocol, signed at Madrid, April 15, 1891, p. 156.

The Swiss Government shall supervise the expenditure of the International Bureau, make the necessary advances, and state the annual account, which shall be communicated to all the other Governments.

The International Bureau shall collect information of every kind relating to the protection of Industrial Property, and shall compile from it general statistics, which shall be transmitted to all the Governments. It shall occupy itself with examinations of general utility which may be of interest to the Union, and shall publish, with the assistance of the documents put at its disposal by the various Governments, a periodical in the French language on questions which concern the object of the Union.

The numbers of this periodical and all the documents published by the International Bureau shall be partitioned among the Governments of the states of the Union in the proportion of the number of contributory units above mentioned.

The copies and supplementary documents which may be requested either by the said Governments, or by corporations or private persons, shall be paid for separately.

The International Bureau must always hold itself at the disposal of the members of the Union, in order to furnish them, on questions relating to the international service of Industrial Property, with such special information as they may need.

The Government of the country where the next Conference is to be held shall prepare, with the assistance of the International Bureau, the work of the said Conference.

The director of the International Bureau shall be present at the sessions of the Conferences, and shall take part in the discussions without voting.

He shall make an annual report on its management, which shall be communicated to all the members of the Union.

The official language of the International Bureau shall be the French language.

7. The present final protocol, which shall be ratified at the same time as the Convention concluded this day, shall be considered as forming an integral part of that Convention, and shall have the same force, value, and duration.

In faith whereof the undersigned plenipotentiaries have drawn up the present protocol.

Signed: Beyens.

" Villeneuve.  
" Duc de Fernan-Nuñez.  
" P. Challemel-Lacour.  
" Ch. Hérisson.  
" Ch. Jagerschmidt.  
" Crisanto Medina.  
" Ressman.  
" Baron de Zuylen de Nyevelt.  
" José da Silva Mendes Leal.  
" F. d'Azevedo.  
" J. M. Torres-Caicedo.  
" Sima M. Marinovitch.  
" Lardy.  
" J. Weibel.

**Opinion of the Attorney-General of the United States Upon  
the Construction of the Articles of the International Con-  
vention for the Protection of Industrial Property.**

47 O. G., 398.

**Legislation for The Enforcement of the Treaty Necessary.**

This treaty is a reciprocal one. Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects and citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws.

DEPARTMENT OF JUSTICE,  
WASHINGTON, D. C., April 5, 1889.

Sir: Your predecessor, by his letter of the 15th of January, 1899, requested the opinion of the Attorney-General on the following state of facts:

Section 4902 of the Revised Statutes grants the right to file caveats preliminary to applications for patents for inventions and establishes the legal effect that shall be given to them. It also provides—

Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may . . . file in the Patent Office a caveat.

It further provides—

An alien shall have the privilege herein granted if he has resided in the United States one year next preceding the filing of his caveat and has made oath of his intention to become a citizen.

By the first of these clauses the grant of the right is limited to citizens. By the second it is enlarged to include one

class of aliens. The grant as a whole entitles only citizens and aliens who have been residents 1 year and have legally declared their intention to become citizens to file caveats.

It is claimed by Ferdinand Bourquin, a Swiss citizen, that the second article of a convention entered into between the United States and certain other nations, of which the Swiss Confederation was one, proclaimed on the 7th day of June, 1887 (U. S. Statutes of 1887 and 1888, treaties, 37), extends the grant of section 4902, Revised Statutes, to all subjects and citizens of the parties to the convention. That article provides—

The subjects or citizens of each of the contracting States shall enjoy in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord or shall afterward accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

Congress has passed no law for the execution of this article, nor did the House of Representatives in any way consider or assent to the treaty.

Section 4902 is a part of the system of laws of the United States *concerning* patents for inventions. If, therefore, the article above quoted has become and is self-executing as an *infraterritorial law*, by virtue of the making and proclamation of the treaty by the President, by and with the advice and consent of the Senate, the claim made by Ferdinand Bourquin is valid. By the second clause of the second section of the second article of the Constitution, the power to make treaties, by and with the advice and consent of the Senate, is vested in the President. By the second clause of the sixth article of the Constitution, "all treaties made or

which shall be made under the authority of the United States shall be the supreme law of the land." By the eighth clause of the eighth section of the first article the whole legislative power over the subject of patents is committed to Congress. It is found among the powers to borrow money; to coin money; to declare war; to raise and support armies; to constitute judicial tribunals; to regulate commerce, etc. It is due to the credit of the United States that the provisions concerning the treaty-making power of the President and the legislative power of Congress shall, if possible, be so construed and executed as to give full and proper effect to each and insure harmony in their exercise.

In the case of *Foster v. Neilson* (2 Peters, 314), Chief Justice Marshall, delivering the opinion of the court, in discussing the effect of the Constitution on treaties as laws, declared:

A treaty is, in its nature, a contract between two nations, not a legislative act. It does not generally effect of itself the object to be accomplished, especially so far as its operation is infraterritorial, but is carried into execution by the sovereign power of the respective parties to the instrument.

In the United States a different principle is established. Our Constitution declares a treaty to be the law of the land. It is consequently to be regarded in courts of justice as equivalent to an act of the legislature whenever it operates of itself without the aid of any legislative provision. *But when the terms of the stipulation import a contract, when either of the parties engage to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the court.*

The principle thus stated has been generally accepted as a true interpretation of the constitutional provisions relating to the subject of treaties. It establishes that there is a class of treaties which, without legislation, do not become self-executing as a rule of municipal law. A statement is given of such provisions of treaties as come within this

class; as "when the terms of the stipulation import a contract, when either of the parties engages to perform a particular act." But the decision does not enumerate or define the limitations of the whole class. In the treaty-making power conferred on the President the implication exists that the power is to be exercised by him subject to the limitation of the Constitution. If, in time of peace, he should provide by the stipulations of a treaty for the quartering of soldiers in any house without the consent of the owner, such a stipulation would be simply void, because forbidden by the Constitution to every department of the Government. But where the Government of the United States has power under the Constitution over a subject, although that power may be vested by the Constitution exclusively in Congress, it has been claimed that in the making of treaties such power may be exercised by the President, by and with the advice and consent of the Senate, without the co-operation of the House of Representatives or act of Congress. Issue was joined on this proposition in 1796 between the President and Senate in the affirmative, and the House of Representatives in the negative, concerning certain provisions of the Jay treaty with Great Britain. The treaty, at the end of the disagreement, remained intact, but the House of Representatives

passed resolutions disclaiming the power to interfere in making treaties, but asserting their right, whenever stipulations were made on subjects committed to Congress by the Constitution, to deliberate on the expediency of carrying them into effect; and in legislating on several treaties then before them they struck out the words, "that provision ought to be made by law," and submitted words which declared merely the expediency of passing the necessary laws. (Sargent's Constitutional Law, 411; Story on the Constitution, section 1841.)

In the session of 1815 and 1816 a like disagreement arose concerning a commercial treaty made in the July preceding "between the United States and Great Britain, by which it was agreed to abolish the discriminating duties on British vessels

and cargoes." This disagreement was terminated with no decisive results.

The treaty between the United States and the King of the Hawaiian Islands, signed January 30, 1875, which provided for commercial reciprocity between the nations, and involved the exercise of one of the powers submitted to Congress by the Constitution, provided in its fifth article that it should not be ratified "until a law to carry it into operation should be passed by the Congress of the United States of America" (19 U. S. Stats., 627). In execution of this treaty Congress, on the 15th of August, 1876 (19 U. S. Stats., 200), passed an act in accordance with the provisions of the treaty. The treaty by its terms, however, was clearly a contract by which, in consideration of certain special commercial privileges granted on the one part, certain other like privileges were granted on the other. Such special privileges granted in consideration of others received, the Supreme Court of the United States in the case of *Bartram v. Robertson* (122 U. S., 120) ruled, constitute a contract, Field, J., delivering the opinion (speaking of the treaty with Denmark as compared with that of the Hawaiian Islands) declaring:

Those stipulations, even if conceded to be self-executing, by the way of a proviso or exception to the general law imposing the duties, do not cover concessions like those made to the Hawaiian Islands for a valuable consideration. They were pledges of two contracting parties, the United States and the King of Denmark, to each other; that, in the imposition of duties on goods imported into one of the countries which were the product or manufacture of the other, there should be no discrimination against them in favor of goods of like character imported from any other country. They imposed an obligation on both countries to avoid hostile legislation in that respect. But they were not intended to interfere with *special arrangements with other countries founded upon a concession of special privileges.* (See also *Whitney v. Robertson*, 124 U. S., 192.)

If the treaty-making power, in all treaties whose execution

required the exercises of powers committed to Congress, should uniformly provide in the treaties for their proper submission to Congress before they should be effective, consequences might be avoided which may jeopardize the credit of the nation. Under the British constitution, with reference to this subject the jurisdiction of Parliament is thus stated in 1 Todd's Parliamentary Government in England, page 610:

The constitutional power appertaining to Parliament in respect to treaties is limited. It does not require their formal sanction or ratification by Parliament as a condition to their validity. The proper jurisdiction of Parliament in such matters may be thus defined: First, it is right to give or withhold its sanction to those parts of a treaty that require a legislative enactment to give it force and effect, as, for example, when it provides for an alteration in the criminal or municipal law, or proposes to change existing tariffs or commercial regulations. \* \* \* If a treaty requires legislative action in order to carry it out, it should be subjected to the fullest discussion in Parliament, and especially in the House of Commons, with a view to enable the Government to promote effectually the important interests at stake in their proposed alterations in the foreign policy of the nation.

It is not necessary to the decision of the question submitted to me in the matter under consideration to determine whether all the provisions of treaties, whose execution requires the exercise of powers submitted to Congress, must be so submitted, before they become law, to the courts and Executive Departments, for the treaty under consideration is a reciprocal one. Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects or citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws.

Very respectfully,

W. H. H. MILLER,  
Attorney-General.

The Secretary of the Interior.

## Extract from Convention Proceedings of December, 1897.

The proceedings of the International Conference of Brussels, first and second sessions, 1897 and 1900, being a translation of the original minutes of the Conference held in Brussels between December 3rd and December 14th, 1897.

\***PROVISIONAL PROGRAMME. ADVANCE PROPOSALS WORKED OUT BY THE INTERNATIONAL BUREAU. EXPLANATION OF PURPOSES AND PROPOSITIONS.**

### II. RECIPROCAL INDEPENDENCE OF PATENTS

(New Article.)

The proposed disposition tends to eliminate the effects of a limitation contained in several legislations, and according to which the duration of a patent is limited by that of a patent delivered previously for the same invention in another country. It has been said that this joint liability between patents is justified by the fact that a country, by keeping in force a working privilege, even after its extinction in a foreign country, puts itself in a state of economical inferiority. If this was the case, it would be necessary to radically suppress the patent system, for it never occurs that a discovery is patented everywhere, and, consequently, it remains always free in several countries. Furthermore, the inventor who takes out a patent in one country alone, allows all the other ones the freedom of using his invention without any restriction. The fact is that the protection assured to inventors has the purpose of very much facilitating the practical use and the development of same.

In general, a patented invention is more promptly propa-

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\*(Translated from "Union Internationale pour la Protection de la Propriete Industrielle Conference at Bruxelles 1897-1900," in Crerar Library, Chicago.)

gated, and more completely exploited than a discovery considered as public property. This has so well been understood in the last years that the contrary principle, that of the reciprocal independence of patents, has been admitted without opposition by the Conferences of Rome and of Madrid. It is evident, in fact, that the privilege assured to the inventor by the patent encourages him to a large extent to propagate and to make his invention known, as he has a personal interest in it of the first magnitude. Hence, there is no serious reason for eliminating this interest in a given country, on the ground that it has disappeared in another country, where, for exclusively local reasons, it has not been able to overcome impediments which barred it.

There exists, however, a difference between the proposed disposition and paragraph III of the IV Protocol adopted by the Conference of Madrid. In the latter, the reciprocal independence was only established between the patents applied for, for the same invention, during the priority time limit established by Article 4 of the Convention. The new article, on the contrary, should be applied to all existing patents, whatever the date on which they were delivered. The Conference of Madrid had, in order to introduce this limitation, a reason which no longer exists to-day. Its IV Protocol being destined, not for the purpose of modifying, but for the purpose of expounding and applying the Convention of 1883, the suppression of the joint liability of the patents was presented as a simple application of Article 4. Since the patent applications made during the priority time limit were supposed to have been deposited at the same date, it was not possible, in fact, to consider one of the patents as being prior to the others, and as being capable of limiting the duration of the latter. But it now being a question of modifying the Convention, it is possible to go further and to grant this principle in a definite manner, that patents delivered upon the territory of the Union are absolutely independent from each other as

to their duration. And matters being thus settled, it is evident that patents taken outside of the Union will neither be able to influence those which will have been secured in its limits.

The realization of this reform should naturally be completed by a disposition which may be applied to patents existing, either at the time of the enactment of the modified text or upon the adhesion of a new member to the Union. It would be harsh, in fact, to deprive quite a large number of patent holders of this favor, whose rights are still valid, and who, consequently, may lawfully ask to take advantage of the improvements introduced in the Convention.

Actual Text Proposition  
To intercalate a new article worded as fol-  
lows:

(New Article)

Art. 4 ter.—When a patent application will have been deposited in the first instance in one of the States of the Union, the rights resulting from patents secured subsequently in the Union for the same invention will be independent the one from the others, as well as the rights resulting from patents secured for the same purpose in the States which do not participate in the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies, reciprocally, in the case of adhesion of new States, to patents already existing in on both sides at the time of the adhesion.

First Meeting. Friday, December 3, 1897.

M. DE FAVEREAU, Presiding.

\* \* \* Delegates from the United States of America:  
His Excellency Mr. Bellamy Storer, Envoy Extraordinary  
and Minister Plenipotentiary of the United States of America,  
at Brussels.

**Mr. Francis Forbes, Counsel of the Supreme Court of the**

United States and of the Supreme Court of the State of New York, member of the Constitutional Convention of New York of 1894.

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M. DE Ro, delegate from Belgium, read the report of the Sub-Committee as follows:

GENTLEMEN: Your Committee appointed at the meeting of the First of December has expressed itself unanimously in favor of the adoption of Article 4 *ter* proposed by the International Bureau and it is as follows:

"Art. 4 *ter*.—Patents applied for in the different contracting States by persons admitted to the benefit of the Convention under the terms of articles 2 and 3, shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies, reciprocally, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion."

This resolution, already admitted in principle at the Conference of Madrid, corresponds in effect to the general sentiment.

The Committee, in accord with the International Bureau, proposes, however, the omission from paragraph 3 of the word "reciprocally," which appears useless and unnecessary.

Secretary,  
GEORGES DE Ro.

President,  
C. NICOLAS.

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M. THE PRESIDENT opens the discussion as to the conclusion of the Committee which has examined the proposed Article 4 *ter* presented by the Bureau of Berne.

There being no discussion, this Article is adopted, with the modification in form proposed by the Committee. It is therefore as follows:

**"Art. 4 *ter*.**—Patents applied for in the different contracting States by persons admitted to the benefit of the Convention under the terms of articles 2 and 3, shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion."

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Ninth Meeting, 13th December, 1897.

**THE VERY HONORABLE C.-B. STUART WORTLEY**, Delegate of Great Britain, having asked whether the delegates actually meeting would sign some act, **M. THE PRESIDENT** replies that it would be very desirable to evidence by the signature of a Protocol the accord established on a certain number of points in the course of the present session.

He adds, in response to a question propounded by **MR. FRANCIS FORBES**, Delegate of the United States, that according to his proposal the Conference would really only suspend its work, in order to permit that diplomatic negotiations should ascertain the probability of unanimous accord. This second meeting, truly very short, and in which new questions could not be discussed, would not accordingly constitute a new Conference.

**MR. FRANCIS FORBES** having expressed the desire to see the meeting place of the next Conference fixed in the course of the actual session, it was decided that this question would be examined at the last meeting.

**HIS EXCELLENCY M. CANTAGALLI**, Delegate of Italy, proposes to designate immediately the country which will be charged with the conduct of the diplomatic negotiations to which the questions held in suspense must give place. He was convinced that the Conference would fix its choice on Belgium.

This motion received the unanimous adhesion of the Conference.

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The new article relative to the reciprocal independence of patents is unanimously agreed to. This article which will bear the No. 4 *bis*, is expressed in the following terms:

Art. 4 *bis*: Patents applied for in the different contracting states by persons admitted to the benefits of the Convention under the terms of Articles 2 and 3, shall be independent of patents obtained for the same invention in the other States whether adhering to the Union or not.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion.

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11th Meeting, December 14, 1897.

In regard to Art. 4 *bis* relating to the reciprocal independence of patents, MR. FRANCIS FORBES, Delegate from the United States, makes the following remark:

According to the second paragraph the new order would apply "to patents existing at the time of its going into effect."

Now, in the United States the law cannot have a retroact effect; the stipulation in question would therefore receive objections on the part of the American Government, objections of such a nature as to retard the signing of the additional Act. Desiring to avoid this eventuality, Mr. Forbes inquires if Art. 4 *bis* could not be made the subject of a special Protocol.

MR. THE PRESIDENT consults the conference on this question in order to learn if it was agreeable to the Conference to modify the text submitted for the signature of the delegates, or whether it would be sufficient to mention in the minutes the reservation made by the delegate from the United States.

MR. FRANCIS FORBES would readily accept the arrangement if it be clearly understood that it should not have a retroactive effect in his country. He explains that the law of the United States has been modified in relation to reciprocal independence. Patents delivered prior to January 1, 1898, however, remain dependent so far as their term is concerned, upon the corresponding foreign patent taken out for the same invention; their term has been fixed at the time of their issue. Now, it might happen that article 4 *bis* would be interpreted as meaning that all patents issued before the coming into force of the new law should be in force during the entire term of 17 years, whereas from the moment of their issuance these patents ought to be considered as limited in duration by the patents issued at an anterior date. This interpretation could only be admitted in the United States by means of a special law, which would be contrary to the principle of non-retroactivity with which all American legislation is inspired.

MR. DUBOIS, Delegate from Belgium, is of the opinion that Art. 4 *bis* is designed only to produce effects after the patent has been issued and consequently it is not contrary to the American law. It is really not the purpose to retroactively modify the *normal* term of the patent, which remains such as it was fixed by the law in force at the time of its issuance.

MR. FRANCIS FORBES insists on the necessity of stating this point very precisely in order to avoid errors of interpretation, which would have very regrettable consequences, in case of the acceptance of the additional Act by the United States.

M. MOREL, Director of the International Bureau, calls attention to the object aimed at by the Conference in voting Art. 4 *bis*. He believes that satisfaction might be given to Mr. Forbes by introducing a condition in the second paragraph of this article excepting very explicitly incidents which are anterior to its being put into force. He suggests for this paragraph the following amendment:

“This provision shall apply to patents in existence at

the time of its being put into force; its effects are, however, limited to nullities and lapses which would affect anterior patents."

M. MICHEL PELLETIER, Delegate from France, remarks that the reciprocal principle of independence being admitted, it is not advisable to restrict same by new provisions.

M. DUBOIS gives his opinion as to the situation which will result from the Art. 4 bis. This establishes the principle of independence as to incidents, notably lapses and nullities, which may occur after the issuance of the patents, but the internal law can freely fix the normal duration of the patent taken out in the country.

M. MICHEL PELLETIER also expresses the opinion that the independence has the precise effect of suppressing all relations between the various patents and leaves to each national law the care of regulating all matters pertaining to patents taken out in the country.

His EXCELLENCY MR. BELLAMY STOREY, Delegate from the United States, asks if the following words could not be added:

"However, the term fixed by the internal law of each country remains intact."

This addition would, of course, only apply to such patents as exist at the time of the coming into force of the additional Act. Its bearing in the United States would be: Patents delivered under the rules of the existing law, that is, until December 31, 1897, would be limited by the normal duration of foreign patents of an anterior date, issued to the same inventor for the same invention; their duration would then remain as it was at the moment when the existing law comes to an end.

M. THE PRESIDENT proposes to leave the text of article 4 bis without any change, and to state in the minutes of the meeting that this article should receive the interpretation which has just been indicated. The American Delegation would thus obtain complete satisfaction.

DD

HIS EXCELLENCY MR. BELLAMY STORER, declares this combination acceptable, if it meets with the unanimous adhesion of the Conference.

M. THE COUNT HAMILTON, Delegate from Sweden, pronounces himself in favor of an addition to Article 4 *bis* in the sense as indicated by M. Morel.

THE VERY HONORABLE C.-B. STUART WORTLEY, Delegate from Great Britain, remarks that it is important, in the examination of the question, to take into consideration Article 2 of the General Convention, which guarantees to those under the jurisdiction of the contracting States, the benefit of the advantages granted in each country to natives thereof. The subjects of Great Britain have then for their patents in the United States a right of protection for a period of 17 years according to the American law.

M. DE RO, Delegate from Belgium, supports the proposition of the President, to record in the minutes the harmony existing in the Conference as to the effect of Article 4 *bis*, to which proposition His Excellency Mr. Storer has kindly acceded.

M. THE PRESIDENT puts to a vote the adoption of the text previously adopted for Article 4 *bis*, with the interpretation which the American Delegation desire to specifically point out by proposing to complete the second paragraph by this explanatory clause:

“However, the term fixed by the internal law of each country remains intact.”

Article 4 *bis* is definitely adopted with these conditions.

THE VERY HONORABLE C.-B. STUART WORTLEY remarks that he could take the indicated act of interpretation only as a declaration of the American Delegation, and not as a decision of the Conference.

The assembly adopts the whole of the First final Protocol prepared by the Committee on Reports.

\* \* \* \* \*

M. THE PRESIDENT recalls that the Conference has been quite willing to confide to the Belgian Government the care of conducting the diplomatic negotiations destined to bring about an accord on the questions held in suspense.

He further specifies the principal questions thus reserved for the second session of the Conference.

The assembly expresses the opinion that the negotiations could usefully include the following subjects—unquestionably only concerning the points on which agreement could not up to now be reached:

The respite as to priority (Art. 4 of the General Convention);

The forfeiture of patents because of non-working (Art. 5);

The admission of trademarks to registry (Art. 6);

Unfair competition (Art. 10 bis).

M. NYSSENS says that there remains a duty for him to fulfil in his position as President; it is to thank all the Delegates for their diligence in pursuing the work of the Conference.

He felicitates himself on having the good fortune to be able to say to the representatives of the different States, not good bye, but *au revoir!* He owes this privilege, rarely reserved to presidents of conferences, to the decision, so flattering to his country, that after the exchange of views which is to proceed through diplomatic channels, the Conference will reassemble anew in the Belgian Capital in order to finish its work.

HIS EXCELLENCY M. THE COUNT OF MONTHOLON, Delegate of France, is convinced that he will be a true interpreter for the Delegates and for his colleagues of the diplomatic corps, in thanking quite particularly M. the President for having presided with such courtesy and authority over this meeting which is about, not to terminate but to adjourn, which insures

to all the good fortune of seeing one another again, it is to be hoped, in the near future.

MM. the Delegates having signed the Protocols, M. the President declares the first session of the Conference ended.

**Report of Delegates from United States to Brussels Conference, under the Convention for the Protection of Industrial Property, Concluded at Paris, March 20, 1883. (Senate Doc. 331, Vol. 26; 55th Cong., 2nd Session 1897-8.)**

BRUSSELS, December 15, 1897.

SIR:

We, the delegates from the United States to the Brussels Conference \* \* \* respectfully report

**Article 4 bis.** A new article, entitled article 4 *bis*, provides for the mutual independence of patents applied for in the different States of the Union by persons entitled to the rights granted by the Convention.

We supported this proposed new article as instructed by you.

In order to avoid any confusion in regard to the interpretation hereafter to be given to the second paragraph, which reads: "This provision shall apply to all patents existing at the time of its entering into force," we called attention to it in the regular meeting and found that it was the unanimous sense of the Conference that the paragraph was not applicable to existing United States patents, but only to those patents whose terms might be shortened by the laws of those States of the Union in which provision is made for a shortening of the term on the lapsing of patents for the same invention in other States.

An existing United States patent cannot be affected by what may take place in regard to a patent for the same invention

abroad. The limitation of the terms of the United States patents imposed by section 4887 was a determination at the moment of the grant of the patent of its term, and therefore the duration of the patent is unaffected by the subsequent expiration of a foreign patent for the same invention by reason of non-payment of taxes or nonworking.

While there exist no patents in the United States which can be affected by article 4, bis, it may still affect advantageously the foreign patents of American citizens, and is, therefore, a provision in the interests of our people. \* \* \*

Recommendation.—These amendments can in no instance, in our opinion, prejudice the citizens of the United States, \* \* \* and should be adopted.

We are, dear sir, very respectfully,

Bellamy Storer.

Francis Forbes.

Hon. John Sherman,  
*Secretary of State.*

#### APPENDIX A.

##### FIRST FINAL PROTOCOL.

The International Conference of the Union for the Protection of Industrial Property convened at Brussels, December 1, 1897, submits to the Governments of the States of the Union the following project:

*Additional act to the Convention of March 20, 1883, concluded between (enumeration of the contracting States).*

The undersigned duly authorized by their respective Governments have by common consent and under reserve of ratification agreed as follows:

Article 3 of the Convention shall be as follows:

Art. 3. Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States not forming part of the Union, who are domiciled or have

effective and serious<sup>1</sup> industrial or commercial establishments upon the territory of one of the States of the Union.

Article 4 shall be as follows:

Art. 4. Anyone who shall have regularly deposited an application for a patent of invention of an industrial model or design of a trade or commercial mark in one of the contracting States shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods can not be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working,<sup>2</sup> by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas.

There is inserted in the Convention an article 4 *bis*, as follows:

Art. 4 *bis*. Patents applied for in the different contracting States by persons admitted to the benefit of the Convention under the terms of articles 2 and 3, shall be independent of the patents obtained for the same invention in the other States adhering or not to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies in the case of adhesion of new States as to patents already existing either in the Union or in the new adhering State at the time of the adhesion.

There is added to article 9 two paragraphs, as follows:

In the States whose legislation does not admit of seiz-

<sup>1</sup> "Effective and serious" inserted by amendment.

<sup>2</sup> *By a third party (par un tiers)* omitted.

ure on importation, such seizure may be replaced by the prohibition of importation.

The authorities shall not be required to effect seizure in case of goods in transit.

Article 10 shall be as follows:

Art. 10. The provisions of the preceding article shall be applicable to every product bearing falsely as indication of origin the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every producer,<sup>1</sup> manufacturer, or trader engaged in the production, the manufacture, or sale of this product when established either in the locality falsely indicated as place of export, or in the region where said locality is situated.

Article 11 shall be as follows:

Art. 11. The high contracting parties shall accord conformably to the legislation of each country<sup>2</sup> a temporary protection to patentable inventions, to industrial designs or models, as well as to trade-marks, for the productions which may figure at official or officially recognized international expositions organized upon the territory of one of them.

Article 14 shall be as follows:

Art. 14. The present convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the Union.

With this object conferences shall take place successively in one of the contracting States between the delegates of said States.

Article 16 shall be as follows:

Art. 16. The States that have not taken part in the present Convention shall be admitted to adhere to the same upon their application.

<sup>1</sup>Producer (production), the production (la production); either \* \* \* or in the region where said locality is situated, inserted by amendment.

<sup>2</sup>"Shall grant conformably to the legislation of each country" (accorderont conformément à la législation de chaque pays), substituted in place of "Agree to grant" (s'engage à accorder), and "organized upon the territory of one three" is added.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all the others.

It shall convey of full right, accession to all the clauses, and admission to all the advantages stipulated by the present Convention, and shall go into force a month after the sending of the notification given by the Swiss Government to the other Unionist States, unless a later date shall have been indicated by the adhering State.<sup>1</sup>

The present additional act shall have the same force and duration as the Convention of March 20, 1883.

It shall be ratified and the ratification thereof shall be exchanged at Brussels in the form adopted for this Convention as soon as may be, and, at the latest, within a period of one year.

It shall go into effect three months after such exchange.

In witness whereof the undersigned have signed the present additional act.

Done at Brussels, the of

The respective Governments are invited to sign the above project within six months; the signature and the exchange of ratifications shall take place in the manner designated in said additional act.

Done in one single copy at Brussels, December 14, 1897.

For Belgium:

A. Nyssens.  
L. Capelle.  
Georges De Ro.  
S. Dubois.

For Brazil:

F. Vierira Monteiro.

For Denmark:

H. Holten Nielsen.

For Spain:

El Marqs. Be Bertemati.  
Eduardo Toda.

For the United States of America:

Bellamy Storer.  
Francis Forbes.

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<sup>1</sup> Last paragraph. And go into effect, etc., added.

**For France:**

Montholon.  
C. Nicolas.  
Michel Pelletier.

**For Great Britain:**

Charles B. Stuart Wortley.  
H. G. Bergne.  
C. N. Dalton.

**For Italy:**

R. Cantagalli.  
C. F. Gabba.  
S. Ottolenghi.

**For Norway:**

Chr. Hansson.

**For the Netherlands:**

Snyder Van Wyssenkerke.

**For Portugal:**

F. Quintella De Sampayo.  
Jayme De Sequier.

**For Servia:**

Spassoie Radoitchitch.

**For Sweden:**

Hugo E. G. Hamilton.

**For Switzerland:**

Alphonse Rivier.  
L. R. De Salis.

**For Tunis:**

Montholon.  
Etienne Blade.

**Report of the British Delegates to the Brussels Conference of 1897.**

*The British delegates to the Brussels conference of the Union for the Protection of Industrial Property to the Right Honorable C. T. Ritchie, M. P.*

BRUSSELS, December 15, 1897.

SIR:—

We have the honor to report that, in accordance with our instructions, we have attended, etc. \* \* \*

The Conference ended in the signature by all the delegates of the enclosed Final Protocol, containing proposed amendments to the Convention of 1883, which the Delegates submit for the consideration of their respective Governments.

The following observations may be made respecting the various Articles contained therein:

\* \* \* \* \*

**PROPOSED ADDITIONAL ARTICLE IV bis.**

This is a new Article. Its effect will be that patents for the same invention taken out in different States of the Union will be independent of one another, and of similar patents granted outside the Union. At present all patents taken out in England are independent of patents for the same invention taken out in foreign countries, and the new Article therefore involves no alteration in the English law. But hitherto every patent which has been granted in the United States for an invention previously patented in any foreign country has been limited so as to expire at the same time with the foreign patent. As the ordinary life of a patent is 17 years in the United States and 14 years only in the United Kingdom, when a patent has been granted in the United States for an invention previously patented in the United Kingdom, its life has been limited to 14 years from the date of application for the pat-

ent in Great Britain. This will no longer be the case, as the American law will be assimilated to the English law in this respect as from the first of January next.

The ordinary life of a British patent is shorter than that of a patent in any other State in the Union, and consequently, the alteration is in favor of the British patentees.

The last two paragraphs of article 4 bis apply the Article to patents now in existence and to patents in existence in any state at the time of its accession to the Union, but the Delegate of the United States made a declaration at the final stage of the proceedings that his country could not bring the legislation which would be necessary to carry the second paragraph of this new article into effect, so far as the United States were concerned.

\* \* \* \* \*

We have, etc.,

CHARLES B. STUART WORTLEY,  
H. G. BERGNE,  
C. N. DALTON.

**Act Providing for the Appointment and Duties of the Commissioners of June 4, 1898. (P. 431 U. S. Stat. L. 55th Cong. 1897-99, Vol. 30.)**

An Act appointing Commissioner to revise the statutes relating to patent, trade and other marks, and trade and commercial names.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the President, with the advice and consent of the Senate, shall appoint three commissioners, to serve without compensation, whose duty it shall be to revise and amend the laws of the United States concerning patents, trade and other marks, and trade or commercial names, which shall be in

force at the time such commission shall make its final report, so far as the same relates to matters contained in or affected by the Convention for the Protection of Industrial Property concluded at Paris March twentieth, eighteen hundred and eighty three, the agreements under said convention concluded at Madrid April fourteenth, eighteen hundred and ninety-one, and the protocols adopted by the conference held under such convention at Brussels, eighteen hundred and ninety-seven, and the treaties of the United States, and the laws of other nations relating to patents, trade and other marks and trade or commercial names.

That they shall report to congress as soon as possible.

That the report shall be so made as to indicate any proposed change in the substance of existing law, and shall be accompanied by notes which shall briefly and clearly state the reason for any proposed change. It shall also be accompanied by references to such treaties and foreign laws relating to patents, trade and other marks, and trade or commercial names, as, in the opinion of the Commissioners may affect citizens of the United States.

That the sum of two hundred and fifty dollars, or so much thereof as may be necessary, be appropriated to pay the necessary expenses of the Commissioners in making their report, which sum shall be immediately available.

Approved, June 4, 1898.

**Report of the Commissioners Appointed to Revise the Laws  
Relating to Patents, Trade Marks and Trade Names with  
Reference to Existing Conventions and Treaties, Under  
Act of Congress Approved June 4, 1898. (Senate Doc.  
No. 3 and No. 20 Revision of Statutes Relating to Patents,  
Etc., 56th Cong. 2nd Session, 1900-01.)**

To the Congress of the United States of America:

We, the commissioners appointed by the President under the Act entitled "An act appointing Commissioners to revise the statutes relating to patent, trade and other marks, and trade commercial names," approved June 4th, 1898, have the honor to submit herewith the report called for by said act.

Respectfully,  
FRANCIS FORBES,  
PETER STENGER GROSSCUP,  
ARTHUR P. GREELEY.

November 27, 1900.

## REPORT.

To the Congress of the United States of America:

We, the Commissioners appointed \* \* \* have the honor to submit the following report and accompanying bills \* \* \*

The changes which we recommend should be made in the patent laws are embodied in three proposed bills which accompany this report. None of the proposed changes affect the general provisions of the patent law.

## THE REVISION OF THE PATENT LAW.

## TREATY OBLIGATIONS REGARDING THE PROTECTION OF INVENTIONS.

## INTERNATIONAL CONVENTION OF PARIS 1883.

## CONFERENCE HELD UNDER THE CONVENTION.

## ADVANTAGES SECURED THROUGH THE CONVENTION.

## EQUAL RIGHTS TO FOREIGN AND DOMESTIC INVENTORS.

## PRIORITY UNDER THE CONVENTION.

## IMPORTATION OF PATENTED ARTICLES.

## INDEPENDENCE OF PATENTS.

Of special importance is the provision contained in the amendment to Article 4 adopted at the recent conference at Brussels, not yet ratified. It provides that patents granted in the different countries for the same invention shall be independent; that is, shall not be limited in terms by the term of any patent previously taken out in another country, and shall not be made void by the forfeiture of a patent in another country. Prior to the Act of March 3, 1897, a patent granted in the United States on an invention previously patented abroad was required to be limited to expire with the foreign patent<sup>1</sup>. The same provision is found in the laws of many foreign countries, and in certain countries the patent granted on an invention which has been previously patented in other countries becomes forfeited if in any of the other countries the patent ceases to be in force. Under the present law of the United States<sup>2</sup> patents are granted for the full term of seventeen years, whether the invention patented has been previously patented abroad or not. This amendment to the Convention is directly in line with the change in our law.

Without this provision of the Convention it might become necessary for an inventor, who out of abundant caution had

<sup>1</sup> Sec. 487, Rev. Stat.

<sup>2</sup> Act of March 3, 1897.

taken out a patent on his invention in each of a half dozen or more countries, in one or two of which the invention might prove of great value, while in others it might for various reasons prove of little value, to pay the heavy annual taxes in every one of these countries and satisfy the requirements as to working in order to prevent the forfeiture of his patents in the countries in which his invention was of value. The dependence of a patent in one country, assigned, it may be, to a citizen of that country, upon the continued existence of a patent for the same invention in another country and under the control of some other person, obviously could not but render property in a patent right most uncertain. To have done away with this serious difficulty is a long step forward.

#### RECAPITULATION OF ADVANTAGES SECURED BY THE CONVENTION.

The advantage to our citizens in the matter of patents directly afforded by the convention may be thus recapitulated:

First. The enjoyment in foreign countries of equal rights with subjects or citizens of those countries.

Second. The "delay of priority" of seven months within which to file applications abroad after filing in this country.

Third. The privilege of introducing articles embodying the invention manufactured in this country into foreign countries to a certain extent without thereby causing the forfeiture of the patents taken out there.

To these advantages will be added, when the amendment above referred to as adopted at Brussels is ratified, the very important advantage that patents taken out in different countries will be independent of each other.

\* \* \* \* \*

### EXAMINATION OF CONVENTION IN DETAIL.

The Attorney-General of the United States in 1889 expressed the opinion (47 Official Gazette 398, Opinions of Attorney-General, Vol. 19, 273) that the International Convention, in so far as the agreements therein contained are not in accordance with the present laws of the United States, is without force and effect; that it is not self-executing, but requires legislation to render it effective for the modification of existing laws; and while this opinion has no other effect than the creation of a rule of departmental practice, and is not binding upon courts, it is our opinion that such legislation should be adopted as shall definitely and positively provide for carrying into effect the requirements of the convention.

Examining the convention in detail, in connection with the statutes of the United States relating to patents, for the purpose of determining what legislation is necessary to carry its requirements into effect in good faith, we find:

Section 4887 of the Revised Statutes, as amended by the Act of March 3, 1897, is not in harmony with Article IV of the Convention.

### CHANGES REQUIRED IN THE LAWS OF THE UNITED STATES TO GIVE FULL EFFECT TO THE CONVENTION.

### SUMMARY OF RECOMMENDATIONS.

We have embodied these recommendations, together with those which we have before referred to, as required by our treaty obligations, in three proposed bills which are submitted herewith.

Sec. 3. Section forty-eight hundred eighty-seven of the Revised Statutes, as amended by Act of Congress as approved March 3, 1897, is amended by \* \* \*

So that the section so amended shall read as follows:

Sec. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless said foreign patent was granted more than two years prior to the filing of the application in this country, in which case no patent shall be granted in this country.

\* \* \* \* \*

Respectfully submitted,

FRANCIS FORBES,

PETER STENGER GROSSCUP.

I concur fully in the above report and recommendations, so far as they relate to changes in the patent law, and in the proposed bills in which such recommendations are embodied.

\* \* \*

Respectfully submitted,

ARTHUR P. GREELEY.

## Conference of Brussels. Second Session.

11-14 December, 1900.

## Minutes of the Sittings of the Second Session.

First Sitting Tuesday, 11 December, 1900.

The International Conference of the Union for the protection of industrial property, which had suspended its work in 1897, convened anew Tuesday 11 December, 1900, at 10.30, in the Salle de Mabre of the Palace des Académies.

There were present

**For the United States of America**

His Excellency Mr. Lawrence Townsend, Envoy Extraordinary and Minister Plenipotentiary of the United States of America to Brussels:

Mr. Francis Forbes:

Mr. Walter H. Chamberlin, Assistant Commissioner of Patents.

M. THE PRESIDENT then speaks as follows:

GENTLEMEN:

The Conference continues. It is by these words, which in the utterance have nothing tragic about them, that I have the honor, as first Delegate of Belgium, to declare the second session of the Conference of Brussels open.

After the profound discussions which took place during our first session and in which the arguments of national and international order were set out, discussed and weighed with as much knowledge as practical competence, after the negotiations and exchange of views to which the unsettled questions have yielded, it seems, gentlemen, that there is no longer any place for new discussions, which could not bring us to

our object, and that we have no more to do except to listen and to register the declarations which the members of the Conference would wish us to do in the name of their respective States. The conclusions will follow. They will be, we strongly hope, conformed to the general expectation and will permit an important act to date from this city which will bring peoples more closely together in mingling their interests in the pacific sphere of work and progress.

\* \* \* \* \*

Second Sitting, 12th December, 1900.

M. LE COMMANDEUR GABBA, Delegate from Italy, recalls that he would like to see it established that the respite of priority of twelve months is applicable to those patents issued before the going into effect of the new act for which the respite of priority of six months actually existing would not yet have expired at the time of this going into effect.

M. MOREL, Director of the International Bureau, declares himself absolutely in sympathy with this idea, which could be interpreted by an arrangement inspired by article 4 *bis* of the Convention.

The honorable representative of the International Bureau recalls that the Delegate from Portugal has raised an analogous question in regard to No. 3 *bis* of the Protocol de Cloture. There also, says M. Morel, the introduction of a retroactive arrangement could have its usefulness.

There would then be in the Convention three arrangements concerning retroactivity: one in article 4, another in article 4 *bis*, the third No. 3 *bis* of the Protocol de cloture.

\* \* \* \* \*

The Conference then considered the form of the diplomatic instruments which would perpetuate the results of its work.

On the proposal of M. THE PRESIDENT, supported by HIS EXCELLENCY M. GERARD, Delegate of France, the Conference

decided to group into one single act the resolutions adopted respectively in the sessions of 1897 and of 1900, concerning modifications of the Convention of 1883.

\* \* \* \* \*

### Report of United States Delegates.

"BRUSSELS, December 15, 1900.

HONORABLE JOHN HAY,  
Secretary of State,  
Washington, D. C.

SIR:

In conformity with your instructions, we attended the Second Session of the Conference held in this city under the Convention for the Protection of Industrial Property concluded at Paris, March 20, 1883.

All the members of the Union created by the Convention were represented by delegates, except Servia. The same countries, non-members of the Union, which sent delegates the first session also sent delegates to this, except Mexico. The Japanese delegation attended as members of the Union instead of non-members as before.

The International Bureau was represented by Mr. Morel, its Director.

The officers of the first session were re-elected, except the Vice-Presidents who were at the first session, the French and Spanish Ministers accredited to Belgium. The present Ministers from these countries were elected vice-presidents of this session.

The delegates to the Conference were either experts on the subjects included in the treaty, or in the case of the Ministers plenipotentiaries resident in Brussels, they were associated with such experts, and in some cases the delegation was large, *e.g.* that of Great Britain, which was composed of three delegates, a technical adviser and a secretary.

The announcement was made at the opening of the session that the propositions to be considered were those contained in the circular letter of the Belgian Government, a copy of which was transmitted to us with our instructions. This statement met with the almost unani-

mous support of the delegates, and it at once became apparent that no other subjects would receive sufficient support to entitle them to a place in the Act, which it was supposed should be signed subject to ratification. All other matters were left to the next conference.

As instructed by you, we presented to the Conference the question of marks used but not registered, but for the reasons stated did not demand a vote upon it, being desirous of not imperiling the other propositions which we were instructed to support.

Propositions from other countries, not contained in the letter of the Belgian Government, were also reserved for the next Conference.

The Conference voted unanimously in favor of three of the propositions contained in said letter of the Belgian Government. The result is as follows:

1. It fixes the period of priority (Art. 4) at twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks, instead of the present periods.

2. The period in which a patentee is obliged to work his patented invention is fixed at three years from the date of his application in the country where patented, unless he can excuse a further delay.

3. As to unfair competition in trade, those entitled of right, under the Convention (Art. 2 & 3) shall enjoy in all the States of the Union the protection accorded to citizens or subjects.

The Conference as a consummation of its labor, adopted an Additional Act to the Convention, in which the Amendments of both the first and second sessions were arranged in proper order. The text of this Act is annexed hereto, together with a translation.

The Amendments to the agreement of Madrid of April 14, 1891, concerning the international registration of trade marks to which the United States is not a party, which were adopted at the Session of the Conference in 1897, were included in an Additional Act to the Agreement, a copy of which is hereto annexed, together with a translation.

The delegates from Germany, Austria and Hungary announced the intention of their respective governments to become members of the Union for the protection of Industrial Property.

The Acts were then signed by the delegates and the Conference adjourned to meet in Washington on a date to be arranged by the Government of the United States of America.

We are, sir,

Very respectfully,

LAWRENCE TOWNSEND,  
FRANCIS FORBES,  
WALTER H. CHAMBERLIN."

---

An Additional Act, concluded at Brussels December 14, 1900, by the plenipotentiaries of the United States and other countries, for the protection of Industrial Property Convention of March 20, 1883.

#### ARTICLE I.

The International Convention of March 20, 1883, is modified as follows:

I. Article 3 of the Convention shall read as follows:

Art. 3. Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States not forming part of the union, who are domiciled or have *bona fide* industrial or commercial establishments upon the territory of one of the States of the Union.

II. Article 4 shall read as follows:

Art. 4. Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter mentioned.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks.

III. There is inserted in the Convention an article 4 bis, as follows:

Art. 4 bis. Patents applied for in the different contracting States by persons admitted to the benefit of the Convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies in the case of adhesion of new States to patents already existing on both sides at the time of the adhesion.

IV. There are added to Article 9 two paragraphs, as follows:

In the States whose legislation does not admit of seizure on importation, such seizure may be replaced by prohibition of importation.

The authorities shall not be required to make the seizure in case of transit.

V. Article 10 shall read as follows:

Art. 10. The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every producer, manufacturer, or trader engaged in the production, the manufacture, or the sale of this production when established either in the locality falsely indicated as place of origin, or in the region where that locality is situated.

VI. There is inserted in the Convention an article 10 bis, as follows:

Art. 10 bis. Those entitled of right under the Convention (Arts. 2 and 3) shall enjoy, in all the States of the Union, the protection accorded to citizens or subjects against unfair competition.

VII. Article 11 shall read as follows:

Art. 11. The high contracting parties shall accord con-

formably to the legislation of each country a temporary protection to patentable inventions, to industrial designs, or models, as well as to trade-marks for the productions which shall be shown at official or officially recognized international expositions organized upon the territory of one of them.

VIII. Article 14 shall read as follows:

Art. 14. The present Convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the Union.

With this object conferences shall take place successively in one of the contracting States between the delegates of said States.

IX. Article 16 shall read as follows:

Art. 16. The States that have not taken part in the present Convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all others.

It shall convey of full right, accession to all the clauses and admission to all the advantages stipulated by the present Convention, and shall go into force a month after the sending of the notification given by the Swiss Government to the Unionist States, unless a later date shall have been indicated by the adhering State.

## ARTICLE 2.

The Final Protocol annexed to the International Convention of March 20, 1883, is completed by the addition of a number 3 bis, as follows:

Art. 3 bis. The patentee, in each country, shall not suffer forfeiture because of non-working until after a minimum period of three years, to date from the deposit of the application in the country concerned, and in the case where the patentee shall not justify the reasons of his inaction.

### ARTICLE 3.

The present Additional Act shall have the same force and duration as the Convention of March 20, 1883.

It shall be ratified and the ratification shall be deposited at the Ministry of Foreign Affairs at Brussels as soon as may be and at the latest within the period of eighteen months dated from the day of signature.

It shall go into effect three months after the close of the record of deposit.

In witness whereof the respective plenipotentiaries have signed the present additional act.

Done at Brussels, in a single copy, December 14, 1900.

For the United States of America:

Signed **LAWRENCE TOWNSEND.**  
**FRANCIS FORBES.**  
**WALTER H. CHAMBERLIN**

**Ratification and Proclamation, 1902.**

*International Protection of Industrial Property.*

An additional act, concluded at Brussels December 14, 1900, by the plenipotentiaries of the United States and other countries, for the protection of Industrial Property Convention of March 20, 1883.

Signed at Brussels December 14, 1900; ratification advised by the Senate March 7, 1901; ratified by the President April 16, 1901; ratification deposited at Brussels May 3, 1901; proclaimed August 25, 1902.

BY THE PRESIDENT OF THE UNITED STATES OF AMERICA.

**A PROCLAMATION.**

Whereas an additional act modifying the Industrial Property Convention of March 20, 1883, was signed at Brussels on December 14, 1900, by the plenipotentiaries of the United States and other powers, a true copy of which additional act in the French language is word for word as follows:

(Translation.)

**INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.**

*Additional Act of December 14, 1900, Modifying the Convention of March 20, 1883, as well as the Final Protocol Thereto Annexed.*

\* \* \* \* \*

The President of the United States of America: Mr. Lawrence Townsend, Envoy Extraordinary and Minister Plenipotentiary of the United States of America near his Majesty the King of the Belgians; Mr. Francis Forbes; Mr. Walter H. Chamberlin, Assistant Commissioner of Patents.

Who, after having communicated to each other their full powers, found to be in good and due form, have agreed upon the following articles:

#### ARTICLE 1.

The International Convention of March 20, 1883, is modified as follows:

I. Article 3 of the Convention shall read as follows:

Art. 3. Are assimilated to the subjects or citizens of the contracting States, the subjects of citizens of States not forming part of the Union, who are domiciled or have *bona fide* industrial or commercial establishments upon the territory of one of the States of the Union.

II. Article 4 shall read as follows:

Art. 4. Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter mentioned.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks.

III. There is inserted in the Convention an article 4 *bis*, as follows:

Art. 4 *bis*. Patents applied for in the different contracting States by persons admitted to the benefit of the Convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

This provision shall apply to patents existing at the time of its going into effect.

The same rule applies in the case of adhesion of new States to patents already existing on both sides at the time of the adhesion.

IV. There are added to Article 9 two paragraphs, as follows:

In the States whose legislation does not admit of seizure on importation, such seizure may be replaced by prohibition of importation.

The authorities shall not be required to make the seizure in case of transit.

V. Article 10 shall read as follows:

Art. 10. The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every producer, manufacturer, or trader engaged in the production, the manufacture, or the sale of this production when established either in the locality falsely indicated as place of origin, or in the region where that locality is situated.

VI. There is inserted in the Convention an article 10 bis, as follows:

Art. 10 bis. Those entitled of right under the Convention (Arts. 2 and 3) shall enjoy, in all the States of the Union, the protection accorded to citizens or subjects against unfair competition.

VII. Article 11 shall read as follows:

Art 11. The high contracting parties shall accord conformably to the legislation of each country a temporary protection to patentable inventions, to industrial designs, or models, as well as to trade-marks for the productions which shall be shown at official or officially recognized international expositions organized upon the territory of one of them.

VIII. Article 14 shall read as follows:

Art. 14. The present Convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the Union.

With this object conferences shall take place successively in one of the contracting States between the delegates of said States.

IX. Article 16 shall read as follows:

Art. 16. The States that have not taken part in the present Convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all others.

It shall convey of full right, accession to all the clauses and admission to all the advantages stipulated by the present Convention, and shall go into force a month after the sending of the notification given by the Swiss Government to the Unionist States, unless a later date shall have been indicated by the adhering State.

#### ARTICLE 2.

The Final Protocol annexed to the International Convention of March 20, 1883, is completed by the addition of a number 3 bis, as follows:

Art 3 bis. The patentee, in each country, shall not suffer forfeiture because of non-working until after a minimum period of three years, to date from the deposit of the application in the country concerned, and in the case where the patentee shall not justify the reasons of his inaction.

#### ARTICLE 3.

The present Additional Act shall have the same force and duration as the Convention of March 20, 1883.

It shall be ratified and the ratifications shall be deposited at the Ministry of Foreign Affairs at Brussels as soon as may be and at the latest within the period of eighteen months dated from the day of signature.

It shall go into effect three months after the close of the record of deposit.

In witness whereof, the respective plenipotentiaries have signed the present additional act.

Done at Brussels, in a single copy, December 14, 1900.  
For the United States of America:

(Signed) LAWRENCE TOWNSEND,  
FRANCIS FORBES,  
WALTER H. CHAMBERLIN.

And, whereas, the said additional act was ratified by the Government of the United States, by and with the advice and consent of the Senate thereof, and by the other signatory governments with the exception of those of Brazil, the Dominican Republic, Spain and Servia, and the ratifications have been deposited with the Ministry of Foreign Affairs at Brussels, as required by Article 3 of the act:

And whereas it is agreed between the ratifying governments that the said additional act shall go into effect between them on September 14, 1902, notwithstanding the non-ratification thereof by the four signatory governments above mentioned, which have reserved the right to ratify the same at a later date;

Now therefore, be it known that I, Theodore Roosevelt, President of the United States of America, have caused the said additional act to be made public, to the end that the same and every article and clause thereof may be observed and fulfilled with good faith by the United States and the citizens thereof.

In testimony whereof I have hereunto set my hand and caused the seal of the United States to be affixed.

Done at the City of Washington, this twenty-fifth day of August in the year of our Lord one thousand nine hundred and two, and of the Independence of the United States the one hundred and twenty-seventh.

THEODORE ROOSEVELT,

By the President:

ALVEY A. ADEE,

Acting Secretary of State.

**Special Laws of Foreign Nations Passed After December, 1900, in Order to Carry Out the Additional Act of the Brussels Conference of December, 1900.**

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(*La Propriete Industrielle, 1902.*)

**ITALY. Law of the 12th of December, 1901, Article 1.**

The Supplementary Act signed at Brussels on the 14th of December, 1900, by Italy and various other States modifying the Convention for the protection of industrial property, signed at Paris on the 20th of March, 1883, and the annexed protocol agreed to on its signature, are approved.

The Government of the King is authorized to ratify the same in the manner and within the terms prescribed by Article 3 of the said Act.

(This was followed by a full copy of the Additional Act.)

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**FRANCE. Law of the 15th of April, 1902.**

Law approving the Additional Act, signed at Brussels on the 14th of December, 1900, modifying the Convention of the 20th of March, 1883, relative to the international protection of industrial property, and also the protocol annexed to the Convention.

The President of the Republic is authorized to ratify and, if necessary, to issue a decree giving force to the Additional Act signed at Brussels on the 14th of December, 1900, modifying the Convention of the 20th of March, 1883, relative to the international protection of industrial property and also the protocol annexed to the Convention.

An authentic copy of the additional Act of the 14th of December, 1900, shall be annexed to this law.

**SWEDEN.** Law of the 9th of May, 1902, amending certain sections of the Patent Ordinance of the 16th of May, 1884.

With regard to inventions protected in a State which grants reciprocity to inventions patented in the kingdom the King may decree:

That if any person applies for a patent in the kingdom for an invention before the expiration of a given time, which may be fixed by decree, but not to exceed twelve months from the date of the application for protection of the same invention in the foreign State or three months from the publication by the competent authorities of the granting of such protection, then the application made in the kingdom shall be considered with reference to other applications and to the restrictions mentioned in Section 3 as if made simultaneously with the application in the foreign State.

The regulations contained in this law shall take effect from the first day of September 1902, and applications for patents filed prior to that date shall be proceeded with in accordance with the provisions hitherto observed, with the following exception:

If the holders of patents for which applications have been filed before the 1st of September, 1902, communicate to the patent authorities in writing that they submit to the altered regulations of this law, these regulations shall from the date of filing of the said communication apply to such prior patents; nevertheless it shall always be competent to prove that the patent had been forfeited before the date of the said communication, in accordance with the provisions hitherto in force. The provision in the new wording of Section 21 respecting the transmission of decisions in cases in which the validity of a patent has been contested shall also be observed in cases in which the patents have been applied for before the 1st of September, 1902.

All persons concerned shall observe and perform the foregoing.

For greater surety we have, with our own hand signed, and, with our own seal, sealed these presents.

The Palace at Stockholm, May 9, 1902.

In the absence of his Majesty, my most gracious King and Monarch.

GUSTAV.

## SPAIN. Law of the 16th of May, 1902.

Art. 16. Neither is the novelty referred to in Art. 14 of this law vitiated by a prior application for a patent for the same object in countries comprised in the International Union of the 20th of March, 1883, nor by publication in any other form which has taken the place of the object in question in these countries; provided that the term set out in Art. 4 of the Convention referred to, modified by the agreement of the Conference of Brussels of the 14th of December, 1900, or those which may be established in the future by international conventions is observed.

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## NORWAY. Law amending the Laws on Patents of the 16th of June, 1885.

We, Oscar, by the grace of God, King of Norway and Sweden, of Gotha and Vend,

Hereby make known that there has been submitted to us a resolution of the Storthing, now assembled, dated the 15th of March in the present year, as follows:

Sec. 33 of the law on patents of the 16th of June, 1885, shall hereafter read as follows:

“Should any person who has applied for a patent for an invention in a foreign country, within a period not exceeding twelve months thereafter make an application for a patent for the same invention in this country, this application shall be treated in relation to other applications as if it had been made at the same time as the application in the foreign State, provided that the State in question makes reciprocal concessions.”

We have therefore approved and affirmed, and do hereby approve and affirm, this resolution as law under our hand and seal.

Given at the Palace of Stockholm the 29th of March 1902.

OSCAR.

**DENMARK.** Ordinance No. 146 of the 12th of September, 1902, modifying Ordinance No. 181 of the 28th of September, 1894, relating to the protection of foreign Trade Marks and Patents (so far as it relates to Patents).

We, CHRISTIAN IX, by the Grace of God, King of Denmark, of the Vends and Goths, Duke of Schleswig-Holstein, Stormarn, Ditmarschen, Lauenburg and Oldenburg, Make known that the Convention concluded at Paris on the 20th of March, 1883, between certain States with the purpose of creating an International Union for the Protection of Industrial Property having been modified as regards all the States belonging to the Union, except the United States of Brazil, the Dominican Republic, Servia, and Spain, by the Additional Act signed at Brussels on the 14th of December, 1900, and published by our Minister of Foreign Affairs on the 26th of last month, We decree, in pursuance of Law \* \* \* No. 40 of the 29th of March, 1901, modifying the law on Patents of the 13th of April, 1894, the following modifications in our Ordinance No. 181 of the 28th of September, 1894, relating to the protection of foreign Trade Marks and Patents, modified by our Ordinance No. 101 of the 8th of July, 1899 \* \* \* as applicable with regard to the States of the Union which have adhered to the additional Act above mentioned, and also with regard to such of the four States mentioned above as shall have adhered thereto by the 14th of the present month at latest.

## II.

Article 1, Section 2, of the Ordinance No. 181 of the 28th of September, 1894, shall read as follows:—

Any person who shall have lodged an application for a Patent for an Invention in one or more of the States named above shall have the right, if he lodge in this country an application for a Patent for the same invention within twelve months following the lodging of the

first of the said applications, to obtain the Patent applied for without regard to the fact that in the interval the invention has been described or brought into use in the manner indicated in Article 1, Section 3, of the Patent Law of the 13th of April, 1894; furthermore, the application so lodged in this country shall be considered relatively to other applications as having been lodged simultaneously with the first of the said applications lodged in foreign States.

The present Ordinance shall come into force on the 14th of this month.

To this all whom it may concern are bound to conform.

Given at Bernstorff, the 12th of September, 1902, under our Hand and Royal Seal.

[L. S.] CHRISTIAN R.

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PORTUGAL. Decree of the 8th of August, 1901, regarding the ratification of the Additional Act of 14th of December, 1900; modifying the Convention of the 20th of March, 1883.

I, DOM CARLOS, by the Grace of God, King of Portugal and the Algarves, &c.

Make known to all to whom the present Decree of Confirmation and Ratification may come that an additional Act modifying the Convention of the 20th of March, 1883, and the Protocol annexed thereto as below set forth, has been concluded and signed at Brussels on the 14th day of the month of December in the year 1900, between Myself and His Majesty the King of the Belgians, The President of the United States of Brazil, His Majesty the King of Denmark, The President of the Dominican Republic, His Majesty the King of Spain and in His name Her Majesty the Queen Regent of the Kingdom, The President of the United States of America, The President of the French Republic, Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, Empress of India, His Majesty the King of Italy, His Majesty

the Emperor of Japan, Her Majesty the Queen of the Netherlands, His Majesty the King of Servia, His Majesty the King of Sweden and Norway, The Federal Council of the Swiss Confederation and the Government of Tunis by their respective plenipotentiaries.

*(Here follows the additional Act in the original French and a translation.)*

And the said additional Act, the wording of which is set out above, having been brought to my cognizance and having been seen, considered, and examined by Me as regards the whole of its contents, after having been previously approved, I ratify and confirm it both in its entirety and in each of its clauses and stipulations, and by these presents I declare it good and valid in order that it may produce its due effects, promising to observe it and to apply it inviolably and to cause it to be carried out and observed in every way.

In witness whereof I have issued the present decree, which is signed by me and sealed with the great seal of my arms, and countersigned by the Minister and Secretary of State whose signature follows:

Given at the Palace of the Necessidades the 8th of August, 1901,

(L. S.) EL REI,  
Fernando Mattozo Santos.

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TUNIS. Decree of the 11th of September 1902, publishing the additional Act of Brussels to the International Convention of the 20th of March, 1883, for the Protection of Industrial Property.

We, MOHAMED EL HADI PACHA BEY, ruler of the Kingdom of Tunis, having considered the additional Act of the 14th of December, 1900, modifying certain Articles, 1st of the International Convention concluded at Paris on the 20th of March,

1883, for the International Protection of Industrial Property, and 2nd of the Protocol annexed thereto, such Act being worded as follows:

(*Here follows the additional Act.*)

Have issued the following Decree:

The above additional Act is published in Tunis, and shall be applied therein, to date from the 14th of the present month.

**BELGIUM.** *Law of the 9th of December, 1901.*

The following are approved:

1. The additional Act modifying the Convention of the 20th of March, 1883, and the annexed Protocol, and concluded at Brussels on the 14th of December, 1900, between Belgium, Brazil, Denmark, the Dominican Republic, Spain, the United States of America, France, Great Britain, Italy, Japan, Norway, the Netherlands, Portugal, Servia, Sweden, Switzerland and Tunis.

2. The additional Act to the arrangement of the 14th of April, 1891, concerning the international registration of trade or commercial marks concluded at Brussels on the 14th of December, 1900, between Belgium, Brazil, Spain, France, Italy, the Netherlands, Portugal, Switzerland and Tunis.

**GERMANY.** Decree relating to the adhesion of the Empire to the International Convention for the Protection of Industrial Property.

The Federal Council on the 9th of May, 1901, declared itself in agreement with the decision of the Imperial Parliament in its full session of the 15th of May, 1901, that the Empire should adhere to the International Convention printed below in the original text with a translation, viz.:

1. To the Convention made at Paris on the 20th of March, 1883, between various States for the protection of industrial property, together with the protocol of the same date.

2. To the protocol added thereto and, signed at Madrid on the 15th of April, 1891, concerning the maintenance of the International Bureau of the Union for the Protection of Industrial Property.

3. To the additional Act signed at Brussels on the 14th of December, 1900, concerning the alteration of the Convention of the 20th of March, 1883, and of the protocol annexed thereto.

The additional Act of Brussels has been ratified by all the States in question with the exception of the United States of Brazil, the Dominican Republic and Serbia, and the ratification documents have in accordance with the provisions of Article 3 of the additional Act been deposited in Brussels in the Ministry of Foreign Affairs on the 14th of June, 1902; Spain deposited the ratification documents for the additional Act at the same place on the 22nd of January of this year.

The adhesion of the Empire to the above-named International Convention has in accordance with the provisions of Article I, IX, of the additional Act, been notified to the Swiss Government on the 21st of last month, and comes into force on the 1st of May of this year.

Berlin, the 9th of April, 1903.

THE IMPERIAL CHANCELLOR,  
By Count von Posadowsky.

(*Here follows the Convention and protocol referred to in French and German.*)

### Turin Convention Resolution of September, 1902.

At the Convention of Turin, held September 16th to 18th, 1902, the International Union for the Protection of Industrial Property passed, among others, the following resolution:

#### “III.

“Concerning the application of the Additional Act of Brussels.

“1st. The independence of patents, proclaimed by the Additional Act of Brussels, ought to be construed in the broadest sense, and particularly in such manner that the term of a patent shall not, in any case, be dependent upon the term of another patent.”

**Letter Charge d'Affaires of Switzerland to Secretary of  
State of United States.**

**Translation.**

**LEGATION OF SWITZERLAND.**

**TO THE UNITED STATES.**

**WASHINGTON, D. C., Oct. 29, 1902.**

**MR. SECRETARY OF STATE.**

The International Bureau for the protection of industrial property, which has been placed under the high authority of the Swiss Federal Council by Article 13 of the Paris Convention of March 20, 1883, has, for some time past, been receiving numerous inquiries concerning the position of the United States in relation to the above named Convention and the additional Act of Brussels of December 14, 1900, by which the former is completed.

If I am correctly informed, the United States has adhered from the date of May 30, 1887, to the Convention entered into by several other States on March 20, 1883, for the protection of industrial property. This adhesion has received the approval of the Senate, but Congress has not brought into the Federal law the changes required to make it consonant with the convention. According to the opinion rendered by Attorney General Miller in 1889, American courts have consistently decided that the Convention of 1883 could not be enforced in the United States except so far as it accorded with the law of the country.

By reason of the liberal spirit which inspired legislation in the United States, the difficulties attending this condition of things were not so great as they would have been in some other country; barring a few exceptions—all of small consequence to the Union as a whole—the law of the country sufficed to secure for foreigners the advantages stipulated in the Convention.

Circumstances in this respect have changed since the Additional Act of Brussels went into effect. One of the most important of its provisions is that which amends Article 4 of the Convention of 1883 by extending to *one year* the priority period of six months (seven months in countries beyond the seas) during which the original applicant for a patent in one of the States of the Union may validly file an application for the same invention in the other contracting States. This provision is in direct conflict with Section 4887 of the Revised Statutes under which a patent may be denied or declared void in the United States if the applicant has already taken out Letters Patent for the same invention in a foreign country the application for the same having been filed over seven months before applying in Washington.

The Government of the United States has ratified the Additional Act of Brussels and declared it agreed with the other states whose ratifications had been filed prior to June 14, 1902, in the decision that the said Act should go into effect on and from the ensuing 14th of September among such countries as had ratified it.

Those countries are bound to grant a priority period of twelve months to applications for patent presented by persons entitled to the benefits of the Convention. But the interested parties, who are aware that, heretofore, the United States granted the priority period of seven months for the only reason that it agreed with the provisions of its domestic legislation, inquire of the International Bureau whether they may rely upon the priority period of twelve months being adopted in this country.

The Bureau is placed in an awkward situation. On the one hand it cannot say that the United States will not enforce the additional Act it has ratified and has asked should go into immediate effect. On the other hand, it is without information that the bills relative to industrial property that have been framed in the committee organized under the Act

of June 4, 1898, have been passed by Congress; and it is constrained to admit that according to judicial precedents, the new Treaty provisions could not be enforced until the corresponding legislation shall have been revised.

I venture to lay the question before Your Excellency. I have the honor to add that the Federal Council deems itself all the more justified in trusting that the United States will shortly place itself in a position to grant full and complete reciprocity to the other countries in the Union, as Congress, itself, by passing the Act of June 4, 1898, recognized the necessity of taking action so as to harmonize the Federal legislation with the Union Convention; this necessity has become urgent since the going into effect of the Additional Act of Brussels, so that my Government doubts not that Your Excellency will do all that lies in your power toward adjusting, as soon as possible, the situation of the American Government in the Union.

Be pleased to accept, Mr. Secretary of State, the assurance of my highest consideration.

The Chargé d'Affaires of  
Switzerland,  
CHARLES L. E. LARDY.

To His Excellency  
Mr. JOHN HAY,  
Secretary of State  
Of the United States.

**Letter of Secretary of State of United States to Charge  
d'Affaires of Switzerland.**

#348.

DEPARTMENT OF STATE,

WASHINGTON, December 29, 1902.

MR. CHARLES L. E. LARDY,

etc., etc., etc.,

SIR:—

Referring to your note of October 29, 1902, in regard to the conflict between the patent laws of the United States and the provisions of the Industrial Property Convention of March 20, 1883, and the Brussels Act of December 14, 1900, modifying it, and in reply to your inquiry as to whether the Department of the Interior will during the present session of Congress press for the enactment of legislation which will make the Convention and the modifying Act effective in the United States, I have the honor to state that I am advised by the Secretary of the Interior, under date of the 19th instant, that the Commissioner of Patents has prepared a bill, a copy of which is herewith enclosed for your information, to make effective, in this country the Convention and the modifying Act in question.

Copies of this bill were transmitted on the 3rd instant by the Department of the Interior to the Chairman of the Senate and House Committees on Patents, respectively.

Accept, Sir, etc., etc., etc.

JOHN HAY.

Enclosure:

Copy of Senate Bill No. 6499, 57th Congress,

Second Session.

**Report of House Committee to House on Act to Effectuate  
Treaty.**

**HOUSE OF REPRESENTATIVES.**

**57th Congress,  
2nd Session.**

**Report  
No. 3426.**

**TO EFFECTUATE THE PROVISIONS OF THE ADDITIONAL ACT OF THE  
INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUS-  
TRIAL PROPERTY.**

January 31, 1903.—Referred to the House Calendar and  
ordered to be printed.

Mr. CURRIER, from the Committee on Patents, submitted  
the following

**REPORT**

(To accompany H. R. 17085.)

The Committee on Patents, to whom was referred the bill (H. R. 17085) to effectuate the provisions of the additional act of the International Convention for the Protection of Industrial Property, having had the same under consideration, beg leave to report it back to the House without amendment and with the recommendation that it do pass.

The purpose of the first section of the bill is to carry into effect the provisions of an additional act concluded at Brussels, December 14, 1900, by the Convention for the International Protection of Industrial Property, which act modified the act of the convention of March 20, 1883.

The United States Government was represented at this convention, and the other Governments participating in the convention were Belgium, Brazil, Denmark, theh Dominican Republic, Spain, France, Great Britain, Italy, Japan, Nor-

way, Netherlands, Portugal, Servia, Sweden, Switzerland, and Tunis.

Article 4 of this convention is as follows:

Anyone who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter mentioned.

In consequence the deposit subsequently made in one of the other States of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks.

Section 4887 of the Revised Statutes, as amended in 1897, required that an inventor should file his application in this country within seven months from the date of his application for a foreign patent, to avoid the bar which would otherwise be created by the issuance of a patent abroad prior to the issue of his patent in this country. The extension of this period of priority to twelve months instead of the term of seven months, which had been before provided, made it necessary that action should be taken by Congress to amend this section of the Revised Statutes to give effect to the provision of this article 4 of the convention, and section 1 of the present bill amends section 4887 so as to do this. The reciprocity provisions of this section will carry out the language of article 4, hereinbefore mentioned, and provide that the extension of the period of priority from seven months to

twelve months is applicable only to citizens of countries which give our citizens a similar privilege.

The following countries have adopted legislation giving full force and effect to the provisions of the additional act, either in the form of a general act approving and giving force to the additional act or by a specific amendment to their laws providing for carrying into force the provisions of the additional act as regards the extension of the "delay and priority" to twelve months: Belgium (December 9, 1901; general act), Denmark (March 29, 1901; specific act), France (December 13, 1901; general act), Great Britain (August 17, 1901; specific act), Italy (December 12, 1901; general act), Japan (February 12, 1901; specific act), Netherlands (July 7, 1902; general act), Norway (March 29, 1902; specific act), Portugal May 21, 1896; general act), Spain (May 16, 1902; specific act), Sweden (May 9, 1902; specific act), Switzerland (March 27, 1901; general act), and Tunis (December 13, 1901; general act).

Germany has not yet formally adhered to the convention, but your committee is informed that legislation is now pending, and will soon be adopted, giving full force and effect to the convention, including the additional act.

Brazil, Dominican Republic, and Servia were represented at the Brussels conference. None of these countries have as yet adopted legislation giving force and effect to the provisions of the additional act, but it is believed that all of these countries will soon ratify the act.

The last clause of section 1 of the bill, beginning at line 17, page 3, is intended to prevent this amended section 4887 from being construed to extend the period of two years, which is permitted by section 4886 prior to filing the application in this country.

Section 2 of this bill is intended to permit oaths executed in foreign countries, in applications for letters patent to be filed in this country, to be taken before judges or magistrates

of those countries who are authorized to administer oaths there. The reason for this is that notaries public are not always authorized to administer oaths, and this extends the power to take the oath before any authorized local officer, proof of their authority being made by certificate of the foreign representatives of this country.

Section 3 of the bill, which amends Section 4886 of the Revised Statutes, is intended to permit foreign executors or administrators to apply for patent upon the right of deceased foreign inventors, as at the present time it would be necessary for such officers to take out ancillary letters of administration for this purpose in this country.

Section 4 of this bill amends Section 4902 of the Revised Statutes, which authorizes the filing of caveats, so as to extend its privileges to foreigners, as well as to citizens of the United States. This gives to the subject of caveats the same breadth as has been already given by Section 4886 to the matter of applications for patents for inventions by foreigners; or, in other words, we no longer discriminate against foreigners in respect to caveats, as we have long since ceased to discriminate against them in respect to applications for letters patent.

**Report of Senate Committee to Senate on Act to Effectuate  
Treaty.**

**CALENDAR No. 3223.**

**SENATE.**

**57th Congress,  
2d Session.**

**Report  
No. 3273.**

**INTERNATIONAL CONVENTION FOR THE PROTECTION OF  
INDUSTRIAL PROPERTY.**

February 24, 1903.—Ordered to be printed.

Mr. Pritchard, from the Committee on Patents submitted the following

**REPORT.**

(To accompany H. R. 17085.)

The Committee on Patents, to whom was referred the bill (H. R. 17085) to effectuate the provisions of the additional act of the International Convention for the Protection of Industrial Property, having had the same under consideration, beg leave to report it back to the Senate without amendment and with the recommendation that it do pass.

The purpose of the first section of the bill is to carry into effect the provisions of an additional act concluded at Brussels December 14, 1900, by the Convention for the International Protection of Industrial Property, which act modified the act of the convention of March 20, 1883.

The United States Government was represented at this convention, and the other Governments participating in the convention were Belgium, Brazil, Denmark, the Dominican Republic, Spain, France, Great Britain, Italy, Japan, Norway, Netherlands, Portugal, Servia, Sweden, Switzerland, and Tunisia.

**Article 4 of this convention is as follows:**

Anyone who shall have regularly deposited an application for a patent of invention, of an industrial model, or design of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter mentioned.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be twelve months for patents of invention and four months for designs or industrial models, as well as for trade or commercial marks.

Section 4887 of the Revised Statutes, as amended in 1897, required that an inventor should file his application in this country within seven months from the date of his application for a foreign patent, to avoid the bar which would otherwise be created by the issuance of a patent abroad prior to the issue of his patent in this country. The extension of this period of priority to twelve months instead of the term of seven months, which had been before provided, made it necessary that action should be taken by Congress to amend this section of the Revised Statutes to give effect to the provision of this article 4 of the convention, and section 1 of the present bill amends section 4887 so as to do this. The reciprocity provisions of this section will carry out the language of article 4, hereinbefore mentioned, and provide that the extension of the period of priority from seven months to twelve months is applicable only to citizens of countries which give our citizens a similar privilege.

The following countries have adopted legislation giving full

force and effect to the provisions of the additional act, either in the form of a general act approving and giving force to the additional act or by a specific amendment to their laws providing for carrying into force the provisions of the additional act as regards the extension of the "delay and priority" to twelve months: Belgium (December 9, 1901; general act), Denmark (March 29, 1901; specific act), France (December 13, 1901; general act), Great Britain (August 17, 1901; specific act), Italy (December 12, 1901; general act), Japan (February 12, 1901; specific act), Netherlands (July 7, 1902; general act), Norway (March 29, 1902; specific act), Portugal (May 21, 1896; general act), Spain (May 16, 1902; specific act), Sweden (May 9, 1902; specific act), Switzerland (March 27, 1901; general act), and Tunis (December 13, 1901; general act).

Germany has not yet formally adhered to the convention, but your committee is informed that legislation is now pending, and will soon be adopted, giving full force and effect to the convention, including the additional act.

Brazil, Dominican Republic, and Servia were represented at the Brussels conference. None of these countries have as yet adopted legislation giving force and effect to the provisions of the additional act, but it is believed that all of these countries will soon ratify the act.

The last clause of section 1 of the bill, beginning at line 17, page 3, is intended to prevent this amended section 4887 from being construed to extend the period of two years, which is permitted by section 4886, prior to filing the application in this country.

Section 2 of this bill is intended to permit oaths executed in foreign countries, in applications for letters patent to be filed in this country, to be taken before judges or magistrates of those countries who are authorized to administer oaths there. The reason for this is that notaries public are not always authorized to administer oaths, and this extends the

power to take the oath before any authorized local officers, proof of their authority being made by certificate of the foreign representatives of this country.

Section 3 of the bill, which amends section 4886 of the Revised Statutes, is intended to permit foreign executors or administrators to apply for patent upon the right of deceased foreign inventors, as at the present time it would be necessary for such officers to take out ancillary letters of administration for this purpose in this country.

Section 4 of this bill amends section 4902 of the Revised Statutes, which authorize the filing of caveats, so as to extend its privileges to foreigners as well as to citizens of the United States. This gives to the subject of caveats the same breadth as has been already given by section 4886 to the matter of applications for patents for inventions by foreigners; or, in other words, we no longer discriminate against foreigners in respect to caveats, as we have long since ceased to discriminate against them in respect to applications for letters patent.

## Debate in Congress on Bill to Effectuate Treaty.

## DEBATE ON BILL OF MARCH, 1903.

Congressional Record, Vol. 36, Part 3, 57th Congress, Second Session, page 2274, House, Feb. 16, 1903.

## PATENTS.

*Mr. Currier.* Mr. Speaker, by authority of the Committee on Patents, I move to suspend the rules and pass the bill (H. R. 17085) to effectuate the provisions of the Additional Act of the International Convention for the Protection of Industrial Property. The bill was read as follows: \* \* \*

*Mr. Currier.* Mr. Speaker, this bill was drawn by the Commissioner of Patents and is favored by authorities on patent law throughout the country.

The principal purpose of the bill is to carry into effect an additional act adopted by the International Convention for the Protection of Industrial Property held at Brussels in December, 1900.

Several of these International Conventions have been held for the purpose of bringing about, as far as possible, uniformity in the patent laws of the great commercial nations of the world.

At the recent Brussels convention the following countries were represented:

The Additional Act there agreed upon simply extends the period of priority in applications for patents from seven months to twelve months. It does not extend by a single instant the life of any patent now in existence, or any patent that may be granted hereafter.

Nearly all of the nations which were represented there have

already passed the necessary legislation to give force to this act.

It seems but fair that this country should take similar action.

*Mr. Clark.* Mr. Speaker, there is no question in the world but that the bill ought to pass. It does not cost anything. It does nobody any harm, and it is a sort of condition precedent to certain exhibitors in Europe coming from there with designs to the World's Fair at St. Louis. It is not possible to do any harm.

*The Speaker.* The question is on suspending the rules and passing the bill.

The question was taken: and in the opinion of the Chair two-thirds having voted in favor thereof, the rules were suspended and the bill was passed.

Page 2986, Senate, March 3rd, 1903.

*Mr. Platt of Connecticut:* This bill was prepared by the Commissioner of Patents, and its only object is to make our practice conform to the practice which has been adopted by the International Convention for the Protection of Industrial Property.

There being no objection, the Senate, as in Committee of the Whole, proceeded to consider the bill.

The bill (H. R. 17085) was reported to the Senate without amendment, ordered to a third reading, read the third time, and passed."

### French Ratification of Treaty.

The French Government, in ratifying the Additional Act of Brussels, made the following statement of its reasons therefor:

“Article 4 *bis* which the Additional Act submitted for our approval, adds to the Convention of Paris, has for its object the establishment of an additional provision, the usefulness of which all States belonging to the Union recognize, and the principal of which was unanimously adopted at the Convention of Rome and of Madrid; we wish to speak of the reciprocal independence of patents obtained in different States for the same invention.

“The legislation of several States, relative to the protection of industrial property, contains a provision by the terms of which the term of a domestic patent is limited by the term of a patent previously granted in another country for the same invention.

“This provision has gradually been abandoned in legislation of recent date and its inconveniences are to-day unanimously recognized. Notably, it can have the disagreeable effect of compelling a patentee to maintain his patent in force in a country where it is in reality of no use to him for the sole purpose of not endangering the validity of another patent granted to him subsequently in some other country where the exploitation of the said patent is, on the contrary, remunerative.

“These and all other inconveniences arising, generally, from the reciprocal dependence of patents are bound to disappear by reason of the introduction into the Convention of Paris of Article 4 *bis*, above referred to. The provision made by this article will have the effect of suppressing all connection between different patents, and of leaving to the law of each State the regulation of the term of patents taken out in that country.”

French Text of Article 4 *bis* of Additional Act of December 14, 1900, modifying the Convention of March 20, 1883.

Page 411:

“III. Il est inséré dans la Convention un article 4 *bis* ainsi conçu:

Art. 4 *bis*.—Les brevets demandés dans les différents Etats contractants par des personnes admises au bénéfice de la Convention aux termes des articles 2 et 3, seront indépendants des brevets obtenus pour la même invention dans les autres Etats adhérents ou non à l'Union.

Cette disposition s'appliquera aux brevets existants au moment de sa mise en vigueur.

Il en sera de même, en cas d'accession de nouveaux Etats, pour les brevets existant de part et d'autre au moment de l'accession.”

CAMERON SEPTIC TANK COMPANY *v.* CITY  
OF KNOXVILLE, IOWA.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES  
FOR THE SOUTHERN DISTRICT OF IOWA.

No. 82. Argued December 11, 12, 1912.—Decided January 20, 1913.

Although under §4834, Rev. Stat., a patent is for seventeen years, under the provision of § 4887, Rev. Stat., as it has been judicially construed, the American patent granted for an invention previously patented in another country is limited by law, whether so expressed in the patent itself or not, to expire with the foreign patent previously granted having the shortest term.

Section 4887, Rev. Stat., limiting patents to the period of the same patent previously granted by a foreign country, if any, has not been superseded by Article 4 *bis* of the Treaty of Brussels of 1900.

A most essential attribute of a patent is the term of its duration, which is necessarily fixed by local law, and the Treaty of Brussels will not be construed as breaking down provisions of the local law regulating the issuing of the patent.

## Opinion of the Court.

227 U. S.

The act of 1903 effectuating the provisions of the Brussels Treaty, as construed in the light of surrounding circumstances and of similar legislation in other countries, did not extend an American patent beyond the period prescribed by § 4887, Rev. Stat.

The Brussels Treaty of 1900 should be construed in accordance with the declaration of the Congress at which it was framed and adopted at the instance of the American delegates; and it was the sense of the Congress of the United States that the treaty was not self-executing.

The act of 1903 did not make Article 4 *bis* of the Treaty of Brussels effective or override the provisions of § 4887, Rev. Stat.

THE facts, which involve the construction of §§ 4884 and 4887, Rev. Stat., as affected by the Treaty of Brussels of 1900 and the effect of prior patents in foreign countries on the duration of an American patent, are stated in the opinion.

*Mr. Henry Love Clarke* for appellant.

*Mr. Wallace R. Lane*, with whom *Mr. R. L. Welch* and *Mr. Samuel H. Crosby* were on the brief, for appellee.

MR. JUSTICE MCKENNA delivered the opinion of the court.

A bill in equity was brought by appellant as successor to the rights of an invention patented under United States letters patent to Edwin Cameron *et al.* for a process and an apparatus for treating sewage, No. 634,423, dated October 3, 1899. The bill contained the usual allegations and prayed for an injunction to restrain appellee from the use of the invention. Appellee filed a plea to the bill in which it alleged that the invention had been previously patented in Great Britain by letters patent dated November 8, 1895, and that that patent had expired on or before the eighth day of November, 1909, being the expiration of

the term for which it was granted, and that therefore the United States patent expired and became terminated by law, and it being stipulated that the bill should be considered as filed as of that date, and as the bill was not filed with the purpose or intention of applying for or obtaining an injunction before the expiration of the British patent, no injunctive or equitable relief could be had. A dismissal of the bill was therefore prayed. The decree of the court recited the facts of the plea and adjudged that the patent had expired as therein alleged and that its expiration was not prevented "by any effect of the Treaty of Brussels of December 14, 1900, which Treaty and the construction thereof was drawn in question on the plea in this cause;" and that therefore the court was without jurisdiction, the complainant having a plain and adequate remedy at law. This appeal was then prosecuted under § 5 of the Circuit Court of Appeals Act, March 3, 1891, 26 Stat. 826, c. 517.

The single question here is whether the United States patent expired with the British patent according to the laws which existed when it was issued or whether its existence was preserved by the Treaty of Brussels.

At the time the patent was issued § 4884, Revised Statutes, made the term of a patent seventeen years, and by § 4887 it was provided that the receiving of a foreign patent did not prevent the granting of a United States patent. It was, however, provided that "every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The section coming up for judicial consideration, it was decided that it assumed that the foreign patent previously granted was one granted for a definite term, that the United States patent should expire with that

term, and that it was not to be limited by any lapsing or forfeiture of any portion of the term of the foreign patent, by means of the operation of a condition subsequent, according to the foreign statute. *Pohl v. Anchor Brewing Co.*, 134 U. S. 381, 386. And it was held that the American patent is limited by law, whether it is so expressed or not in the patent itself, to expire with the foreign patent having the shortest term. *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 167; *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 43; *Leeds & Catlin Co. v. Victor Co.*, 213 U. S. 301, 325.

Appellee contends that these decisions and the cited sections of the Revised Statutes constituted the law of the United States patent to Cameron and caused it to terminate with the expiration of the term of the British patent. The argument is that it was granted not for seventeen years but for a term to be measured by that of the foreign patent, enduring the full term for which the latter was granted but no longer, though on its face it was to run seventeen years. The appellant, opposing the contention, insists that the Treaty of Brussels has superseded § 4887 and has freed the Cameron patent from subjection to the provisions of that section. It is the effect of the contention that, though the patent was issued for a definite term, as decided by the cited cases, the term was enlarged by the Treaty.

Appellant candidly admits that there are cases adverse to its contention, but seeks to limit their strength of persuasion or authority to one only, and to that one opposes the reasoning and precedent of another. The cases so put in opposition are *United Shoe Machinery Co. v. Duplessis Shoe Machinery Co.*, 155 Fed. Rep. 842, decided by the Circuit Court of Appeals of the Second Circuit against the effect of the treaty contended for, and *Hennebique Construction Co. v. Myers*, 172 Fed. Rep. 869, decided by the Circuit Court of Appeals of the Third Circuit,

which is asserted to be the other way. But the cases do not present the antagonistic authority of two courts. Judge Archbald, whose views in the latter case are relied on by appellant, stated in a subsequent one (*Union Typewriter Company v. L. C. Smith & Bros.*, 173 Fed. Rep. 288, 299) that his opinion was not that of the court.

The other cases in which the Brussels Treaty was considered, and in which it was decided that it did not enlarge the term of an American patent beyond the term of a foreign patent for the same invention, are the following: *Malignani et al v. Hill-Wright Electric Co.*, 177 Fed. Rep. 430; *Malignani et al. v. Jasper Marsh Consol. Elec. Lamp Co.*, 180 Fed. Rep. 442; *Commercial Acet. Co. v. Searchlight Gas Co.*, 197 Fed. Rep. 908. Appellant contends, as we have seen, that these cases do not express independent views but follow *United Shoe Machinery Co. v. Duplessis Shoe Co.* as authority. This is not true to the extent contended. In the first two cases an independent judgment was expressed. In the third case (197 Fed. Rep. 908) it was said of *United Shoe Machinery Co. v. Duplessis Shoe Company* that it was "well considered and very persuasive" and was "deemed to be the correct expression of the law for the purpose" of the hearing. Judicial opinion must therefore be ranged against appellant's contention and is persuasive, at least, of its unsoundness.

Appellant, however, relies on the words of the treaty, which, it is insisted, have no ambiguity whatever, and which, it is contended, by the proclamation of the President of September 14, 1902, became the "supreme law of the land." The provision relied on reads as follows:

"Art. 4 bis. Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adherents or non-adherents to the Union.

"This provision shall apply to patents existing at the time of its going into effect.

"The same rule applies, in the case of adhesion of new States, to patents already existing on both sides at the time of the adhesion." 32 Stat. 1940.

The Cameron patent existed at the time the treaty went into effect, and the British patent by which it was limited was a patent obtained in one of the States adhering to the treaty, namely, Great Britain. It is hence contended that all of the conditions necessary to the application of the treaty to the Cameron patent existed, and the limitation of its term to that of the British patent as provided by law at the time it was issued was removed, that law being repealed by the treaty, which, it is contended further, was self-executing, and the patent became a grant for seventeen years. Two propositions are involved in the contentions: (1) that the treaty applies to the Cameron patent; (2) that the treaty is self-executing. If either proposition be erroneous, appellant's contentions are untenable.

To say that the text of the treaty is without ambiguity does not carry us far. All of the conditions of a patent are not expressed in it, and when these are considered construction is demanded and must be exercised. What is meant by the independence of a patent for the same invention in different States? It certainly was not intended to break down all of the provisions of law applicable to a patent; in other words, to interfere with the manner of its grant, and, it would seem by necessary implication, the extent of its grant as provided by the local law. A most essential attribute of a patent is the term of its duration, which is necessarily fixed and determined by the local law. And what difference in principle or effect is there if the term be expressed directly by a number of years or by something else, as a foreign patent which has a certain duration? The patent is no

more contingent in one case than in the other. It is complete in both cases at the moment it is issued. In both cases its term has certain definition given by the local law. And this is the declaration of the cases, and that the integrity of its term and its independence were not affected by subsequent conditions which might terminate the foreign patent.

But it is contended that so to confine the treaty is to deprive it of significance and force because the decisions of this court had given to patents such independence. *Pohl v. Anchor Brewing Company*, 134 U. S. 381. The answer is not sufficient. It might have been thought worth while to give conventional sanction to the judicial construction and make it applicable to the adhering States whose laws were not uniform; and it is certain that there was an immediate demand of the American delegates so to qualify the provision that it should not extend the term of the monopoly of the patent beyond that which was given by the law under which the patent had been issued.

The details of the conference are set out in *Hennebique Construction Co. v. Myers, supra*. It appears that Mr. Forbes, one of the American delegates, pointed out that if Article 4 bis could be interpreted as applying to patents already issued, which he said it might be, it would encounter opposition in the United States, and he inquired whether it could not be made the subject of a special protocol. A view was expressed that the Article would not produce the apprehended effect, but Mr. Forbes insisted on the necessity of stating the point precisely in order to avoid error of interpretation. After debate, in which different views were expressed, the Director of the International Bureau suggested the following amendment: "This provision shall apply to patents in existence at the time of its being put into force. Its effects are, however, limited to nullities and lapses which

## Opinion of the Court.

227 U. S.

would affect anterior patents." The amendment was not adopted, but, following the suggestion of Mr. Bellamy Storer, one of the delegates from the United States, the President "put to vote the adoption of the text previously adopted for Article 4 *bis*, with the interpretation which the American delegation desired to specifically point out, by proposing to complete the second paragraph by supplementing this explanatory clause: 'However, the term fixed by the initial law of each country remains intact.' Article 4 *bis* is definitely adopted with this condition."

It is, however, urged that the delegate from Great Britain said that he "could only take the indicated act of interpretation as a declaration of the American delegation and not as a decision of the Conference." The proceedings, however, show that the Conference adopted the whole of the first final protocol prepared by the Committee on Reports.

Certain subjects were not disposed of by the Conference but postponed with the comment that "after the exchange of views through diplomatic channels," the Conference would "reassemble anew in the Belgian Capital in order to finish its work."

The American delegates reported to the Secretary of State their understanding of the meaning of Article 4 *bis* and the interpretation which had been given it by the Conference. The unanimous sanction of the Conference, they said, was that the second paragraph of Article 4 *bis*, which reads: "This provision shall apply to all patents existing at the time of its entering into force," was not applicable to existing United States patents but only to those patents whose terms might be shortened by the laws of those States of the Union [for the Protection of Industrial Property] in which provision was made for the shortening of the term on the lapsing of patents for the same invention in other States. Existing United States patents, they further reported, could not be affected by what might take place

in regard to a foreign patent, their terms having been determined by § 4887 at the moment they were issued and that therefore their duration was unaffected by the subsequent expiration of a foreign patent for the same invention by reason of non-payment of taxes or non-working.

There was a second session of the Conference in December, 1900. Article 4 *bis* was not further debated. There was some reference to it as one of three arrangements "concerning retroactivity." Appellant hence insists that having that quality the article necessarily applied to existing patents and was a "plain and simple retroactive ending of the former dependence of existing patents upon the running of the terms allowed to foreign patents." To confine the provision, it is contended further, to "mere future contingencies that might befall patents would be prospective and not 'retroactive.'" In aid of these contentions it is urged that the American delegates, two of whom were new, made no objection to the declaration of the retroactivity of Article 4 *bis*, and that no limiting protocol was annexed to the treaty when it was finally adopted at Brussels in 1900 and that the Article was ratified by the Senate and proclaimed by the President without qualifying it. The considerations have strength, but there are opposing ones. The second session of the Conference was a continuation of the first. The American delegates had secured an interpretation of Article 4 *bis*. It could be accepted by them as final and definite. There was no challenge of it by ascribing retroactivity to Article 4 *bis*, for that Article was recognized to have such effect but not to extend the term of a patent fixed by the initial law. Future contingencies, as said by appellant, would of course be prospective, but whether patents existing at the time of the treaty should be subject to them or independent of them was retroactive.

The action of Congress must be taken into account in estimating appellant's contentions. In *United Shoe*

Opinion of the Court.

227 U. S.

*Machinery Co. v. Duplessis Shoe Machinery Co., supra*, it was made determinative, and the court decided that what construction should be put on Article 4 *bis*, and what rule should apply as to its becoming effective became academic questions in view of the provisions of the act of Congress of 1903, entitled "An Act to Effectuate the Provisions of the Additional Act of the International Convention for the Protection of Industrial Property." The act of 1903 was preceded by—and probably induced by—a letter which the Chargé d'Affaires of Switzerland addressed to the Secretary of State. The letter was prompted, according to its representations, by the embarrassment to which the International Bureau was subjected on account of the uncertainty of the action of the United States in regard to the Additional Act of Brussels of December 14, 1900, the treaty being so designated. It referred to the Convention of March 20, 1883, and the approval by the Senate of that Convention in 1887, but it stated "that Congress had not brought into the Federal law the changes required to make it consonant with the Convention," and that, "according to the opinion rendered by Attorney General Miller in 1889, American courts have consistently decided that the Convention of 1883 could not be enforced in the United States except so far as it accorded with the law of the country." The opinion was expressed that the difficulties attending this condition of things were not so great as they would have been in some other country, but it was said, however, that the circumstances had changed since the Additional Act of Brussels went into effect. One of the most important of its provisions, it was said, was that which amends Article 4 of the Convention of 1883, extending to one year the priority of six months during which the original applicant for a patent in one of the States of the Union may validly file an application for the same invention in the other contracting States. After some comment on the priority

period, the letter proceeded as follows: "The Bureau is placed in an awkward situation. On the one hand, it cannot say that the United States will not enforce the Additional Act it has ratified and has asked should go into effect. On the other hand, it is without information that the bills relative to industrial property that have been framed in the committee organized under the act of June 4, 1898, have been passed by Congress; and it is constrained to admit that according to judicial precedents the new Treaty provisions could not be enforced until the corresponding legislation shall have been revised." The required legislation was urged.

The Secretary of State replied to the letter, describing it as "in regard to the provisions of the Industrial Property Convention of March 20, 1883, and the Brussels Act of December 14, 1900, modifying it," and said that he was advised by the Secretary of the Interior that he had prepared a bill "to make effective in this country the Convention and modifying Act in question."

The act of 1903 was then enacted, and if there could be any doubt that it expressed the sense of Congress and those concerned with the treaty that it required legislation to become effective, such doubt would be entirely removed by the legislative action of other States. It appears from the report of the Committee on Patents of the Senate and of the House of Representatives on the proposed legislation that thirteen countries had adopted legislation giving full force and effect to the provisions of the Additional Act either in the form of a general law or by specific amendment to other laws providing for carrying into force the provisions of the Additional Act as regards the extension of the "delay and priority" to twelve months. Other countries were mentioned as being expected to do so. In explaining the object of the bill the member in charge of it in the House of Representatives said that it was to carry into effect the Additional Act of the Convention held at

Opinion of the Court.

227 U. S.

Brussels in December, 1900; and, further, that the Additional Act agreed upon simply extended the period of priority in applications for patents, and that it did not "extend by a single instant the life of any patent now in existence, or any patent that may be granted hereafter." He further said that nearly all of the nations which were represented at Brussels had already passed legislation to give force to the act and that it was but fair that this country should take similar action.

An attempt is made by appellant to distinguish between Article 4 *bis* and the provisions of the treaty expressly dealt with by Congress, and to assign to that Article a more distinct and definite power of execution than the other provisions possess. To account thereby for its omission from the act of 1903, it is urged, that those provisions concern matters of administrative law which might be or thought to be in conflict with statutory provisions, whereas Article 4 *bis* accomplished all that it could accomplish the instant the treaty went into effect and there was nothing further to be done as a matter of administrative law. We are unable to accept the distinction, and appellant is therefore brought to this alternative. If the treaty be construed, as we think it must be construed, in accordance with the declaration of the Conference at the instance of the American delegates, it has no application to the Cameron patent. If it be not self-executing, as it is certainly the sense of Congress that it was not and seems also to be the sense of some of the other contracting nations, and as the act of 1903 did not make effective Article 4 *bis*, the provisions of § 4887 apply to the Cameron patent, and caused it to expire with the British patent for the same invention.

*Decree affirmed.*

END

OF

CASE